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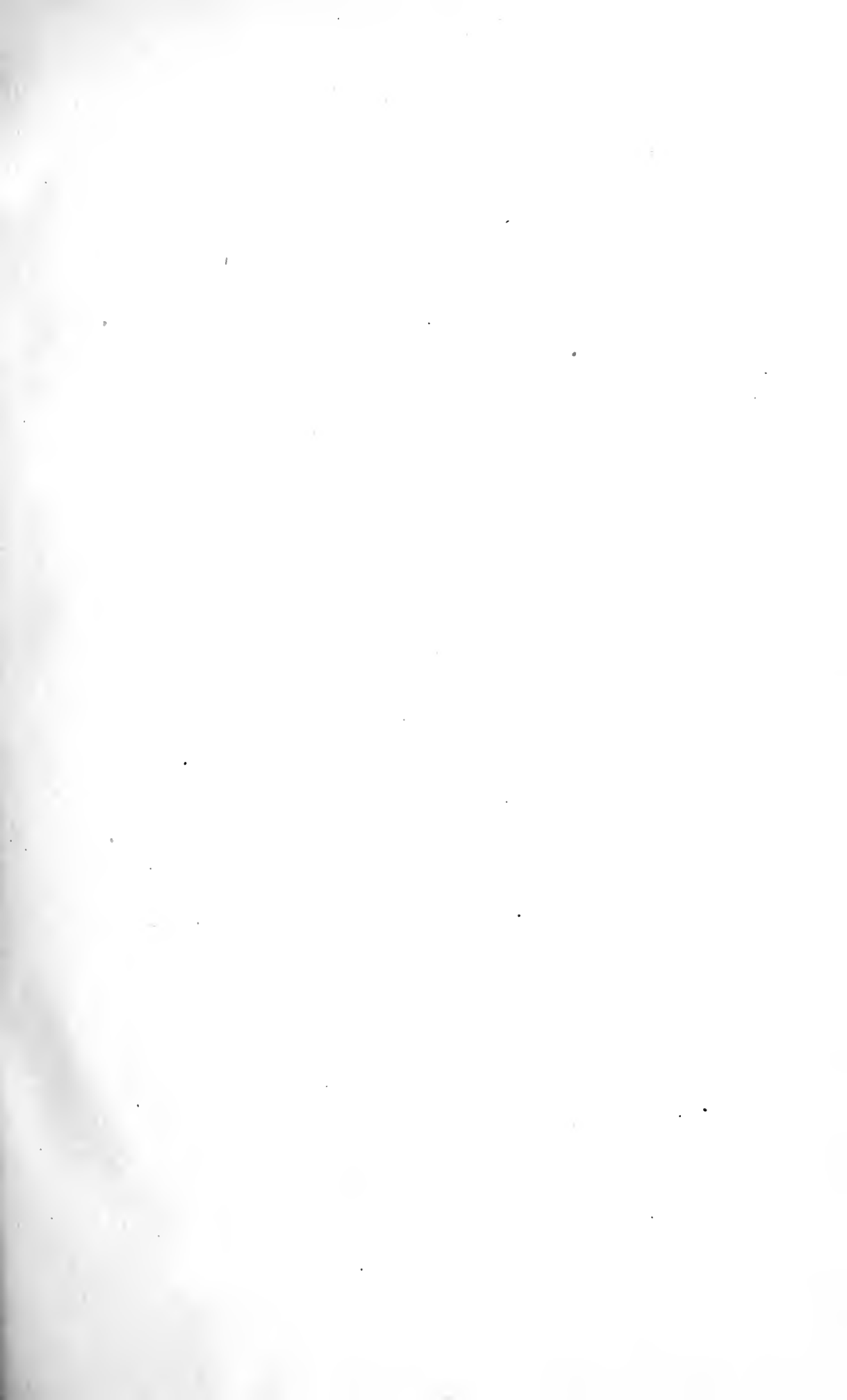
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UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE NINTH CIRCUIT.

J. M. K. LETSON AND F. W. BURPEE

Appellants,

vs.

THE ALASKA PACKERS' ASSOCIA-
TION,

Appellee,

THE ALASKA PACKERS' ASSOCIA-
TION,

Appellant,

vs.

J. M. K. LETSON AND F. W. BURPEE,

Appellees.

Brief for Appellants Letson and Burpee.

FILED

APR 24 1903

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Records of business
court of appeals

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IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

ALASKA PACKER'S ASSOCIATION,

Complainant and Appellant,

vs.

J. M. K. LETSON and F. W. BURPEE,

Defendants and Appellants.

BRIEF FOR DEFENDANTS AND APPELLANTS LETSON AND BURPEE.

This is a suit in equity brought to obtain the usual relief for an alleged infringement of United States Letters Patent No. 376,804, bearing date January 24th, 1888, and granted to Mathias Jensen and the Jensen Can Filling Machine Company, for a can crimper and capper. The complainant has been the owner of said patent ever since the 16th day of May, 1896, which covers all of the time during which infringement is charged against the defendants.

The action was brought in the Circuit Court of the United States, Ninth Circuit, in and for the District of Washington; and was tried before His Honor C. H. Hanford, the Judge of said Court.

Testimony was taken by both the complainant and the defendants, and, after a full hearing the Court decided that the defendants had infringed claims five, nine and ten of the patent, but that they had not infringed either one of the claims one, three or eleven.

The opinion and decision of the said Court is in the record, pages 434 to 460.

Both parties were dissatisfied with the decision and both parties have appealed from the decree of the Circuit Court to this Court of Appeals.

The assignment of errors of the defendants Letson and Burpee is in the printed record at pages 467 and 468.

There is only one printed record in this Court. That printed record contains the full record of both sides. The complainant's assignment of errors is on pages 477 and 478.

This being a case of cross appeals, we will, for convenience and greater certainty of identification, use the terms complainant and defendants, instead of appellant and respondents.

The main issues in the case are upon the question of infringement, and the assignment of errors of both parties relate to the issues regarding infringement. The defendants, Letson and Burpee, assign as errors the

decision of the Circuit Court which finds that they have infringed claims five, nine and ten; while the complainant assigns as error, that the Circuit Court erred in not deciding that the defendants Letson and Burpee had infringed claims one, three and eleven.

There is but very little conflict in the testimony. Most of the material facts are established beyond any controversy and are practically undisputed.

The questions to be decided by this Court of Appeals are whether or not the defendants have infringed claims one, three, five, nine, ten and eleven of the said Jensen patent, or either of them, when the law is applied to the material facts that are established.

FACTS OF THE CASE.

The record contains a cross appeal, as before stated, but the testimony and facts, and law apply alike to both appeals, and most of the arguments will apply to both appeals alike.

The patent sued upon describes a modified form of automatic can capping or heading machines, several of which machines this Court has become familiar with in past litigation. In fact this identical patent was before this Court in the case of *Norton vs. Jensen* 49 Fed. 859. So far from being a pioneer invention in can capping or heading machinery, it was decided by this Court in the case referred to that the machine covered by the Jensen patent was itself an infringement upon no less than four prior can heading patents. In that

case *six prior patents or can heading* or capping machines were sued upon, and, besides, the prior patents that were sued upon, there were other prior patents on machines for heading cans put in evidence by the counsel of Jensen, who, in that case, was a defendant. Jensen's machine described in the patent herein sued upon was but a modification of well known can capping machines already in use. It was itself a can capping machine, and (leaving off its crimping apparatus, which has nothing to do with this case as the defendants have never used any crimping apparatus), it is nothing but a can heading machine. The terms "can capping" and "can heading" mean exactly the same thing. They are only different names for one and the same thing. Every can capping machine is a can heading machine and vice versa.

While the Jensen machine was but a modified form of the can capping machines already in use, it nevertheless contained valuable improvements and changes that adapted it particularly for use for putting a single head upon a can while the can was in a vertical position, and in practice it was used more especially for putting the upper head upon cans that were filled with raw fish.

Doubtless, it could also be used for putting the first head upon the empty can body. The defendants' machines were so used. Record, pages 390 and 391. Still the machine was a long way down the list of can capping machines from the first, or pioneer machine. But more of this hereafter.

The patent has sixteen claims, but only claims 1, 3, 5, 9, 10 and 11 are asserted to be infringed. The defendants' machine has no crimping apparatus attached to it of any kind, and some of the claims of the Jensen patent cover its crimping devices. Those of course were not infringed. There are also other claims of the patent of which no infringement is asserted, and no attempt is made in the testimony to show any infringement thereof. Proof of alleged infringement is confined to the six claims above enumerated.

Defendants' answer contains a full denial of infringement, and also sets up anticipating matter, only a small portion of which was introduced in evidence.

The bill of complaint waives an answer under oath, and neither the bill of complaint nor the answer is verified.

The defendants have two machine shops in both of which they have manufactured machines of the kind which are claimed to be infringements of the complainant's patent. One of these machine shops is located in the city of Vancouver in British America. Of course the making and selling of machines in British America could not infringe the complainant's United States patent since that patent does not extend into British America.

The other of the defendants' machine shops is located at Fairhaven in the State of Washington, which is within the United States.

The machines made in the United States by the defendants are made under a United States patent No. 629,574 bearing date July 25th, 1899, and was granted to the defendants for a can capping machine. This patent of the defendants' was put in evidence by the complainant, and is "Complainant Exhibit Defendants' Patent," Record, page 97. The exhibit itself is in the record at pages 519 to 533.

The machines made by the defendants were made in accordance with the machine described in said patent. Some of them, however, contained slight modifications in a few particulars of the description of the patent. These modifications are shown in the testimony of Mr. Burpee, taken by complainant. There is no conflict we believe in the testimony as to the exact description of the machines, and every part of the machines, that have been made by the defendants. The record from page 28 to page 45 tells the whole story regarding infringement.

As the Jensen patent sued on shows for itself what it is and what it covers, and as the machines made by the defendants were made as described in their said patent, with slight modifications as to some of the machines, an exact and undisputed description of which is shown in the testimony, there is really little, and probably nothing, to do in deciding this case except to compare the defendants' machines with the said claims of the complainant's patent and find whether or not the combinations of those claims, or of any of them, are to be found in the defendants' machine.

We believe and contend that there is no infringement of any claim of the Jensen patent by the defendants' machines, even though those claims were allowed all the force that could be contained within the broadest scope that could be given to the language in which they are expressed, and without any limitation being placed upon them by proof of the prior state of the art in can heading mechanism.

Defendants have, however, put in evidence testimony which shows something of the state of the art. The oral testimony shows that automatic can heading machines were in common use before Mr. Jensen made his invention. In addition to this defendants have put in evidence two prior United States patents for showing, in some particulars, the said state of the said art.

One of these was Patent No. 265,617, bearing date October 10th, 1882, and granted to George A. Marsh, for a machine for heading cans. It is defendants' Exhibit A. The machine described in this patent was operated largely by hand. It was well adapted to putting the upper head on filled fish cans. It put the head on the upper end of the can body while the can was in a vertical position. This patent says in its specifications:

“The purpose of my invention is to provide a convenient device for heading cans. In packing goods in open-top cans the cover must be placed upon the can *after the can has been filled*, and consequently while it is in an *upright position*.”

And further along it says:

“ In operation, the can, *having been filled*, is placed “ against the base of the machine, its wall resting “ against the guides n n.” The machine of this patent was well adapted for putting the upper head on filled fish cans.

This exhibit was put in evidence during the cross-examination of the plaintiff’s expert, L. W. Seely. Record, pages 255 to 257.

Defendants’ Exhibit F is a full sized model of the above Marsh patent. It was put in evidence while taking testimony of defendant Burpee, and he testifies that the machine would head filled fish cans just as perfectly in all respects as the Jensen machine does or ever could. Record, 334 to 336.

The other prior patent that was put in evidence to show the state of the art was Patent Nos. 307, 197, bearing date October 28th, 1884, and granted to Edmund Jordan for a can-ending machine. This patent was put in evidence during the cross-examination of the complainant’s expert, L. W. Seely. It is defendants’ Exhibit B. Record, 258 and 259.

Afterwards, and while defendant Burpee was giving his testimony, the defendant put in evidence a model which contained such part of the machine, described in said Jordan patent, as received the can heads and placed them upon the can bodies. This model is defendants’ Exhibit E. Record, 329. This Jordan machine put the heads upon the can bodies while the can

bodies were in a vertical position, and it was an automatic machine.

By reading the said patents to Marsh and Jordan, while viewing the respective models, Exhibits F and E, the patents are easily understood.

The Jensen machine is what is commonly called a stop motion machine. By "stop motion" is meant that the *can body stops* its forward movement, on its way through the machine while the head is being put upon it. The term does not mean that all the mechanism of the machine stops its work. The devices which place the head upon the can body must do this part of their work while the forward motion of the can body is temporarily suspended. The term "stop motion," as we use the term, means that the can body stops its forward motion through the machines while the head is being forced upon it.

The defendants' machines, on the other hand, places the head upon the can body while both the can body and the can head are moving forward through the machine. In the defendants' machines no time is lost while the head is being forced upon the body, for the reason that the head is so forced upon the body while both the body and the head keep on with their forward motion while the head is forced upon the body, just as a railroad passenger does not lose any time while taking his meals upon the dining car that goes with the train that is speeding him on his journey while he is eating.

This saving of time by having the head forced upon the body while both are traveling forward through the machine is so much that one of the defendants' machines will head twice as many cans as will the Jensen machine. Record, 297 and 298. In the Jensen machine the can bodies stop their forward motion while the head is being forced upon it. During this stop the can moves upwards and downwards, but not forward on its way through the machine.

This difference between the two machines, one being a stop motion while the other is a continuous motion machine, is fundamental. As will be readily understood, the different character of the movements of the machines results from the fact that they are built upon radically different plans, operate upon different principles, have different mechanism as a whole and different devices in detail and different combinations and sub-combinations of devices throughout their entire organizations.

The witnesses *upon both sides* of the case fully agree on the fact that the devices used to produce effects in one of the machines could not be used in the other machine. This results on account of the fundamental differences in the general plans and organizations of the machines, their different modes of operations, all of which necessarily require different characters of devices, and a different character of sub-combinations of operative devices in order to operate the different plans and organizations of the two different machines.

The complainant has put its patent in evidence. In order that it might be easily understood and its operations, in gross and in detail, comprehended with certainty, the defendants have made and put in evidence a full sized working model of the machine which is capable of heading cans. This model is the defendants' Exhibit D. Record, 299.

As already stated, the complainants put in evidence the defendants' patent. This is a convenient way of showing the description of the machines which the defendants were making and selling. In order to make their patent more easily understood the defendants put in evidence one of their actual machines, and placed upon its several parts and devices the same figures and letters that indicate the same parts and devices in their patent. This machine of the defendants' is their Exhibit C. See Record, 290 and 291. From page 291 to page 295, is contained an oral description of the machine and its operations.

In the Jensen machine the filled fish cans are placed in a vertical position upon a constantly moving horizontal belt and are carried by the belt into the machine. Over the belt were arranged spacing fingers to regulate the passage of the cans into the machine. Fixed rigidly across the belt is an immovable stop E. When the can reaches this stop E, it stops, allowing the belt to slide under it. In the machine is a device which is called in the patent "the feeder or carrier F." This feeder F consists of a horizontal arm F, extending across the

table at right angles with the feed belt. It has four arms or prongs H, projecting at right angles from it, and at sufficient distances apart to admit of a can being received between them so as to be transferred by their movements. The feeder F is mounted upon the pins of three cranks, I and JJ. These cranks have vertical shafts which are journaled in the frame, and power is applied to move them so that they produce a circular sweeping motion of the feeder or carrier and its forked arms H. The arm F and the arms H are rigidly attached so as to form one single moving device, and the arms H and arm F together constitute the carrier or feeder F.

As the feeder is carried around by the said cranks in its sweeping movement, the first two of the arms or prongs H are brought forward so as to receive between them the can which is standing on the traveling belt and is kept there by the stop E. The further movement of the carrier F transfers the can one step crosswise of the table and at right angles to the belt, at which point the sweeping motion of the carrier withdraws the prongs H from the sides of the can and leaves it standing in its position until the feeder again comes around. The feeder or carrier being again carried around by the cranks, its said first two prongs H receive another can, which has in the meantime been brought by the belt against the stop E, and the first can which was left standing on the table is received between the second and third of the prongs H, and is carried by them on to

the top of a vertical plunger S, and is left standing there until the plunger raises. Over this plunger S is a conical opening in the top part of which is a can head resting upon its rim edge on a circular flange. The conical opening is widest at its lower part, and it acts as a guide to direct the upper end of the can body into the inside of the rim of the can head when the plunger S raises the filled can upwards. The can being thus headed, the upper portion of the conical guide, which is composed of two sliding parts, separates, and by so doing makes room for the head, now upon the can, to descend downwards as the plunger S descends. When the can has descended to its original position upon the plunger S, the carrier F again comes around, and the can is received between the third and fourth prongs H, and is moved forward towards the crimping mechanism.

Above the plunger S, and over the can cap when it is in place in the conical hollow guide, is another plunger, U. This plunger U follows the headed can down through the conical guide, resting on top of the can, so as to *steady the can while descending*. On one side of the feed belt A are two vertical shafts I, each having swinging arms J that swing horizontally in the segment of a circle over the side of the belt. Coiled springs around these vertical shafts tend to draw them in one direction, while connecting chains which connect the arms with the carrier F draw them in the opposite direction with the movement of the carrier. In this way

the filled cans on the belt A can only pass, one at a time, to the stop E.

The heads are fed into the machine through an inclined chute, by means of which and an additional large complicated mass of mechanism the heads are carried into the machine, their descent down the inclined chute is regulated, and they are finally forced into their position in the upper part of the conical guide, over the plunger S as before stated.

In the defendants' machine the filled cans are also carried into the machine by a horizontally moving belt, being placed thereon in a vertical position, and in most of the defendants' machines there were spacing fingers over the belt to regulate the passage of the cans into the machine so as to prevent any can from being accidentally mashed when the belt was not kept full of cans. With this feeding belt and the spacing fingers over it, however, all identity between the Jensen machine and defendants' machine ends and is lost. The Jensen machine being a stop motion machine and the defendants' being a continuous moving machine the mechanism of the one could not be, and was not used in the other. The defendants' machine has no stop E, nor anything that corresponds to it. Neither does it have the carrier F with its prongs H, nor anything that corresponds to it. In the defendants' machine, fixed in a suitable bracket is a vertical spindle or shaft marked 35 in the patent. Attached to this vertical shaft are two skeleton wheels, the upper one being marked 37, and the lower one 36.

These wheels are both of the same shape, and instead of being round they have each four irregular sides. Near the back end of each one of the sides is a sort of pocket or can recess, each one of which is marked 36a in the patent, in the lower wheel. The upper wheel has exactly the same shaped pockets or recesses, and they are in an exact perpendicular line over the pockets or recesses, 36a, in the lower wheel 36.

The said shaft 35 is at one side of the carrying belt 59, that brings the filled cans to the machine. The wheel 36 is a short distance above the belt, and as this wheel 36 revolves its pockets, or can recesses, pass in a circle across the belt and at a distance beyond it. As each one of the filled cans comes along the belt it is received, while it is still under motion, by one of the can recesses in the wheel and carried off from the belt and around in a circle to its place upon one of the can supports 19, which is carried by another revolving device, which we will describe as far as is necessary.

Another vertical spindle 13 is fixed rigidly and immovably in the machine parallel with the shaft 35. A vertical carrier 14, of considerable vertical length, rotates around the spindle 13. This carrier 14 carries a horizontal, rotating table 20. There are four circular openings through this table 20, each of which openings is marked 21. Through these openings 21, the upper end of the filled can passes into the can head.

Underneath the table 20, and revolving with it around the spindle 13, is another horizontally rotating

carrier 14. This carrier has four radial arms 14a, the projecting ends of which have vertical apertures, in which are seated spindles 18. Each one of these spindles carries one of the can supporting disks 19. Between the upper rotating table 20, and the carrier 14, is another device that rotates around the spindle 13, and has four can holding recesses, marked 40 in the patent, therein. The object of this device is to furnish guides for the cans so that, as they are transferred to the can supports 19, the side of the can body will fit into the can holding recess in the radial arm 40, which acts as a guide. The can will thus be placed in exact alignment with the head which will be the opening 21 above it. The table 20, the carrier 14, and the intermediate device carrying the can holding recesses, are connected and all rotate together as one device. The defendants' machine uses, to carry the caps into the machine, a horizontally moving belt 69. The caps are carried into the machine on the opposite side from that where the cans are carried in, and therefore do not have nearly as far to be carried by the feed wheel as do the cans. Upon the spindle 35, and immediately over the can feed wheel 36, is the cap feed wheel 37, which is of the same form as is the wheel 36. This upper cap feed wheel is just high enough to carry the can heads upon the wheel 20, and the arrangements are such that the cap will be carried and placed in the upper part of the opening 21, in the proper position to receive the end of the can body. This cap feed wheel

37, receives the cap in one of its recesses or pockets, and carries it off of the belt and on to the table 20, just as the lower can feed table 36 receives the filled can and carries it around and places it upon the can support 19.

Underneath the can supports is a circular member 47, having inclined surfaces 46. It is really a circular cam. When the can and heads have been placed by the rotating mechanism in their proper positions, the parts still continue to rotate and the stem 18, of the can support 19, comes in contact with the upwardly inclined side 46, of the circular cam 47, and being carried forward is raised thereby and carries the filled can upwards, thus forcing its upper end into the can head, and thus the can is headed. As the rotation still continues the spindle 18, comes to the downward incline on the other side of the member 47, and descending with such incline the headed can is carried downwards to other mechanism which receives it and takes it and carries it around to another belt 73, which carries it out of and away from the machine.

Adequate mechanism is applied to drive the vertical carrier 14, and the two toothed wheels 31, and 39, operating as regular gearing, drive the vertical shaft 35, which carries the feed wheels 36 and 37.

There is much other detail and necessary mechanism which we will examine closer later, while discussing the specific claims of infringement to which the complainants' experts have testified. All that we have so far

intended to present is the general differences between the general plan and organization of the Jensen patented machine and those of the defendants' machines, with such description of the principal operating mechanisms as will make the general character of the operations, and operating mechanism, of the two machines understood.

Before going on to compare the defendants' mechanisms with the said claims of the Jensen patent we will refer the Court to the elementary rules of law that control simple cases of this kind, and which rules we claim should have secured a decree in the Circuit Court for the defendants. We believe that it is not seriously contended that there is anything in the defendants' machines that was ever invented by Mr. Jensen. It is only claimed to reach the defendants by using the term "mechanical equivalents," and then spreading and expanding the term, and by thus doing, make it reach not only to the full limits of Jensen's invention, but into a broad expanse beyond those limits.

Section 4888, of the U. S. Revised Statues declares as follows:

" Before any inventor or discoverer shall receive a
 " patent for his invention or discovery, he shall make
 " application therefor in writing to the commissioner of
 " patents, and shall file in the patent office a written de-
 " scription of the same and of the manner and process
 " of making, constructing, compounding and using the
 " same in such full, clear, concise and exact terms as to

“enable any person skilled in the art or science to
 “which it appertains or with which it is most nearly
 “connected, to make, construct, compound, and use the
 “same; and in case of a machine he shall explain the
 “principle thereof and the best mode in which he has
 “contemplated applying that principle so as to distin-
 “guish it from other inventions; and he shall particu-
 “larly point out and distinctly claim the part, improve-
 “ment or combination which he claims as his invention
 “or discovery.”

All this was done by Mr. Jensen as is shown by his patent. It is a machine patent. His specifications explains the principle of his machine and the best mode in which he had contemplated applying that principle, and they distinctly point out and claim the improvements or combinations which he claimed as his inventions.

As shown by his specifications, the best mode in which he applied the principle of his invention, and in fact the *only mode* in which he attempted to apply it, was by the construction of a *stop motion machine*. He did not contemplate any machine in which the can should be moving forward through the machine while the head was being forced upon it. Neither such a mode of operation nor such a principle of construction was contemplated by him. No mechanism by means of which a can could be automatically headed while moving forward was introduced into his machine, and in his application no such continuous movement of the

can while being headed was mentioned or described or in any way, directly or indirectly, even hinted at. The machine which he described did not operate on that principle, or by that mode of operation. Jensen described nothing, and claimed nothing that included the principle of continuous movement of the can on its way through the machine while the head was being forced upon it.

The difference between stop motion machines and continuous moving machines have long been well known, as have machines operating on those two different principles. Sometimes machinery may be changed and the one principle substituted for the other and some times they cannot. A jig saw works with a stop motion while band saws and also circular saws work on the continuous movement principle. Ordinary planing machines for planing metal operate on the stop motion principle, while turning lathes operate on the continuous running principle. The Wheaton heading machine was a machine that operated on the continuous motion principle while the Norton and Hodgson machine operated on the stop motion principle. The Wheaton machine would head four cans while the Norton and Hodgson machine was heading one, and the Wheaton machine was adjudged to be no infringement of the Norton and Hodgson patent. *Wheaton vs. Norton*, 70, Fed. 833, pages 851 to 853. Machines that operate on the continuous motion principle are much

more efficient than those that operate on the stop motion principle.

It cannot be denied but that Jensen in his specifications has well described the principle of his machine as a stop motion machine, and that the best mode in which he contemplated applying that principle was by means of the mechanism described in his patent which would operate with the stop motion; and his description all through was well made so as to distinguish his machine from any and every machine operating on the continuous motion principle. His description would certainly distinguish his machine from the defendants' machine, even if the defendants' machine had been first.

His claims are also drawn so as to leave outside of them any and every combination that can be found in the defendants' machine. Not a single combination that is covered by any claim of the Jensen patent is in the defendants' machines. If the defendants had been the first in the field in making an application for their patent *they could not have used or placed in their claims a single one of the Jensen claims*, and had it cover any combination that is described in their specifications, or that has ever been used in their machines. And, now, if the Court was to take the claims of the Jensen patent and the specifications of the defendants' patent and undertake to read those claims into the defendants' specifications it would find itself struggling with a task impossible of accomplishment. It could not

find in the defendants' specifications, or in its machines a single combination that a single one of the Jensen claims would cover. And on the other hand if it should undertake to apply any of the defendants' claims to the Jensen specifications, it would go through the entire list of claims without finding a single combination in the Jensen machine that a single one of the defendants' claims would apply to.

L. W. SEELY was one of the complainants' principal experts and did the best he could for the complainant. On pages 223 and 224 of the record Mr. Seely testifies that the defendants' machine does so much more work than the Jensen machine does because "*the organization of the whole machine has been changed* so as to give it greater capacity." and that:

"The defendants' machine as a whole is differently organized from the Jensen machine in order to give it greater capacity." That "*the structural organization*" of the two machines is different.

We make this reference at this time that the Court may know as we go along that the organization of the defendants' machine, which operates with the continuous movement, is proved by the complainant's own witnesses to be fundamentally and radically different in its plan of construction, and in its mechanism, and in its operation, from the Jensen machine, which can be operated only with the stop movement. This the Court will realize we think when we further show the

extent to which the complainant's own professional and skillful experts have so testified.

Further along we shall discuss each one of the said claims of the complainant's patent and will then show more of the same character of testimony by witnesses upon both sides of the case.

The said section, 4888, of the Revised Statues, has been repeatedly construed by the Courts and it is well understood. It is the foundation sill of the patent law structure. It is the law itself. Under it, the courts have decided repeatedly that a patent can never cover anything except what its claims cover. Even though the claims fail to cover the invention, still the patentee is bound and limited by the claims that are made in his patent.

McClain vs. Ortmyer, 141 U. S. 419.

Beginning on page 423 of this case the Supreme Court says: "While the patentee may have been unfortunate "in the language he has chosen to express his actual invention, and may have been entitled to a broader claim, "we are not at liberty, without running counter to the "*entire current of authority* in this Court, to construe "*such claims to include more than their language fairly imports*. Nothing is better settled in the law of patents "than that the patentee may claim the whole or only a "part of his invention, and that if he only describes and "claims a part, he is presumed to have abandoned the "residue to the public. The object of the patent law "in requiring the patentee to 'particularly point out

“and distinctly claim the part, improvement or combination which he claims as his invention or discovery,’ is not only to secure to him all to which he is entitled, *but to apprise the public of what is still open to them.* THE CLAIM IS THE MEASURE OF HIS RIGHT TO RELIEF, and while the specification may be referred to to limit the claim, IT CAN NEVER BE MADE AVAILABLE TO EXPAND IT.”

And further on page 424:

“When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent IS BOUND BY IT. . . . HE CAN CLAIM NOTHING BEYOND IT.” The last sentence was quoted by the Supreme Court from one of its own prior decisions.

See, also, *Keystone Bridge Co. vs. Phoenix Iron Co.*, 95 U. S. 274, pages 278 and 279.

Burns vs. Meyer, 100 U. S. 671.

Merrill vs. Yeomans, 94 U. S. 568.

Robinson on Patents, Vol. 2, sections 504 and 505. He says:

“The claim is thus the life of the patent so far as the rights of the inventor are concerned, and by it the letters-patent, as a grant of an exclusive privilege, must stand or fall.”

Another rule of law applicable is this. When the claim is for a combination of devices only, it does not cover either one of the mechanical elements named in

the claim, but in law admits all of those individual mechanical devices to be old and no part of the patentee's invention.

The Supreme Court, in the case of *The Corn Planter Patent*, 23 Wallace, 181, on pages 224 and 225, says:

“Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new. True, he or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, *the remaining parts are old*, etc.”

The pertinency of this rule of law appears when we read the complainant's testimony, and there find efforts made apparently to convince the Court that the *Jensen machine* is the invention covered by the patent, and the thing that deserves protection, although the claims of the patent which are alleged to be infringed are only claims for sub-combinations of devices. True, the testimony of its experts changes its tone in this respect in part, but the *Jensen machine*, as an entire machine and pioneer invention, is the burden of a great part of the testimony of complainant.

That there can be no infringement of a combination claim unless every one of the elements of the combina-

tion is used by the defendant was decided as early as the case of *Prouty vs. Ruggles*, 16 Peters, 336; and that decision has been followed ever since in numberless decisions.

In *Rowell vs. Lindsay*, 113 U. S. 97, on page 101, the Supreme Court says:

“The patent of the plaintiffs is for a combination “only. None of the separate elements of which the “combination is composed are claimed as the invention “of the patentee, therefore *none of them standing alone* “*are included in the monopoly of the patent.*” The Court then goes on and cites a large number of authorities, and quotes from the case of *Prouty vs. Ruggles*. See, also, *Walker on Patents*. Sec. 349. The cases hold, and we freely admit, that if one of the devices of the combination is removed and a mechanical equivalent of the device so removed is put in its place that it is still in law the *same combination*, and would be an infringement just the same as though the exact elements of the original combination were used. It is true that in many cases the use of mechanical equivalents are not to be allowed. This occurs in the cases of very narrow patents where the invention is very thin. We do not claim that the present is such a case, but expect the Court to read our brief with the understanding that when we mention a combination we include in it any mechanical equivalents or substitutes which might be put in place of any of the original elements omitted from that combination. As to

what constitutes a mechanical equivalent or substitute we will show later on.

On pages 103 and 104 of the foregoing case of Rowell vs. Lindsay, the Supreme Court says with reference to mechanical equivalents:

“We find, therefore, that the curved upper part of “the shank used by defendant does not perform one of “the material functions of the brace-bar of the plain- “tiff’s combination. It cannot therefore be the equi- “valent of the latter. For where one patented is as- “serted to be an infringement of another, A DEVICE “IN ONE TO BE THE EQUIVALENT OF A DE- “VICE IN THE OTHER MUST PERFORM “THE SAME FUNCTIONS.”

“As, therefore, there is one element of the plaintiff’s “patented combination which the defendants do not use “and for which they do not employ an equivalent, it fol- “lows that they do not infringe the plaintiff’s patent.”

A further rule of law is this: When the claim of a patent names an element as one of the elements of the combination which the claim covers, such element, no matter if it is entirely useless, cannot be abandoned by the patentee and his patent construed to cover the remaining elements as the combination patented. This rule is pertinent in view of the efforts made by the complainant to get rid of the Stop E, of claim one of the Jensen patent.

Above section 349 of Walker on Patents. (Second edition.)

In *Water Meter Co. vs. Desper*, 101 U. S. 332-337, the Supreme Court says:

“Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of those elements is immaterial. The patentee *makes them all material* by the restricted form of his claim.”

In *Fay vs. Cordesman*, 109 U. S. 408, on pages 420 and 421, the Supreme Court says:

“The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination, and the Court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality.” Citing authorities.

This Court quoted the above as an authority in *Wheaton vs. Norton*, 70 Fed., on pages 841 and 842.

Another rule of patent law is that a result or effect produced is not patentable, but only the means are patentable by which the result or effect is produced.

Claims must not be *functional* or they are void.

This point was decided as early as 1853 in the case of O'Reilly vs. Morse, 15 Howard, 62, in a case brought on the Morse telegraph patent. Morse had covered in his first seven claims of the patent his telegraphing apparatus. He then added his eighth and last claim, and in that he stated that he did not propose to limit himself to the specific machinery or parts of machinery described in his specifications and claims; the essence of his invention being the use of the motive power of the electric or galvanic current which he called electro magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which he claimed to be the first inventor or discoverer.

The Supreme Court says on page 113 of the case that: "In fine, he claims an exclusive right to use a "manner and process which he has not described, and "indeed had not invented, and therefore could not describe when he obtained his patent. The Court is of the opinion that the claim is too broad, and not warranted by law."

The Court held that the said eighth claim of the Morse patent was void for covering what he had not invented.

This case and others establish the further proposition that if the claims of a patent cover more than the patentee invented, or more than he has described in his

specifications such claims are absolutely void. On pages 120 and 121, of this O'Reilly vs. Morse case, the Supreme Court says:

“The evil is the same if he claims more than he has
 “invented, although no other person has invented it be-
 “fore him. He prevents others from attempting to im-
 “prove upon the manner and process which he has de-
 “scribed in his specification—and may deter the public
 “from using it, even if discovered. HE CAN LAW-
 “FULLY CLAIM ONLY WHAT HE HAS IN-
 “VENTED AND DESCRIBED, AND IF HE
 “CLAIMS MORE, HIS PATENT IS VOID.”

In Miller vs. Eagle Man. Co., 151 U. S. 186, on page 201, the Supreme Court says:

“It is not the result, effect, or purpose to be accom-
 “plished which constitutes invention, or entitles a
 “party to a patent, but the *mechanical means* or instru-
 “mentalities by which the object sought is to be at-
 “tained,” and further, “PATENTS COVER THE
 “MEANS EMPLOYED TO EFFECT RE-
 “SULTS.”

The law as declared in the authorities cited is also substantially declared by this Court in the case of Norton vs. Jensen, 67 Fed. 236, on pages 242 and 243, beginning as follows:

“These are all combination claims, and each is broad
 “enough to include every imaginable style of mechan-
 “ism for forming can bodies and soldering the side
 “seams thereof. SO REGARDED, THEY WOULD

“ALL BE VOID FOR FAILURE TO DESCRIBE
“ANY PATENTABLE INVENTION.”

The foregoing rules are elementary, and well understood. Their application and pertinency will be noted in the further parts of this brief.

Because of the strenuous efforts made by complainant and its counsel and experts, in the taking of the testimony, to make it appear that the Jensen invention is one of a primary and pioneer character, we will now discuss that proposition and will endeavor to show that it does not belong to that category of inventions, even if the patent had been made with claims that covered the machine as an entire machine, instead of containing only narrow claims for limited sub-combinations.

Every valid patent must cover an invention that is absolutely *new*. It must have been known to others before the invention thereof by the patentee. If the invention was known to others prior to the invention thereof by the patentee, then the patent would be void, as it would not cover any patentable invention. We are not speaking of cases where there have been any assignments, but of those cases where the inventor himself is the patentee.

Now, the condition that the patentable invention must be absolutely new with the patentee applies to the cases of pioneer inventions and primary patents and also with *equal force to the very narrowest* of inventions and thinnest of patents, alike. A narrow inven-

tion must be as new and as original with the patentee as must be the broadest and most pioneer of inventions.

So far, then, as the mere fact that the patentee was the first one that ever discovered or invented the thing patented goes, such fact belongs alike to narrow patents and inventions and to broad patents and pioneer inventions. In a *literal* sense the narrow patent covers an invention that is just as original and just as pioneer in its character as is the invention that the broad patent covers. One invention must be just as original and just as new as the other. If in this case the defendant's patent is valid, and so far no one has asserted that it is not valid, it covers inventions that are just as new as was Jensen's and just as original. The defendants were the first that ever made those inventions, and as to those inventions they were literally the pioneers.

While all this is so in a literal sense, the Courts have for convenience applied the adjectives *pioneer* and *primary* to some classes of patents and inventions to distinguish them from the great mass of inventions in which there is less in the nature of discovery and less breadth and depth of the original ideas which produced them.

There have been inventions made, in which the idea that a certain desirable thing was possible of accomplishment was first thought of by the inventor. The possibility of using an alphabet of any kind to record intelligible words at a distance by the use of electricity was new with Morse. The conception of the possibil-

ity of sewing a continuous seam automatically by machinery was new with Howe. The possibility of using steam to drive a boat was a new idea with Fulton. The almost wild conception of the idea of talking at a distance by the use of electrical apparatus was new with Bell.

In these and other instances of like character, the mechanism by which the new conception could be reduced to practical use, came second, and followed after the new conception. The new conception of a possible new result that had never been accomplished in any manner whatever was the important starting point. Without that as a foundation to work upon nothing new would have been discovered at all, but the whole subject matter would have remained in oblivion. Suppose Bell had never lived and his new conception of the possibility of talking at a distance through the medium of electrical wires had not been thought of by any one else, as it probably would not have been, the telephone would not yet have been dreamed of. The world had been running thousands of years, science had been advancing and developing wonders for generations, but no one had thought of the possibility of talking at a distance by means of any kind. The same may be said of other inventions of similar character where the new result was itself the foundation upon which the new invention was built. It was so with the Morse telegraph right now.

Yet, the new *result could never be the subject of a patent*, but only *the means* by which the inventor produced that result could be patented. This we have shown was demonstrated in the case of the Morse telegraph, in *O'Reilly vs. Morse*, 15 Howard, 62.

It has ever since the Morse case been an admitted fact that a patentee of a machine patent at least, cannot cover the result which his invention produces. It can only cover the means which the patentee has invented by which the result is produced, even in the extreme cases which we have mentioned where the result itself was, for the first time in the world, not only produced by the patentee, but was also originally discovered by the patentee. In the telephone cases the Supreme Court held that Bell's method included both a process and the means by which he operated the process, making the patent an improvement in an art, and also an invention in mechanics. The decision indorses the case of *O'Reilly vs. Morse*. See 126 U. S., pages 532 to 536, and authorities there cited by the Supreme Court.

Now, whenever the patent is for a process, or in other words for an *art*, it will be infringed when any kind of machinery is used to practice it. It makes no difference what mechanism or apparatus is used to practice the process with.

Walker on patents, section 335. Bell's telephone patent covered both mechanism and a process.

Telephone cases, 126 U. S., pages 532 and 533. For

this reason there is much said in the decision in the telephone cases that does not apply to a patent that covers mechanism only.

Now, it is evident that cases where the result itself is discovered by the patentee, as well as the means by which that result is produced, are cases in which the terms "primary" and "pioneer" are especially applicable, and that a patent which covers the mechanism that produces such pioneer result must necessarily be given a very broad construction in order to protect the discoverer and inventor in his discovery and invention. Patentees that first conceive of the possibility of a new result, and then invent the means by which they successfully produce the new result, are both discoverers and inventors.

In telephone cases, 126 U. S. patent, on pages 532 and 533, the Supreme Court after describing what Bell's art was, and how he had put it in a condition for practical use, says on page 533:

"In doing this, both discovery and invention, in the popular sense of these terms, were involved; *discovery* "in finding the art, and invention in devising the means "of making it useful."

Now, it is this class of inventors that are entitled to the fullest possible protection, and *as they cannot patent the new result, the only method by which they can be protected in it is by giving them the benefit of the doctrine of equivalents*, so as to cover the broad field of their discovery. They patent one form of means by

which their new discovery is made practical and useful to the world. Often, especially in the case of machine patents, there are many forms of mechanisms by which the new discovery may be utilized, and many of them will be better than the means particularly described in the pioneer patent. Unless the courts should decide that the invention included all the equivalents by that the invention included all the equivalents by which the new discovery could be reduced to practice the inventor would lose all benefit of his discovery and be compelled to accept the mere mechanism shown in his patent as the only thing covered by his patent, and this he would often lose because the later and better mechanism put his in the shade.

Primary and pioneer patentees having primary and pioneer patents **HAVE NO ADVANTAGE OVER OTHER PATENTEES OTHER THAN THAT OF BEING GIVEN GREATER SCOPE IN THE APPLICATION OF MECHANICAL EQUIVALENTS.** *This is their only advantage,* and even this would be lost if the doctrine of mechanical equivalents was applied in the same way to mere improvements on known machines, or to the accomplishments of results already well known.

Now we contend that it is such cases as those that we have mentioned in which the inventions and patents are held by the courts to be primary and pioneer. Compare the great discovery and invention of Bell with Jensen's invention, in which there was nothing in the na-

ture of a new result discovered, but only a modification of well known can heading machines produced, and how the Jensen modification shrinks into littleness by the contrast.

In the case of Morley Machine Co. vs. Lancaster, 129 U. S. 263, the Supreme Court says on page 273:

“Morley having been the first person who succeeded
 “in producing an automatic machine for sewing but-
 “tons of the kind in question upon fabrics, is entitled to
 “a liberal construction of the claims of his patent. He
 “was not a mere improver upon a prior machine *which*
 “*was capable of accomplishing the same general result;*
 “*in which case his claims would properly receive a nar-*
 “*rower interpretation.* This principle is well settled in
 “the patent law, both in this country and in England.
 “*Where an invention is one of a primary character, and*
 “*the mechanical functions performed by the machine*
 “*are, as a whole, ENTIRELY NEW,* all subsequent
 “*machines which employ substantially the same means*
 “*to accomplish the same result* are infringements, al-
 “though the subsequent machine may contain improve-
 “ments in the separate mechanisms which go to make
 “up the machine.”

The foregoing quotation, we think, states the rule fairly and correctly, and well defines what are primary machines. The invention was of a primary character. Probably no one else had ever thought of the possibility of producing a machine that would automatically sew buttons of the kind in question upon fabrics. His ma-

chine was the first ever produced that was capable of producing *the kind of result* which his machine produced. The ultimate general result produced by that machine was new. It was a machine in which the invention was of a primary character. It was a machine in which the *mechanical functions* performed by it *were as a whole entirely new*. It was one of the class of machines to which the terms primary and pioneer were properly applied. This is beyond doubt.

The number of these primary or pioneer inventions and patents are very few, indeed. Their number is extremely limited. Most patents are secondary and involve new methods and improvements upon existing machines. Sometimes such inventions are of very great importance. But the great majority of them are of so little importance that they are never put into practical use. Other things in use are better, and they have no practical value. We do not believe that one patent in ten, and probably not one in twenty, has any practical value, for the reason that what it covers is not wanted and is never used.

Now one of the cases where the patent covered a secondary, though a new, radical and important invention was that of *Clough vs. Baker*, 106 U. S. 166. Clough had invented a method of applying a bat wing burner to the burning of carburetted or air gas, which was a gas that flowed with a variable density from the generator which produced it. With the bat wing burner Clough used a valve for regulating the gas sup-

ply. He was the first to apply *any kind of a valve regulation* to the combination, and the Supreme Court held that as he was the first to make the combination and the first to apply a valve regulation *of any kind* to the combination, he was entitled "to hold as infringements all valve regulations, applied in such a combination, which perform the same office in substantially *the same way* as, and were known equivalents for, his form of valve regulations." Pages 177 and 178.

Now, in this case the Supreme Court applies the doctrine of mechanical equivalents, but *it does not treat the invention as one that comes under the head of primary or pioneer* inventions. Not a word is said in the decision about *primary* or *pioneer* inventions. Important and radical as the invention was, it was only an improvement in the method of regulating the flow of carburetted or air gas, which was a gas that flowed with a varying density. The same gas had already been flowing through other burners and was, of course, regulated in its flow, to some extent, by the ordinary valves which turned on, and limited the supply of gas that flowed through the burner. The invention and patent were secondary and not primary or pioneer, but an important improvement and advance forward, in an art already developed and in common use. See the beginning of the specifications of the patent on page 165 of the decision.

Another case which has been often cited in other cases by complainant's counsel, and in which he has

claimed that the patent on which the suit was based covered a pioneer invention, is that of Consolidated Valve Co. vs. Crosby Valve Co., 113 U. S. 157. The patent in that case was for improvements in safety valves in steam boilers. Safety valves were old in steam boilers, but a trouble existed with them from the fact that when they were lifted and opened by the pressure of steam in the boiler they would not close until the pressure of the steam in the boiler had been greatly reduced, resulting in a loss of power, and also loss from the increased amount of fuel required to again raise the steam to its working pressure. The inventor, Richardson, invented a safety valve that was a very great and radical improvement over any that had preceded his. The supreme court sustained the patent and applied the law of mechanical equivalents to broaden its construction, when passing upon the issue of infringement. Still, when all of this was done it did not bring the invention under the head of primary or pioneer inventions. As the opinion of the Supreme Court in the case shows, the field of safety valves was already open and largely occupied, but when the Richardson safety valve came into that field, it captured it, because of its great superiority over all other safety valves. In its decision the Supreme Court does not once pronounce the invention to be of a primary or pioneer character. It was a machine patent, but it was not a machine in which "the mechanical functions performed by it were, as a whole, entirely new." It opened when the pres-

sure of steam was too great, just exactly as the prior safety valves had opened when the pressure of steam was too great. This opening was one of the necessary and mechanical functions which it performed, and it was not new. It also closed when the steam pressure was reduced, as others before it had closed, but it had new mechanism and closed much quicker than the others had closed, and before the steam pressure was so greatly reduced. There was only a difference in degree between its ultimate results and the ultimate results of prior safety valves. The Supreme Court did not intimate that "the mechanical functions performed by it were, as a whole, entirely new," and did not apply to it either one of the adjectives "primary" or "pioneer". We have referred to the foregoing cases because complainant's counsel has heretofore cited them as illustrations of what he calls primary and pioneer inventions, and we presume he will do it in this case. We wish to point out the distinction between these cases and those in which the Supreme Court has applied the terms primary and pioneer inventions, such as the Bell telephone and others where the very conception of the subject matter to which they applied was new and such subject matter was itself created by the inventor. Discovery as well as invention is required in those cases which the Supreme Court has classified as primary and pioneer. As before remarked, in a literal sense, every patentable invention must be new with the inventor, and hence, in a literal sense, is primary and pioneer, but only a

very few of them come within the requirements that will place them within the category of primary or pioneer inventions and patents, as the Supreme Court has defined and classified primary and pioneer inventions. This classification is original with the Supreme Court, and that Court has declared what conditions and qualifications of an invention are required in order to place it within the classifications of an invention of primary and pioneer. Among other things primary and pioneer inventions must be absolutely the *first in the art* to which they appertain. They must be the first to produce the *kind of result* which they produce. Probably there is not one patent in a thousand that comes within the classification of pioneer or primary, as those terms are used by the Supreme Court.

Take such extreme inventions as the Howe sewing machine that was the very first machine to sew a continuous seam automatically, or the Morse discovery and invention which created the first telegraph and first discovered the principle upon which a telegraph was possible of construction and operation, and invented and applied mechanism so as to reduce and harness the discovery to practical use for the first time in the world, or the Bell telephone, or Fulton's invention and discovery that steam could be made to drive boats, and it would be strange if the Courts had not used some terms that would place them in a special class that would distinguish them from the great mass of inventions which were not the first in the art to which they belonged, and

in which there was no creation of the result accomplished, but only an improvement in the means of accomplishing known results, and means for increasing the speed, and cheapening the processes, by which known results were produced, inventions that increased the degrees to which known results could be carried, &c., &c., &c. All of these latter kinds of inventions are secondary in degree as compared with the former.

The foregoing rule which we have quoted from the Morley case we claim to be correct when applied as the Supreme Court applied it.

The rule, however, applies to a machine as *an entire machine* or to a device as *an entire device*, and has no application to combination claims. In the case of Fuller vs. Yentzer, 94 U. S. 288, the Supreme Court, in speaking of combination claims, on page 297, says:

“Such an invention, if it produces a new and useful result, is the proper subject of a patent, and such a patent is valid and operative; but the right of the patentee under it *differs* in one respect from those of a patentee for an invention which *consists of an entire machine, or of a new and useful device*, as the rights of a patentee for a mere combination of old ingredients are not infringed, unless it appears that the alleged infringer made, used, or sold the entire combination.”

See, also, Waterbury Brass Co. vs. Miller, 5 Fisher's Patent Cases, on page 69.

Smith & Griggs Mfg. Co. vs. Sprague, 123 U. S. 249, last seven lines on page 255, and first two lines of page 256.

Curtis on Patents (Edition of 1867), sections 110-111 and 239.

Other decisions have been made construing patents in cases in which the patents covered machines or devices as *entire machines* or *entire devices*, and *were not patents for combinations only*. In the case of McCormick vs. Talcott, 20 Howard, 402, the subject matter of the patent was a divider, used on a harvesting machine for separating the stalks of grain that were to be immediately cut by the harvester from those that were not to be cut. The Court says, page 405: "If he be the "original inventor of the device *or machine* called a "divider," &c. This was treating the divider as an entire device or entire machine.

The Supreme Court further says on the same page:

"But if the invention claimed be itself but an improvement on a known machine by a mere change of "form *or combination of parts*, the patentee cannot treat "another as an infringer who has improved the "*original* machine by use of a *different form or combination performing the same functions*. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the "first."

In *Winans vs. Denmead*, 15 Howard, 330, often cited by complainant's counsel in other cases, and we expect it will be in this the thing patented was a car body made conical shape, &c. Before that time car bodies for carrying coal had to be made so strong that a car could not carry more than about its own weight of coal. The coal, in rectangular vertical car bodies would keep packing down wedging between the sides of the body from the constant jar of the car until the pressure against the vertical sides and ends of the body was enormous. By making the car body conical shaped the packing down and wedging of the coal was prevented and cars could carry very much larger loads. The car body, however, was a *single device*, and the Court applied the rule of construction to it as a single entire device. In this case the word *form* was used as referring entirely to *shape*. The *form* of the car body was its *shape*, and it was the shape of the body and the discovery of what new effects that shape produced that constituted the invention. This case is no authority whatever for the position that the form of an *operative combination of mechanism* includes *other forms of mechanism*, merely because both forms produce the same effects. We can properly speak of the form of two machines being alike, and also that other machines for doing the same kind of work are of another form. It would be perfectly right to speak of the Jensen form of can header and also, in contradistinction thereof, to speak of another machine as being of the Burpee and

Letson form of machine. It would be good English, we believe, to speak of one heading machine as being of the *intermittent form*, and of another as not being of the intermittent form, but as being of the *continuously operating* form. In neither of these cases would the term form mean shape as it did in the car body case.

We will now proceed to apply the rules of law fixed by the authorities to the complainant's testimony in this case. So far the complainant, both in taking its testimony and in its arguments, has asserted that the Jensen machine was the first one that ever successfully headed filled fish cans, and has in this way indirectly, if not directly, represented that the Jensen machine as an entire machine was the thing patented. We find this fallacy running through a great part of the complainant's testimony. The conclusion which it evidently hopes will follow, is that the Court will decide that the Jensen machine was the first one that would successfully head filled fish cans, and that if the defendants' machine will do the same work, that then the defendants' machine must be an infringement of the Jensen patent.

We therefore here remind the Court that there is no patent on the Jensen machine as an entire machine. The patent covers only sub-combinations of mechanisms which are contained in the machine. When the witness L. W. Seely, complainant's expert, was testifying, he, on cross-examination, was driven to stating the fact that the organization of the defendants' machine was different from the organization of the Jensen ma-

chine; he, for the evident object of showing that this organic difference between the two machines did not affect the complainant's rights *under the patent*, at once testified that his "statement should be taken with the qualification and explanation that in the Jensen machine, or rather in the Jensen patent, *there are no claims to the organization of the machine*, but that *each claim is devoted, to a part of the machine, to a sub-combination,*" &c. Record, page 224.

On the same page Mr. Seely admits that in his direct examination he had explained the *general operations and objects* of the two machines *as entire machines for the purpose of making it appear that there was an infringement.*

We therefore urge that as the complainant has no patent that covers the Jensen machine as an entire machine that the evidence as to the merits of the machine as an entirety has no pertinancy or relevancy as competent testimony tending to show whether or not the claims for the sub-combinations had been infringed.

All that mass of testimony which extolls the Jensen machine to the higher elevations, should be disregarded. The Circuit Court in its opinion in this case stated the rule correctly, as we think. See page 440 of the record. But we also think that it did not apply the rule in making its decision for the reason that it seems largely to have based its decision upon the merits of the machine as an entire operative machine. See page 456 of the record, where the Jensen machine as an en-

tire machine is highly eulogized by the Court. The Court there says of the machine, "Its merits is such as to require liberality in construing these claims." etc.

THE JENSEN MACHINE WAS NOT A PIONEER MACHINE.

The Jensen machine, after all that can be said in its favor, was only a can heading machine. It put heads upon cans and it did not do anything else. We are leaving off its crimping mechanism as that is not involved in this case, and we speak of the heading apparatus alone.

In heading cans the Jensen machine used largely devices and apparatus which had been used in well known prior can heading machines. In its operation it did not produce the smallest fraction of any new ultimate result. It headed cans in a vertical position, but heading filled cans in a vertical position was a result that had been already accomplished. This result had doubtless been accomplished by hand and without any machine thousands of times. That cans had been filled with fish and then headed by hand is proved in the case and by the complainant's witnesses. Bradford swears to its being done. Record, pages 54 and 55. Robbins swears to it. Record, page 63. Munn swears to it. Record, page 269.

Of course the machine would head the can just the same whether there was fish in it or not. It would put a head on an empty can. It made no difference to the

machine whether there was any fish in the can or not.

What we are now showing is for the purpose of contrasting the Jensen machine with those machines called primary and pioneer in which the *ultimate result* produced by the machine was absolutely new, and was produced for the *first time in the world* by the machine itself; such as the Howe sewing machine, etc. We are not trying to invalidate the Jensen patent, but are getting at its proper construction. For this purpose we are showing that it was not a pioneer can heading machine.

The only ultimate result produced by the Jensen machine was that of heading cans by mechanism. This was not new either in whole or in part. This result was old and well known. The Jensen was not a pioneer can heading machine.

Neither was it the first machine that would head cans in a vertical position. The Marsh machine, which is described in the Marsh patent that is in evidence in this case as Exhibit A, did it. The patent is in the record, pages 256 and 257 and 535 to 539.

A full sized model of the Marsh machine is in evidence, as Exhibit F. Record, 334.

This Marsh machine is well explained by Mr. Burpee in the record from page 334 to page 336. On the latter page he testifies that he has just headed a can in the Marsh machine, *and that it would head full fish cans just as perfectly in all respects as the Jensen machine does or ever could.*

Another prior patented machine that is in evidence, and which headed cans in a vertical position, is that of E. Jordan. His patent is in evidence as Exhibit B. Record, pages 328 and 541 to 550.

This Jordan patent was issued in October, 1884, between three and four years before Jensen applied for his patent.

A full sized model of this Jordan machine is in evidence as Exhibit E. Record, page 329.

This Jordan machine is explained by Mr. Burpee as shown in the record from page 328 to page 334. While giving his testimony Mr. Burpee headed a can in the Jordan machine. Record, 329; and he explains the action of the machine, and its working parts, while it is going through the process of heading the cans, beginning on said page 329.

The Court will understand that we are not attempting to invalidate the claims of the Jensen patent which are sued upon. Those claims are limited to sub-combinations of devices, and such sub-combinations of devices are not in the defendants' machines and never have been. This is sworn to not only by Mr. Burpee, but also by both of the complainant's expert witnesses, F. E. Monteverde and L. W. Seely, as we will show more fully when discussing those claims. We are presenting the Marsh and Jordan prior machines for the purpose of showing the state of the art at the time that Jensen made his invention. We do this for the purpose

of showing that the Jensen machine does not belong to that class of inventions which the Supreme Court has classified as primary and pioneer, and to show that the complainant's assertions are not based upon fact.

Now in both the Marsh patent and in the Jordan patent the machines headed cans in a vertical position. The Marsh patent speaks of its machine as follows:

“The purpose of my invention is to provide a convenient device for heading cans. In packing goods in open-top cans the cover must be placed upon the can *after the can has been filled, and consequently while it is in an upright position.*” Record, 538. Here we have stated the subject matter, and the whole ultimate object that the Jensen machine was intended to accomplish. That very statement could have been put into the Jensen specifications and it would have been pertinent and it would have been a true statement of everything that the Jensen machine was expected or intended to accomplish, and *of every thing that the Jensen machine ever did accomplish.*

Not only this, but the Marsh *machine* actually accomplished the entire ultimate object that the Jensen machine accomplished. That ultimate object was the heading of filled cans in a vertical position.

Neither were the means used to accomplish this ultimate object so entirely new with Jensen. Jensen used a conical guide through which he forced the end of the can body into the flange of the head. Both the Marsh machine and the Jordan machine did exactly

this same thing. Both used conical guides through which the end of the can body was guided and forced into the flange of the can head. The Jensen machine had mechanism by which the end of the can body was forced into the can head. So did both the Marsh machine and the Jordan machine.

That the Jensen machine was differently organized from the Marsh and Jordan machines we admit, but while this is so, it is also true that he used, in planning and constructing his machine mechanism that operated in forcing the end of the can body into the flange of the can head substantially, and, we think we may truthfully say, exactly the same as did the mechanism of the Marsh and Jordan machine operate in guiding and forcing the end of the can body into the flange of the can head. In all the machines the ultimate object accomplished was the forcing of the end of the can body into the flange of the can head, and in all of the machines this ultimate object was accomplished by using a conical guide through which the end of the can body was rounded and guided into the can head flange, and in all the machines further mechanism was employed to force the end of the can body into the can head; all done while the can was in a vertical position. Besides all this, we remind the Court that the same general mode of operation was in many machines that were used for heading cans in a horizontal position. The application of the same mechanism for heading cans in a vertical position that had been used for head-

ing cans in a horizontal position was at the most but the application of the mechanism to a new use that was strictly analogous to its prior use. That this could not constitute any patentable invention is an elementary rule.

Curtis on Patents, sections 49 to 57, and 66; edition of 1867.

Further, the specifications of the Jensen patent show that he did not himself suppose that he was inventing an entire machine, or that he was originating a pioneer invention. His specifications say:

“My invention relates to a machine for capping and crimping cans; and *it consists in certain details of construction*, which will be more fully explained by reference to the accompanying drawings, &c. Certainly “details of construction” do not make a new machine nor a pioneer and primary invention.

The complainant’s expert, Mr. Seely, describes the Jordan machine, but with a hostile sentiment running through his description. Still he states that in its heading operations a swinging horizontal chuck carries upon its end a sectional chuck. That it is a stop motion machine. That the chuck is made in segments that move backwards and forwards towards and from the center. That there is a recess in the chuck in which the can heads are placed with the flanges down, with ledges underneath to hold them in that position while the can is being headed, and that below the recesses there is an inclined or hollow or conical guide which

directs the upper end of the can bodies into the flange of the can head.

He testifies that the arm which carries the chuck swings back and forth and moves up and down. That the chuck grasps a can head which has been placed by hand upon a boss on a revolving disk D. That the swinging arm and chuck then rise and swing back to a position over another disk on which the cans have been placed in a vertical position. The swinging chuck is then made to descend and force the can head upon the can body. The jaws of the chuck then open and the swinging arm and chuck then rise, a spring plunger within it keeping the headed can from rising with it, and acting as a releasing device for the headed can. That in the Jordan patent there was mechanism for automatically opening and closing the chuck.

Record, 258 to 261.

On page 260, he testifies that the swinging arm and chuck of the Jordan machine "only did what had formerly been done by the bench headers operated by foot power." This shows how very common was the use of the conical guide for conducting the upper end of the can body into the flange of the can head in the heading of cans. We think that this use was so common that we might fairly ask the Court to take judicial notice of it, and also take judicial notice of the fact that in its use in bench headers, or, what is the same thing, its use in foot headers, the cans were headed in vertical position.

In Mr. Burpee's testimony he describes the operation of the Jordan machine. Record, pages 328 to 334.

He put a full sized working model of the Jordan machine in evidence as Exhibit E. The model is made largely of wood, but it shows the full operation of the machine. Mr. Burpee headed a can in the model and he explains the operation seriatim. Record, 329-330.

In heading the can its upper end was guided into the head by a conical guide. The can was in a vertical position. If it had been filled with fish it would have been headed just the same. The can was kept in a vertical position all the while that it was being headed.

The conical guide of the Jordan patent is there called a segmental clamp chuck, and is marked m. It is shown plainly in figures 16 and 19. Figures 13 and 14 show a plain view of the same. Record, 332.

In the Jordan machine the can is not raised to receive the cap but the cap is forced down upon the can. When the segmental clamp chuck was swung around by the arm A, over the can head the chuck was open, and was sufficiently enlarged to pass down outside of the can head. After it descended upon the cap it was closed to grasp and hold the can head. It was so closed by the mechanism of the Jordan patent and it then formed a conical guide that would force the upper end of the can into the can head. Record, 333.

When the chuck was closed there was a seat formed which received the lower edge of the can head flange

and held the can head in position. All of these things are fully described in the Jordan patent. Record, 334.

Mr. Seely tried to make a point by saying that the Jordan machine has no automatic feed beyond a set of disks upon which the heads and cans must be placed by hand. Record, 259. Admitting this to be true, the fact remains that those *disks are automatic feeding disks*, and it is also true that in the Jensen machine and in the defendants' machines the cans and heads must be placed *by hand upon their feeding devices*, which are the feeding belts, and the Jensen inclined chute for the heads.

The witness Robbins seemed to think that the Jensen machine received the filled cans automatically from the Jensen can filling machine. Record, 64. But in this he was mistaken. The filled cans were taken *by hand* from the can filling machine and slammed down on their bottoms to settle the fish down more in the can, and then they were placed by hand on the feeding belt of the Jensen machine. One man did nothing else. Record, pages 358 and 359.

The complainant's witness William Munn, who has been actively connected with the business for many years and had an actual and intimate knowledge of the entire process of packing salmon, swears that in practice the cans do not pass from the can filling machine to the feeding belt automatically. That when the cans are filled with the fish they are in a horizontal posi-

tion. The fish inside of it is stiff enough *so that it will not run out*. Record, 283. The cans are not always well filled and are therefore examined, before they are placed on the feeding belt, to see if they are well filled, and when they are not they are placed one side. When the can goes down from the can filler "a man has got to take it from a horizontal position, and he has got to put it in a vertical position," and, "that is all the man does; that is what he is there for; he takes this can from a horizontal position and puts it on the belt in a vertical position," etc .Record, page 283. See also pages 284 and 285 for still further facts on the same point.

Mr. Robbins was simply mistaken in his testimony. The complainant's feeding belts in the Jensen machines were themselves fed by hand.

Mr. Seely also describes the Marsh machine, which he says is a *foot machine* for heading cans in an upright position. That it has a hollow conical guide for guiding the upper end of the can into the can head. Also a seat or ledge for the flange of the can head to rest upon when the jaws are closed and while the can is being forced into the jaws, and also a plunger that operates to drive the head upon the can body.

The testimony of Mr. Seely agrees with that of Mr. Burpee shown in the record, pages 334 and 337, as far as it goes. The said testimony of Mr. Burpee is much fuller. Both show that the Marsh machine headed

cans in a vertical position and that it would head filled fish cans:

“Just as perfectly in all respects as the Jensen machine does, or ever could.” Record, page 336.

Without pursuing this particular subject further we respectfully submit that, whatever merit the Jensen machine may have had, either as an improvement on other prior machines, or as an improved machine, it still was not the first machine that ever headed cans. Neither was it the first machine that was used to head cans in a vertical position. Neither was its most important features, viz: the conical guide with its opening and closing slides for first receiving and holding the can head when the slides were closed, and then by opening the slides releasing the can head, with mechanism for automatically opening and closing those slides, new in the Jensen machine. In short it was not a primary or pioneer machine, or the production of a primary or pioneer invention or discovery.

We further believe that we have shown that the Jensen patent does not cover an *entire machine*, and that therefore the question as to whether the defendants' machine as an entire machine involves the principle and mode of operation of the Jensen machine is not a material question in this case. At least it is not a material question any further than such fact may tend to show whether or not the combinations of the claims sued on, or some of them, are in the defendants' machines. It is not a material question for the purpose of

deciding whether or not the defendants' machine would be an infringement of the complainant's patent if that patent claimed the Jensen machine as an entire machine, and as the first machine that ever accomplished the result of heading cans in a vertical position or at all. A comparison, however, of the machines as entire machines may be proper, for the purpose of showing whether or not the combinations of the claims sued upon are in the defendants' machines. If the comparison of the two machines as entire machines proves that the combinations of the claims sued upon are not in the defendants' machines and could not be placed in defendants' machines without destroying their operation, such comparison is proper. But, if the comparison is made for the purpose of *jumping over the claims sued upon* and asking for a decision that could only be made by comparing one machine with the other, *ignoring the limitations of the claims* sued upon, and holding that, if the two machines do the same work, infringement follows without regard to the differences in the mechanisms employed, then we say, that the comparison for such purpose is improper, for the reasons that the Jensen patent does not cover the machine as an entire machine; and also because the Jensen invention is only a modification of well known can heading machines, and does not fall within the category of primary discovery, or pioneer inventions, as those terms are used by the Courts in classi-

fyng, and distinguishing between, the different grades of discoveries and inventions.

We will now proceed with an examination of each one of the several claims which are alleged to be infringed, following the order pursued by complainant's counsel in the examination of his experts.

The first claim of the patent sued on is claim one. It is as follows:

“An endless traveling carrying belt, a stop, E, extending across it to change the direction of the cans, and arms swinging over the belt, whereby the delivery of the cans from the belt to the feeder is rendered exact, substantially as herein described.”

Of course this is a combination claim, and its mechanical elements are:

1. The endless traveling-belt.
2. The stationary stop E.
3. Arms swinging over the belt. Unless each and every one of these three elements are in the defendants' machine the claim is not infringed.

The defendants' machine has the endless traveling carrying belt. This we admit. It also has fingers for regulating the travel of the cans on the belt to the feed wheel 36. These fingers, however, are very unlike the swinging arms of the Jensen patent. But we deny most emphatically that the defendants' machines have the stationary stop E, which is one of the most prominent

of the mechanical elements of the combination of the first claim of the complainant's patent, or any equivalent thereof.

The complainant's experts testified without ever having seen the machines at work and they have drawn on their imaginations, and strained every nerve to make out that the constantly moving sides of the defendants' revolving feed wheel 36, constitute mechanical equivalents of the stationary stops E, of said claim one.

Mr. Monteverde, one of the complainant's experts, to make the description of the machines of the two patents more lucid, has made thirteen drawings which are put in evidence, each one being marked "Complainant's Exhibit Montervede Drawing," and adding to each of the drawings its respective number. They are in the Record, pages 493 to 505. Their numbers are: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 10a, 11 and 12.

Of these drawings numbers 1, 2, 3, 4, 5 and 6 represent various parts of the Jensen patented machines, and the other numbers represent various parts of the defendants' machines.

Of these drawings, No. 1, page 493, is made to represent the combination of said claim 1 of the Jensen patent. It is made from the drawings of the Jensen patent and is like those drawings, except being somewhat enlarged. The drawing has two figures. See record, page 75.

Beginning on page 72 of the record, Mr. Monteverde gives a general description of the Jensen machine and its operations and the operation of its various devices and combinations.

Beginning on page 74 of the same, he describes the stop E, and other matters. On page 74 is described the feeding device F, and from page 75 to page 78 are further descriptions of said drawing No. 1.

The cross-examination of this witness regarding said first claim is in the record, from page 138 to page 156. Upon this testimony as well as that of the complainant's other expert L. W. Seely we think we could safely rest our case. The facts which they state show that there has been no infringement, and wherein they state opinions that conflict with the facts, their opinions are so manifestly absurd that no Court would give them any serious consideration in deciding the case. The said cross-examination of Mr. Monteverde well illustrates this.

On page 138 the witness says that the stop E is one of the elements of said claim 1. On the next page he states that the cans travel on the carrying belt until they are stopped by the stop E, and that after they are so stopped they are taken by the feeder F, and carried off of the belt. This is correct and shows that the stop E is a device that comes between the carrying belt and the sweeping feeder F, with its arms H. The witness asserts that part of the outer periphery of the defend-

ants' revolving feeder 36, lies directly across the path of the can as it is carried inwards by the traveling belt and holds it there until in the further revolution of this feeder 36, one of its concave cavities, or pockets as we have called them, marked 36a, comes along and takes the can and removes it from the belt and carries it along in its course towards its delivery on to the can support 19. Record, 141. This can support 19, as it is called in the defendants' patent, the witness chooses to call the plunger 19. This is a misnamer, and is obviously applied so as to make it, in name, resemble the plunger S, of the Jensen patent. The misnomer is without warrant.

The witness admits that the edge of the revolving feeder 36 is a part of the feeder itself. He also admits that there is no stop between the belt and the feeder 36. He says that "*The actual stationary stop is not there,*" but claims that in place of it the outer face of the rotating carrier 36. Record 141 *et seq.* On page 142 the question is asked the witness:

"Then the stop E, which is put in the complainant's patent to stop the cans on the belt before they come in contact with any part of the feeder F, is not in the defendants' machine at all, is it?" and the answer is, "*It is not.*"

On page 144 this witness says that the defendants' feeder is so constructed that *it does not require* any stationary stop like the stop E of the Jensen machine.

On and after this page 144 the witness asserts that the side of the revolving feeder 36, of the defendants' machine, does in fact bring the can to a standstill on the belt before it is carried away from the belt in the pocket 36a of the feeder. In this statement he is proved to be in error. The witness had never operated or seen operated either the Jensen machine or the defendants' machine, and has no practical knowledge of either. Record, page 121.

The operation of the defendants' machine that is in evidence proves that the can body does not stop its forward motion from the time that it has passed the spacing fingers over the carrying belt until it is discharged, headed, from the machine. To make this fact certain and beyond question we put the defendants' machine, Exhibit C, in evidence, and had the defendant Burpee make a full explanation of it and its operations throughout. Record, pages 290 to 295.

Burpee explains stop E of the Jensen patent, and testifies that there is no stop of that kind in defendants' machine. On page 299 a full sized working model of the Jensen machine is put in evidence as Exhibit D, with the numbers pasted on the various parts of the machine, the same as in the Jensen patent.

On the said page 299 and the following pages the witness demonstrates that the Jensen machine could be operated without the stop E in it. He does this by taking the stop E out of Exhibit D and heading a can

in it without the stop in it. In such a case the can was carried on the belt until it came in contact with the feeder F, which stopped the can, until, in its sweeping movements, it carried the can off of the belt and one step forward, leaving it there until the further sweeping movement of feeder F carried it still another step further along, following the same number of forward movements, until the can was headed, that was followed when the stop E was in the machine. The movements of the can were of greater length forwards and backwards in the direction parallel with the belt when the stop E was out than they were when the stop was in the machine.

This certainly proves that the stop E is a device that is in the Jensen patent, and that its place and operation is between the carrying belt and the feeder F, which carries the can off and away from the belt. That there is no kind of stop of any nature **whatever** between the carrying belt of the defendant and the feeder which carries the can from off the belt is beyond any doubt whatever. In the defendants' machine there is no device of any nature or kind between said belt and said feeder 36.

Monteverde so swears. Record 141. Seely so swears. Record 237 to 243. Burpee so swears. Record 303 and 304. On pages 303 to 305 Mr. Burpee swears positively that the stop E, of the Jensen patent, has never been in any of the defendants' machines nor any equivalent of it, and that the combination of said claim one of

the Jensen patent is not in the defendants' machines, nor has it ever been in any of them. His cross-examination strengthens these statements. Record 374 *et seq.*

We think it is obvious that no rigid stationary stop could be put over the carrying belt in the defendants' machine without destroying the operation of the machine. The can must be allowed to travel forward on the carrying belt until it reaches the bottom of the pocket 36a, which is at the back end of each of the four sides of the skeleton feeder wheel 36. As this pocket and the can come together, the forward movement of the belt carrying the can blends with the new side circular movement of the pocket, and the can, without ceasing its movements, is carried away from the belt. Evidently if a stationary rigid stop of the character of said stop E was interposed to stop the forward movement of the can, the can could not get into the bottom of said pocket, and the heading operation of the machine would be broken up. Even in the Jensen machine the feeder F could not be used if it had a circular motion like the defendants' feeder wheel 36.

The complainant's feeder F, could not be used in the defendants' machine, nor could the feed wheel 36 of the defendants' machine be used in the Jensen machine. This fact is not only obvious, but the witness Seely so testifies. Record 243.

Monteverde swears to about the same thing. He testifies that the arms H are necessary elements of Jen-

sen's feeder F, and that neither those arms H, or the stop motion of the Jensen machine are in the defendants' machine, and he does not see how the feeder F could be incorporated into the defendants' machine without destroying its action. Record 157 and 158.

But further than this, the side of the feeder 36, does not stop the can, at any time or place.

There are four sides or edges to the feeder 36, in the defendants' machine. Each one of these sides is formed in a sort of double circular line, and the part of the side where the can first comes in contact with it, is farther from the central axis 15 around which the feeder revolves than are the other parts of the side against and along which the side of the can slides, as it remains upon the carrying belt which keeps pushing the can against the feeder's side until the pocket, 36a, of the feeder takes the can and carries it off the belt. The consequence of this shape of the feeder's side is that the can keeps on moving forward and under motion all of the time that it is on the belt. By actual test and measurement the can moved forward one inch and three-quarters while it was in contact with the side of the feeder.

Because the experts Monteverde and Seely had given it as their opinion that in the defendants' machine the can was stopped on the feeding belt for a moment of time, when it came in contact with the edge of the feeder 36, Mr. Burpee, while on the witness stand, headed a can in the defendants' machine, and proved

by actual demonstration that the can did not stop but actually moved forward one inch and three-quarters after it came in contact with the edge of the feeder 36, and that it did not stop at all. Its forward motion was retarded but not stopped. No attempt was made to contradict this demonstration, but we believe that it has been acquiesced in by the complainant's counsel. It has not been asserted that the cans made any stop on the defendants' feeding belt since said demonstration which was made in Mr. Seely's presence.

Record pages 302 and 303. On the last page, 303, Mr. Burpee testifies that the witnesses Monteverde and Seely were mistaken in their statements made to the effect that the cans were stopped on the defendants' feeding belt. It was mere guess work with them, as neither of them had ever seen the machine work at the time they gave their testimony. Mr. Monteverdeswears that he had never seen either the Jensen machine or the defendants' machine operate. Record page 121. Mr. Seely also swears that he had never seen either of the machines operate. Record page 223. Later, at the said demonstration Mr. Seely did see it operate, and he has not since, to our knowledge, asserted that the cans did stop on the defendants' feeding belt. This fact destroys so much of the opinions of said experts as was based upon their belief that the cans did so stop.

The testimony on the said pages proves positively and conclusively that the can does not stop in the defendants' machine while it is in contact with the edge

of the feeder 36; that the can during such contact moved forward one and three-quarters inches; that both the complainant's experts, Monteverde and Seely, were mistaken in their opinions to the effect that the said feeder 36, did stop the can for an instant of time, and it also shows that the defendants' machines never have had the stop E, of the Jensen patent in them nor any mechanical equivalent thereof.

We think that the testimony of Mr. Seely also proves that the stop E is not in defendants' machines. Mr. Seely was one of the complainant's experts, and was doing all that he conscientiously could to make out an infringement against the defendants. Still he stated facts as to what was described in the complainant's patent as to what the defendants' machines contained as the same were described in the defendants' patent and in the testimony.

On pages 236 and 237 Mr. Seely testifies that the edge of the feeder 36 is not concentric with its center, which is the spindle of 35. Also that that part of the edge of the feeder which is over the belt is moving slightly forward lengthwise of the belt. The can of course follows this forward motion while it is in contact with the edge of the feeder.

Mr. Seely testifies that complainant's claim that the rotating feeder 36, of the defendant's patent is the thing that corresponds to the Jensen feeder F. Yet that in the Jensen machine the fixed immovable stop E, comes

between the carrying belt and the feeder F. That the stop E, is no part of the feeder F, or of the feeder frame. Also that in the defendants' machine there is no stop that comes between the carrying belt and the feeder or feeder frame. Record, 247 to 243. On page 243 of same Mr. Seeley states that it would be "absolutely impossible to take the feeder out of defendant's machine and put it into the plaintiff's." It is equally certain that the sweeping feeder of the Jensen patent could not be used in the defendants' machine.

We think that we have shown by the testimony beyond a doubt that the stationary stop E, of said claim I of the Jensen patent is not in the defendants' machine and never has been, either as shown in the patent or in any equivalent form. If we are correct in this, then the defendants have not used the combination of said first claim, and have not infringed it.

It would seem to make no difference whether the feeding fingers of the defendants' patent and machines are the mechanical equivalents of the swinging arms of the said claim 1 or not, since the combination has not been used by the defendants, even if the said spacing fingers used by defendants were exactly the same as the Jensen swinging arms. As none of the other claims of the Jensen patent which are asserted to be infringed have the said swinging arms as one of their mechanical elements, it is immaterial so far as any of those claims are concerned whether the spacing fingers of the de-

defendants are, or are not, different from the said swinging arms.

Still, that they are different is shown by the testimony found on the following pages: 322, 324, 325, 371, 372 and 373.

They are not actuated the same nor by the same kind of mechanism.

The next one of the complainant's claims which is asserted to be infringed is claim 3. It is as follows:

"In combination with a transverse belt, the *feeder having the projecting arms* between which the cans are received from the belt and the *actuating devices* by which the motions of the feeder are produced, substantially as herein described."

The feeder of this claim is of course the feeder F.

The defendants' machine does not have the feeder F, nor any feeder having projecting arms between which the cans are received from the belt, nor does it have the actuating devices, nor any of them, by which the motions of the feeder F are produced. To make any pretense that the defendants' machines or any of them infringe the foregoing claim is as monstrous as it is absurd and ridiculous. There is no feeder having the projecting arms between which the cans are received from the belt in the defendants' machines and never has been. No device or devices of the defendants' machine performs the operation that the feeder F performs or that has its motions produced by the actuating devices that

produce the motions of feeder F. The feeder F has a sweeping circular movement peculiar to itself. It does not have an axis of its own around which it revolves. It does not revolve around a center of its own. Its actuating devices are the cranks JJ and I. With these cranks actuating the feeder it could not possibly revolve around its own center. The defendants' feeder, the wheel 36, which is claimed to be the equivalent of the Jensen feeder F, does revolve around its own axis—its own center, the shaft 35. To put the cranks JJ and I, in the defendants' machine, and make them actuate the feeder 36, would at once destroy the whole operation of the defendants' machine, and make it fit for nothing but the junk pile.

On the other hand, to put the shaft 35 in the feeder F of the Jensen machine and make the feeder turn round its own center would destroy its action, and the Jensen machine would also be of no use except for junk.

On pages 161 and 162 of the record, Mr. Monteverde swears that the actuating devices of said third claim of the Jensen patent are the crank I and the other cranks JJ, and they operate the Jensen feeder to give it the sweeping motion. *That those devices are not in the defendants' machine* for operating its rotary feeder 36. That the defendants' machine has actuating devices for operating its rotary feeder 36. *That the actuating devices of the Jensen patent are not in the defendants' machine.* That the actuating devices that actuate the de-

defendants' rotary feeder 36 are the gears 31 and 39. That those are not the devices that actuate the Jensen feeder F. That there is nothing in the defendants' machine that operates as do the actuating devices that move the Jensen feeder F, by stop motions, and that those actuating devices of the Jensen patent are not in the defendants' machine at all.

An inspection of the defendants' machines, and a comparison of them with the Jensen patent, shows that the foregoing statements of Mr. Monteverde are true. In view of these facts, it is idle to talk about any use being made of the said combination of said claim 3 by the defendants. The defendants' machines never have had any feeder with the projecting arms between which the cans are received, nor the actuating devices that operates the Jensen feeder, and of course said claim 3 has not been infringed.

On pages 249, 250 and 251 of the record, Mr. Seely testifies that *Jensen's actuating devices could not be put into the defendants' machine and operate their feeder or any part of their feeder.* That this could not be done because one is a rotary feeder and the other is an oscillating or swinging feeder. Also that the devices, which actuate the defendants' feeder 36 *could not be put into the Jensen machine and have it operative.* That it would be impossible to interchange the feeder-actuating devices of the complainant's and defendants' machinery, and tells why this could not be done. We think

there is not a shadow of an excuse for claiming any infringement of said claim 3.

Both of said claims, one and three, being combination claims, and each including within its combination mechanical elements which are not in the defendants' machine, neither has been infringed; and this was so decided by the Circuit Court.

The next claim which is asserted to be infringed is claim 5 of the Jensen patent. It is as follows:

5. The *inclined chute* into which the caps are placed and a stop extending across said chute, so as to prevent the caps from moving downward, in combination with a trigger extending across the path of the cans as they are moved toward the capping table, said trigger being connected with the stop, so that as it is moved backward by the passage of the can it withdraws the stop to allow a cap to move down the chute, substantially as herein described."

This claim is intended to cover the combination, or rather a part of the combination of mechanism, by means of which the caps, or covers, are fed into the machine and conducted to their position over the can so as to be in a position to receive the upper end of the can body when the can body is raised and forced into the head. The fundamental foundation device in this combination is the *inclined chute*. Without this inclined chute for the can heads the remainder of the mechanism would be entirely useless.

The power that makes the operation of the inclined chute possible is the power of gravity. Until the cap reaches the spring R, near the bottom of the incline of the chute, it is carried along by the power of gravity alone.

This inclined chute is very defective in many particulars. The cap in descending it must be in an inclined position. Before it can be placed in its position in the conical hollow guide its inclined position must be changed to a horizontal position. To make this change and get the head into its last position over the can body requires the complicated mass of mechanism that is shown in the patent. The caps sliding down the incline must first be stopped. Then they must be again moved until they are again stopped by the second spring, R. Again, it has to be forcibly moved forward by means of the forked lever V. To operate these springs and forked lever there is used a quantity of devices, which, although explained in the patent, are somewhat difficult to understand therefrom.

The feeding apparatus for the *cans* in the Jensen patent is entirely unlike its apparatus for feeding the *can heads* to the machine.

The defendants' apparatus, on the other hand, for feeding the can heads to the machine is precisely the same as that used for feeding the can bodies to the machine. The can bodies are fed to the defendants' machine by means of the horizontal belt 59, and the horizontally revolving skeleton wheel 36. The can

heads are fed into the defendants' machine by means of the horizontal belt 69, and the horizontally revolving skeleton wheel 37. The skeleton wheels 36 and 37 are both carried by the vertical shaft 35, and revolve with it, and of course they both revolve alike. Both are also of the same shape, and both alike have the pockets, one for taking and carrying forward the can bodies, and the other for taking and carrying forward the can heads.

While the spacing fingers are not a necessity in the defendants' machines they have been used in many of their machines, and when used the spacing fingers for the heads are precisely the same as the spacing fingers for the can bodies. Record 316 and 317.

Defendants have made and sold several of their machines without any spacing fingers in them at all, and those machines have done just as good work as any. All that is necessary when the spacing fingers and the bracket 86 are taken out of the machine is to keep the machine filled with cans and caps, since it is possible for a straggling can or cap to get caught between the most projecting corners of the feed wheels 36 and 37, and the outer rims against which the cans or caps slide as they are carried around in the feeder. Record 323 and 324.

Also, evidence of James Fowler. Record 363 and 364.

Mr. Burpee explains the mechanism and action of the defendants' machines well, and his descriptions are

believed and accepted as correct by both sides, and no attempt was made to contradict his evidence at all. He testified for the defendants, and no rebutting evidence whatever was offered. Not a witness was sworn in rebuttal. His direct testimony for the defendants is in the record from page 290 to 369, except a few pages that contain the testimony of James Fowler. The cross-examination of Mr. Burpee goes from page 369 to 430. His redirect examination is on pages 430 and 431. We will ask the Court to read this evidence from the record, instead of our undertaking to copy it at an unnecessary length in this brief.

We suggest that a very good way to test the question to whether or not the combination of Jensen's claim 5 is in the defendants' machine is to reverse the order of the examination, and first examine the simple feeding apparatus of the defendant, and see if any of the defendants' apparatus can be found in the Jensen patent. The defendants' apparatus for feeding the heads is very simple and is easily understood, while Jensen's is very complicated and is more difficult to understand.

In feeding their caps to the machine the defendants first put them on to the horizontal feeding belt 69. Jensen has not this horizontal feeding belt, nor anything that operates in the same manner, or in substantially the same manner. The caps cannot slide down the belt, because it is horizontal and *gravity* will not work in it. No gravity as an operative working power is, or can be

incorporated into it, or the cans that it carries, at all. On the contrary, the cans are carried along by the belt. The *belt is a moving carrying device*, and it has to be driven by a mechanical power *applied by mechanism*. It is the same apparatus that is used for feeding the filled cans into the defendants' machine.

Jensen on the other hand uses an inclined chute to begin with. This chute is not horizontal, as is the defendants' belt. The chute does not move as does the defendants' belt, but is fixed and stationary. It does not carry the cans along with itself, but allows them to slide downwards by the force of gravity with whatever speed their weight and the incline may urge them to.

The complainant and its experts contend that the defendants' belt is a mechanical equivalent of the Jensen inclined chute, but we think that there is ample evidence in the mechanism of the two machines to prove that this is not the case. If the belt is an equivalent of the chute, why is it that the defendants' cap feed wheel 37 cannot be used with the chute? Why is it that the mass of complicated machinery that is required in the Jensen machine to get the can head into its position over the can body, is not used, nor any equivalents of it, in the defendants' machine? Surely it will not be pretended that the defendants' feed wheel 37 is a mechanical equivalent of any device, or any number of devices that can be found in the Jensen patent. On page 314 of the record, Mr. Burpee names no less than nine specific devices that are used in the Jensen machine to meet the difficulties that are encountered in changing the incline of the heads, while going down the

chute, to a horizontal position, and getting them into their proper position over the can body. See the nine pages of Burpee's evidence respecting said claim five, in the record from page 312 to page 322.

But gravity and mechanical devices are not mechanical equivalents of each other. This was decided by the Supreme Court in the case of *Wicke vs. Ostrum*, 103 U. S. 461, pages 469 and 470.

Wicke had invented a machine for driving nails. The machine was a new one and the Supreme Court says that he was "entitled to the benefit of all mechanical equivalents of his several elements known at the time of his invention, if used in the same combination." See page 469 of the decision.

The defendant Ostrum made a nail driving machine in which the nails were driven in a horizontal position. They were "laid in a groove and *held there by gravity* until forced into the board." He was thus enabled to dispense with two of Wicke's mechanical devices. The Court says, page 470: "He accomplishes by *natural causes* what Wicke required a mechanical contrivance to do."

The Supreme Court decided that there was no infringement. The entire opinion in this case is very interesting.

A very pretty and correct definition of what constitutes a mechanical equivalent in patent law is given in the case of *Jensen Can Filling Machine Co. vs. Norton*, 67 Fed., on page 239. The decision was by this Court of Appeals. It says: "'Mechanical equivalents,' as 'that phrase is to be understood in this connection, are

“such devices as were known previously, and which, “in the particular combination of devices specified as “constituting the patented invention, can be adapted to “perform the functions of those specified devices for “which they are employed as substitutes without chang- “ing the inventor’s idea of means. In other words, “without introducing an original idea, producing as “the result of it, an improvement which is itself a pat- “entable improvement.”

Applying the tests furnished by the above definition of mechanical equivalents, we think the solution of the issue as to whether or not the traveling horizontal carrying belt was or was not a mechanical equivalent of the stationary inclined chute of Jensen is easy.

First, what was Jensen’s idea or means for feeding the cap into the machine and getting it into its position over the can body? Evidently, the means which his idea worked out and covered were those described in his patent and applied to the machines which he built.

The inclined chute was only one of them. It was only one device, although the principal one, in the combination which he adopted as the means for obtaining the result for which he was working. His means involved and included all of that complicated mechanism through which he succeeded in getting the cap into the machine and into its final location over the can body. True, the claim does not cover all of those means in the actual combination which are used and are necessary to its working. Still the specific combination of devices which the claim does cover are a portion of the entire means employed, and the inclined chute was his

foundation device in the means which he employed. All the others were necessary in order to make the chute effective. While we are testing the question of what would or would not be a mechanical equivalent of the inclined chute, we must remember that nothing could be an equivalent of that chute unless it could be substituted for it in that mass of machinery which made the chute effective and without which the chute was worthless. The whole mechanism constituted Jensen's idea of means. Could the inclined chute be taken out of those means and the horizontal traveling belt be substituted for it, and the new combination be effective? We all know that this could not be done, and the testimony shows beyond a doubt that it could not be done. To put in the belt and make it effective not only must the inclined chute be taken out, but nearly all, or quite all, of the accompanying mechanism that constituted Jensen's idea of means must go out with it, *since that mechanism could not be used as part of the machinery that would work in connection with the belt.* All, or nearly all, of that mechanism would work, and did work, and assist the operations of the chute, but it would not work and do anything in connection with the horizontal belt.

But beyond this it is proved that the defendants' idea of means created a new and patentable invention. The defendants obtained and now have a patent for the combination of means which they work out to a successful result. See claims sixteen and seventeen of defendants' patent.

This patent is evidence of a new invention by the defendants. Besides this, Mr. Burpee testified that the application of a belt for feeding can heads to a can heading machine *was new with the defendants.*

Record 315.

Obviously, Jensen knew well what a carrying belt would do, as he used one for carrying his cans into the machine. But he did not know or have any conception of any mechanism that would act in connection with the belt to get the caps into their final position over the can body. The belt alone would not do this. It does not do it in the defendants' machine. The defendants must use with the belt the feeder wheel 37. Jensen had no idea of such a thing as the defendants' feeder wheel. If he ever thought of the belt as a part of the means for getting the cap into its final position he rejected the idea. The belt, though well known to Jensen as a carrying belt, formed no part of the means which he adopted. Before the belt could be used something new had to be discovered that could be combined with the belt to carry the cap to its final position. A new invention had yet to be made or the belt could never be used for carrying the caps into the machine. *The defendants, and not Jensen, made that new invention, and for the first time in the world made it possible to use the belt for getting the caps into the machine.*

According to the idea of law, which the complainant's counsel has so often claimed in many cases, in this and the Circuit Court, this invention of the defendants would be a primary and pioneer invention. The application of a horizontal belt with necessary accompany-

ing mechanism *by means of which the belt could be used for feeding can heads* into a heading machine *was new with the defendants. It had never been done before.* It doubled the capacity of machines that were used for heading cans in a vertical position. *Doubling the capacity of vertical heading machines was obtaining a new result, never before known,* and was invention.

Loom Co. vs. Higgins, 105 U. S. 580, pages 591 and 592.

Walker on Patents, Sec. 26.

The defendants' machine comes quite as near to being a primary and pioneer invention as does the Jensen.

Every test that would tend to make the Jensen machine a pioneer invention would equally make the defendants' a pioneer invention. It was new; it produced a new result never before produced; and its mechanism was new, as were also its combination of mechanisms.

Jensen's inclined chute cannot be used in any known combination in which a belt can be used, and neither can a belt be used in any known combination in which the inclined chute can be used.

We submit that the horizontal carrying belt for caps, and the inclined chute are not mechanical equivalents of each other, and that this is proved by every legitimate test that is known to the law for determining what is, and what is not, a mechanical equivalent. Of course, if it is decided that the horizontal traveling belt is not the mechanical equivalent of the inclined chute, the defendants have not used the combination of claim five, and it makes no difference whether the spac-

ing fingers and bracket 86, with their connections, are or are not the same mechanism as are the trigger N, and stop P, of the Jensen patent. The claim does not include all of the mechanism that is necessary to make the trigger N, and stop, operative. Just the trigger N, and stop, taken alone, by themselves, do not constitute an operative mechanism. The "upwardly projecting arm O" of the patent is a device that intervenes between the trigger N, and stop P, and the trigger operates the stop, only by means of the said intervening arm. Leave out the arm O, and there would be no connection whatever between the trigger N and the stop P. Applying the strict legal rules, we might claim that said claim five is void for the reason that it does not cover an operative mechanism. Not only is the arm O a necessary element to make the mechanism operative, but so also is the spring of the spring arm P, which operates to throw the spring arm, or stop P, backwards after it has been moved forwards by the arm O. Without this spring, when the stop P had been moved forwards to stop the cans, it would remain there, and no more caps could pass into the machine.

When all the additional elements are read into the claim that are necessary to make an operative combination of it, there appears quite a wide difference between the bracket 86, and spacing fingers of the defendants and the combination of claim five. Mr. Burpee tells of further differences.

Record 322, 323 and 324.

The fact, as shown in this testimony, that the defendants' bracket, 86, and their spacing fingers can be

taken out of the machine without destroying or perceptibly injuring its utility, we think assists to show that they are not the same thing and do not operate in the same general combinations of mechanical elements as does the apparatus of Jensen's.

We submit that the defendants have not infringed claim five of the complainant's patent, for the reason that they have not used the inclined chute, nor any equivalent for it. Also, because the claim is void for not covering any operative combination of mechanism, unless additional mechanical elements, necessary to make an operative mechanism, are read into the claim, and when such additional elements are read into the claim, then the claim has not been infringed, not only because the defendants' machine does not have the inclined chute or any equivalent thereof, but also because it does not have the other elements of the combination of said claim five.

The Circuit Court had very little to say as to said claim five. It was proved in the case that the defendants' machines would work just as well without the spacing fingers for the can heads as with them when the belts were kept filled with can bodies and can heads. It is a fact that the defendants are now making and selling the machines without using any of the apparatus called for in claim five, and therefore the Court was right in concluding that the issue of infringement of claim five was not of vital consequence. Still we are not satisfied with its conclusion that the defendants had infringed said claim five. The inclined chute is the vital element of the combination of claim five. Take

out the inclined chute and the whole combination is gone, and what remains is absolutely useless for any purpose whatever. The object of the combination is to advance the can heads forward so as to get them nearer to the can body. The inclined chute is the viaduct, and the only viaduct, through which the can heads can make any part of that advance. Without the advance made by the can heads through the inclined chute not a single head could reach a single can body and not a single can could ever be headed.

But further than this, the chute itself would be entirely ineffective and worthless if the incline were taken out of it. Take the incline out of the chute and not a single can head could be advanced or a single can ever headed in the machine. Not only is the inclined chute the vital element of claim five, but the incline of the chute is its soul and is the one feature of it that gives it any vitality whatever. Take the incline out of the chute and it is at once a dead stop to the heading of cans in the machine. The chute is not a piece of moving mechanism, but is a mere stationary slide down which the heads move by their gravity. In and of itself it does nothing whatever.

The inclined form is of the essence of the Jensen chute. It would not be effective in any other form than the inclined form. We challenge complainant's counsel to show any form which could be given to the chute, in place of its inclined form, without utterly destroying its effectiveness, and, in fact, destroying the whole operation of the machine. The inclined form of the Winans car body was the one and only

feature which gave it its value. The inclined form of the Jensen chute is the one and only thing that gives it its value. In this case form is of the very essence of the chute, as it was of the car body. Not only is the horizontal traveling belt for carrying the can heads into the machine a very different device in and of itself from the Jensen inclined chute, but the necessary connecting mechanism that is used by Jensen with it is so very different from anything in the defendants' machine as to demonstrate the fact that the belt could not be substituted in the Jensen machine in the place of the inclined chute, and also that the inclined chute could not be substituted for the carrying belt in the defendants' machine.

The heads must be transferred from the viaduct by means of which they are fed into the machine to their position over the can body which is to be forced into them. For performing this duty the defendants use a horizontally revolving cap carrying wheel, which is precisely the same in shape as their can carrying wheel underneath it. Both are carried by the same vertical shaft. Record 317 and 318.

Both of these wheels were the invention of the defendants. There is nothing in the Jensen machine that approximates the defendants' arrangement for feeding either the cans or the caps into the machine. Record 317. The cap feeding wheel used by the defendants was an original creation of their own. Record 315. In the defendants' machine this revolving cap feeding wheel removed the caps from the belt to their revolving seats, which, as the wheels revolve, will come over

the revolving can bodies beneath, and no mechanism, other than this revolving cap wheel, is required or used for so transeferring the caps from the feeding belt to their said seats. This cap feeding wheel revolves horizontally, and could not be made to act successfully in removing the heads from the inclined chute of Jensen to their seats over the can bodies beneath.

Now, in the Jensen machine the caps slide down the chute in an inclined position, and have to be stopped, and are stopped by the stop P, just *before they reach the bottom of the chute*. They are in their inclined position when they are so stopped, and it requires an extra amount of mechanism to change them from the inclined to a horizontal position and drive them further along into their seat over the can body.

After the can head is stopped near the lower end of the Jensen chute they must aagin be moved forward, changed from an inclined to a horizontal position and advanced to their seat over the can body. To do all of these things the Jensen machine has a large amount of special machinery, which is particularly specified by Mr. Burpee on page 313 of the record. By using the defendants' can head carrying horizontal belt instead of the inclined chute *no less than nine specific mechanical devices are dispensed with*. These are the arm Y, the bell crank Z3, connecting rod Y1, crank Z, connecting lever Z1, connecting link Z2, yoke X1, the connection that reaches down to cam W, marked X, and the cam W. All these devices are shown in the Jensen patent. *They are all necessary to the operation of the chute, and all are so used.*

Not one of them could be left out without stopping the successful operation of the machine. Record pages 313, 314 and 315.

For all the work performed by these nine pieces of mechanism the defendants use only one single piece of mechanism, and that is the revolving feed wheel; supposing that it could fairly be said that the defendants' mechanism, the head feed belt and head feeding wheel, did do the same work that the Jensen chute and its said accompanying mechanism did. Even this supposition, however, we deny, and assert that the operations performed by the defendants' head feeding belt and revolving feed wheel was different work from that performed by the Jensen chute and its accompanying mechanism that was used to transfer the head from the chute to its seat over the can body.

Comparing the head feeding mechanism of the two machines further, and it is seen that Jensen's starts with his inclined chute. The defendants not only do not have any inclined chute, but, as Mr. Monteverde truthfully swears, they *do not have any chute at all*. Record page 167.

Near the bottom of the Jensen inclined chute the can heads have to be *stopped*, and this is accomplished by the stop P, of the patent. The defendants' heads *are not stopped at all*, but move forward continuously from the time that they are placed upon the feeding belt until they are on the can body. Fingers, which have been shown to be unnecessary, were used by the defendants on most of their machines to regulate the run of the heads, but not to stop them. After stopping the heads

near the bottom of the chute the Jensen machine had to have all the nine pieces of mechanism before specified to get the heads into their seat over the can body, while in the defendants' machine the simple head feed wheel swept the heads sidewise off of the belt and placed them in the revolving head seats which were over the can bodies that were carried underneath in the revolving can body feed wheel. The Jensen machine during all its operations worked with stopping and starting motions, while the defendants' machine operated with a smooth continuous motion, that enabled the machine to head two cans while the Jensen machine was heading one. It is fully proved that none of the Jensen devices except the can feed belt were in the defendants' machine, and, further, that none of the Jensen devices, except said can feed belt, could be incorporated into the defendants' machine without destroying its entire operations. It is also proved beyond any doubt that none of the defendants' devices, except said can feed belt, could be found in the Jensen machine, and further, that none of the defendants' working devices, except said can feed belt, could be put into the Jensen machine without destroying its operation. Also that the machines from beginning to end, after passing the can feed belt, were differently organized. The *organic system* upon which one was built was that of a *stop motion machine*, while the *organic system*, upon which the other was constructed, was that of a *continuous motion machine*. In the face of all these undisputed facts, how can it be said that Jensen's patented invention is in the defendants' machine.

One machine can only be held to be an infringement of another patented machine when there are three distinct identities between the two. There must be

First. Identity of *result*.

Second. Identity of *means*.

Third. Identity of *operation*.

Only a few weeks since, on March 23d, 1903, the United States Supreme Court rendered a decision in the case of Kokomo Fence Machine Co. vs. Kitselmans.

The suit was brought for an alleged infringement of four different patents covering machines for making wire fabrics. The case is reported in the Patent Office Official Gazette, volume 103, on page 1417. On page 1422, the Supreme Court states the rule in the following language:

“We perceive no reason to decline acceptance of these findings of the Circuit Court, and agree with that Court in the conclusion that the machines lack that *identity of means* and *identity of operation* which must be combined with *identity of result* to constitute infringement.”

See, also, Robinson on Patents, Vol. 3, Sections 893 and 894.

While the ultimate result of heading cans is accomplished in both machines, the means used are surely entirely different and the operations of the means used are entirely different. The extreme difference between the means employed by the two machines and the modes of their operations is accentuated by the fact that

none of those means can be transferred from one machine to the other without destroying the machine to which the means are transferred.

The case decided by our Court of Appeals, of Norton vs. Jensen, 90 Fed. 415, is much in point. On pages 428 and 429, the Court says:

“Looking at and comparing the old and new Jensen machines, we find that the new Jensen machine, as altered and changed from the old machine, does not contain any such a thing as an ‘annular space’ in a sizing and heading device having its end enlarged to fit the exterior diameter of the can-head, nor anything that reasonably approximates to it, *nor does it possess the gravity chute peculiar to Norton’s invention. It does contain a can-feeder, but that is not operated by gravity, nor does it contain the device for that purpose peculiar to the Norton chute. It is, on the contrary, a positive conveyer. The cans are placed on the revolving disk, and the mechanism carries the cans to the can-heading machine. The Norton chute can in no sense be regarded as the equivalent of the Jensen chute, any more than the latter could be regarded as mechanical equivalent of the former.*”

* * * * *

“Further differences from a mechanical standpoint might be enumerated, but it is obvious that in a patent for a combination, which is what Norton claims, the alleged infringing machine must contain all of the elements of the combination, or their mechanical equivalents.” Citing a list of authorities. There is more of

the decision in this case that is pertinent as legal authority on the questions of construction, equivalents and infringement.

For one device to be a mechanical equivalent of another the substituted device must perform the *same work* as the device performed for which it was substituted; and it must perform that work in substantially *the same way* as the original device performed it.

In the case of Engle Sanitary and Cremation Co. vs. City of Elwood, 73 Fed. 484, the Court, on pages 485 and 486, quote the rule and make citations in the following language:

“One thing, to be the equivalent of another, must perform the *same function* as that other; and, while it can be such an equivalent if it does more than that other, *it cannot be such equivalent if it does less.*” Walk. Pat., Sec. 352. And it is an essential rule, governing the application of the doctrine of equivalents, that *not only must there be an identity of function* between the two things claimed to be equivalents, but that function must be performed in *substantially the same way* by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such. Walk. Pat., Sec. 353; Machine Co. vs. Murphy, 97 U. S. 120; Roller Mill Patent, 156 U. S. 261, 15 Sup. Ct. 333; Seeley vs. Electric Co., 44 Fed. 420.

In Machine Co. vs. Murphy, 97 U. S. 120, the Supreme Court, on page 125, says:

“Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the Court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of *what they do*, or *what office or function they perform*, and *how they perform it*, and to find that one thing is substantially the same as another, if it performs substantially the *same function* in substantially the *same way* to obtain the *same result*, always bearing in mind that devices in a patented machine *are different* in the sense of the patent law *when they perform different functions or in a different way*, or *produce a substantially different result*.”

“Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the *mode of operation* or the *way the device works*, and *at the result*, as well as *at the means by which the result is attained*.”

“Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself;

so that if two devices *do the same work* in substantially *the same way*, and accomplish substantially *the same result*, they are the same, even though they differ in

name, form, or shape. Curtis, Patents (4th ed.), Sect. 310."

See also Walker on patents, Sections 352 and 353.

The subject of mechanical equivalents is exhaustively treated in Robinson on Patents from Section 245 to Section 258.

Here we turn to a piece of evidence that is of great value in deciding upon the issue of infringement, and that is the patent of the defendants. This patent is legal evidence that the defendants were themselves the inventors of the mechanisms and combinations thereof, which are described in their specifications and covered by their claims.

It was decided by the Supreme Court in the case of Corning vs. Burden, 15th, Howard 252, that the defendant's patent furnished the presumption that his machine was new and not an infringement of the plaintiff's prior patent. Page 271 of the decision.

In the case of Ransome vs. Hyatt, 69 Fed. 148, this Court of Appeals endorsed the rule, "that the issuance of the defendant's patent creates a prima facie presumption of a patentable difference from the prior patent of the plaintiff." Citing several cases. This Court reversed the judgment in that case because the lower Court had ruled out the defendants' patent as evidence.

Now, there are several sections in Robinson on Patents, under which he is discussing the doctrine of me-

chanical equivalents that elucidates with remarkable and convincing clearness the effect as evidence of a defendant's invention in proving whether or not the thing that he is using is, or is not, a mechanical equivalent of a plaintiff's device.

Robinson all the while keeps in mind that the plaintiff's patent protects what *he has invented*. The patent cannot be expanded so as to reach beyond the patentee's idea of the means which he has employed in making his invention. Obviously he can patent only the means which he employs to obtain his results. He cannot patent the result itself, neither can he in a machine patent, patent the mode of operation. His *means for obtaining his results are the only things that the law can allow him to patent*. This we believe we have already shown by the authorities that we have cited. Robinson gives the patentee all the means which he had used, and this includes such mechanical equivalents as were within his ideas of the means which he employs. This is going as far as the patent law allows. If a defendant uses means to accomplish the same result as that accomplished by the patentee, and the means so employed by the defendant are not within the patentee's idea of means, but were something that he had never thought of, they, of course, could not constitute any part of his invention. Things that had never come to his mind, that he had never used, that he had never produced, and the possibility of which he had never conceived or thought of he, of course, could not have been the inventor of. Those

things which were *first invented subsequently to the invention* of the patentee, and by other parties, could not possibly be the patentee's invention. Such things would not be shown in his application for a patent, nor in the specifications or claims of his patent. True they might be patented inventions, and therefore could not be lawfully used without his license, but even then they would not be any part of his invention, and he would have no right to use them.

Even if they were improvements upon his patented machine and, for that reason, could not be used without his consent, they nevertheless, in and of themselves, would not be any infringement of his patent or any equivalents of its mechanism. If the defendant infringed the plaintiff's patent it must be because he used the patented invention itself, and not because he used the improvement that he had added to it. That improvement the plaintiff would have no right to.

Now in this case the defendants, Letson and Burpee, invented the machine which they use. This is indisputable, and we believe is undisputed. They did not take the Jensen machine and add an improvement to that. Their whole mechanism, except the can feeding belt, was new and original with them. It had never been used before by any one, and certainly not by Jensen. It was a new *kind* of machine. None other had ever been made upon the same general plan as that was built upon. Its can feeding wheel was new with them. Its cap feeding wheel was new with them. The placing of both of those feeding wheels upon the same revolv-

ing shaft was new with them. The revolving table in which were the seats for the can bodies to occupy while the heads were being applied was new with them. The revolving table in which were the seats for the can heads to occupy while the cans were being forced into them was new with them. The putting both of those tables on the same revolving shaft, one over the other, was new with them. The application of two gear wheels, by which one of those shafts was made to revolve the other shaft, was new with them. The building of the machine and arranging the parts so that the heads and cans would go through the machine, and the cans be headed while so going through the machine, and without stopping, was new with them. The whole movements, and life and soul of the machine, excepting only the can feeding belt, was new with them and was born of their inspiration. None of these things came from Jensen.

Now Section 253 of Robinson on Patents says:

“253. EQUIVALENCE IMPOSSIBLE WHEN THE IDEA OF
“MEANS IS CHANGED.

“The second essential requisite in an equivalent is
“that its use in the invention must not involve a change
“in the idea of means. A change in the idea of means
“is a change of substance, demanding an operation of
“the creative faculties and producing either a new in-
“vention or an improvement on the old. The substitu-
“tion of equivalents is, on the contrary, a mere change
“of form, involving no inventive skill, but suggested by
“the invention itself to every person familiar with the
“art to which the invention appertains. Any act or

“substance, therefore, however accurately it performs
 “the function of the element whose place in the inven-
 “tion it supplies, is *not a mere equivalent if in addition*
 “*it has also introduced a new idea or a development of*
 “*the old idea of means.* While an equivalent may act-
 “ually accomplish more, or operate to better purpose
 “than the former, its excess of action must be consistent
 “with the *unity and identity of the idea embodied in the*
 “*original invention.*”

Section 256 of the same great author is as follows:

“256. EQUIVALENCE IMPOSSIBLE IF THE ALLEGED
 “EQUIVALENT HAS BEEN INVENTED SINCE THE
 “ORIGINAL INVENTION WAS PATENTED.

“The third essential attribute of an equivalent is that
 “it must have been known as such at the date of the pat-
 “ent, or have since become known without the exercise
 “of inventive skill. The substitution of one equivalent
 “for another is a change in the form of embodiment
 “only; and as all forms of embodiment known in the
 “arts are presumed to have been also known to the in-
 “ventor and to have been open to his selection, his
 “choice of one and its employment points out the mode
 “of using all the rest, and thus renders every other an
 “imitation of his own. But acts and substances which
 “have been invented, or whose availability for the em-
 “bodiment of his idea of means has been discovered and
 “applied by the exercise of additional inventive skill,
 “since he completed his invention and bestowed it on
 “the public by his patent, are not imitations of the ele-
 “ments in which he has embodied his idea. Their crea-

“tion or discovery, and their adaptation to the purposes
 “of his invention have resulted from a subsequent and
 “separate inventive act—an act performed after the
 “completion and publication of his invention, and
 “hence, though capable of exact substitution for the acts
 “or substances he has employed, they are not true equiv-
 “alents whose use causes a mere diversity of form, but
 “new inventions expressing a diversity of substance.
 “The attribute of knowledge, at the point of time when
 “the inventor’s right received the positive sanction of
 “the law, thus enters into the character of an equivalent.
 “If then known as a substitute, the substitution is an al-
 “teration in the form of the embodiment, a simple
 “equivalent and nothing more. If then unknown, its
 “subsequent creation and adaptation to the invention,
 “by the exercise of inventive skill, if not resulting in an
 “essential alteration in the idea of means, is at least a
 “development of that idea, and constitutes an improve-
 “ment.”

Therefore we urge that the defendants’ can head car-
 rying belt is not the mechanical equivalent of the Jen-
 sen inclined chute, and that there has been no infringe-
 ment of said claim five of the Jensen patent:

Because the inclined chute of the Jensen patent was a
 mere stationary device that had no movement what-
 ever, and did not carry the can heads, but merely al-
 lowed them to *slide* down its incline by the power of
 gravity alone, while the head feeding belt of the de-
 fendants’ was not a stationary device, but was a moving
 piece of mechanism that received and *carried* the can

heads with steady and equal movement, and did not allow them to slide at all, and to which the power of gravitation was not applied and could not be applied, and the action and operation of the two devices was not the same, or of the same kind, and:

Because the sliding of the cans down the inclined chute by gravitation was a result that was not produced in the defendants' machine while the result of receiving and carrying the can heads in a horizontal line and at a uniform rate of speed was a result that was accomplished by the defendants' can head feeding belt for the first time in the world and was a different result from that accomplished by the inclined chute, and:

Because the character and actions and operations of the chute and carrying belt were of such vital differences that one could not be used in the place of the other, were not interchangeable and would not operate with the same kinds of the additional mechanism that was necessary to be added in order to make the devices operative in can heading machines, and:

Because the inclined chute when incorporated into a can heading machine required one character of accompanying mechanism to make it operative and effective, while the can head feeding belt when incorporated into a can heading machine required an entirely different kind of accompanying mechanism to make it operative and effective, and:

Because the can head feeding belt was a device that was entirely *outside of any means* that were described or used in the Jensen patent, and:

Because the incorporation of the can head feeding belt into a can heading machine, and combining it with new mechanism with which it would operate harmoniously and effectively in doing the work of heading cans was a *new and useful invention that was made by the defendants long after the Jensen machine had been on the market and in use and all of its mechanisms, operations and possibilities were well known, and which did not include any of the mechanisms of the defendants' machines, excepting only the can body feeding belt, and:*

Because the defendants' patent proves their machine to be a new and useful invention, and:

Because the oral testimony proves beyond any doubt that the defendants' machine will do double the quantity of work that the Jensen machine can do, and thus produces a further new and useful result that flowed from the defendants' invention, and:

Because not only the defendants' patent, but also the oral testimony taken in the case proves beyond any doubt whatever that the defendants' machine as a whole, and in all of its combinations of devices was the invention of defendants. The defendants' machine is not something that is added to the Jensen machine, nor does it take any of the Jensen devices and change them into different forms or shapes, but it is a new machine throughout, excepting only the can body feeding belt, and there is not a single combination which includes even that belt, that was ever in the Jensen machine or that is shown in the Jensen patent.

The next claim of the complainant's patent of which infringement is charged is claim nine. It is as follows:

"9. The vertically moving plunger upon which the cans are delivered by the feeder, in combination with the conical guide situated above the cans, and the transversely-moving slides upon which the caps are received and held, with a mechanism by which the slides are withdrawn as the can enters the cap substantially as herein described."

This is a combination claim of which the vertically moving plunger is the first and most important mechanical element. Without this vertically moving plunger no cans could be headed in the machine.

The first question we present in regard to this claim is this: Have the defendants used this vertically moving plunger of the Jensen patent? We contend that they have not.

As has already been described both in the patent and in the testimony, without any conflict whatever, this vertically moving plunger, which is the plunger S, of the patent, is movable only in a vertical direction. It has no horizontal movement whatever. It is stationary except as to its vertical movement.

Another feature of this vertical plunger is that it *operates with an intermittent motion*. It rises to force the upper end of the can into the can head or cap, and then descends into its normal position and remains stationary while the feeder F, with its arms H, carry the headed can off from the plunger and places another

filled can upon it. This plunger S is operated by movable mechanism which raises and lowers it. None of these features apply to the devices which are used by the defendants in their machines, which devices are asserted to constitute mechanical equivalents of the complainant's plunger S.

In the lower figure of the Monteverde drawing No. 6, record 498, is shown the plunger S, with a filled can just placed thereon by the arms H, of the feeder F. In this figure is also shown the mechanism that is used as described in the patent, to raise and lower the plunger. The patent, in the last column of page 3 of the specifications, describes this apparatus as follows:

“The plunger S is raised by the arm e, one end of which acts against the bottom of the plunger, the other end being fulcrumed to a fixed support, and having a roller, f, turning upon a downwardly-projecting arm or shaft, as shown. This roller is engaged and actuated by a cam, g, upon the lower end of the vertical shaft which carries the crank I. The action of this cam upon the arm e raises the plunger S, which drops by gravitation, or, if preferred, may have a spring applied, so as to cause it to move with greater activity.” Record, 516.

The Court will notice that the cam, g, above mentioned, is a disk which is mounted upon the vertical shaft which passes through the disk at one side of its center. This converts the disk into a cam and enables it to operate the said mechanism to raise and lower the plunger S.

In the first figure of the Monteverde drawing, No. 12, Record, 505, is shown parts of the defendants' apparatus. The filled can is there shown as being just delivered from the revolving feeder wheel, 36, on to one of the can supports 19, which has a stem 18, that passes down through the radial arm 14a, of the carrier 14. There are four of these radial arms and there are four of the can supports 19, each one of which has a stem 18 that passes down through one of said radial arms 14a. Said carrier 14 rotates around the vertical stationary shaft 13. The rotary feeder 36, is so timed that it will deliver a filled can upon one of said can supports 19, at just the moment that the can support is in the right position to receive it. There are four of the pockets in the feeder wheel 36, and there are four of the can supports in the radial arms 14a, of the carrier 14. The feeder wheel 36, and the carrier 14, *revolve horizontally and continually without stopping at all while the machine is at work.* See also figure 1 of the defendants' patent. Record, 520.

Underneath the parts mentioned is what the defendants' patent calls a member 47, having inclines or "chases" 46 on its upper surface. As the carrier 14, revolves the lower ends of the spindles 18, are forced upwards by the rising incline 46, and the upper end of the can body is forced into the can head over it.

As the carrier 14 continues to revolve the spindle 18, riding upon the downwardly inclined surface of the circular cam 46, will descend down its incline carrying the headed can down with it. This headed can will be

removed from the can support 19, by further mechanism, not yet herein described, but which is not any part of the feeding apparatus. In the Jensen patent the headed can is removed from the plunger S by the feeder F with its arms H, which is the same mechanism that placed the unheaded filled can upon the plunger. The defendants' feeder 36, finishes its work with each can when it has deposited that can upon one of the can supports 19.

We think that the defendants do not have in their machine the plunger S, nor any mechanical equivalent of it. The differences between the plunger S and the defendants' can supports are so many and of such character as to prohibit the idea that one is the equivalent of the other. The plunger S moves *only in a vertical direction*. The can supports each move in a horizontal circle, which is utterly impossible for the plunger S to do. The can supports are raised and lowered by a *fixed stationary cam*. The plunger S must be raised by *the action of moving machinery, and cannot be operated by a stationary cam*. The can supports have *no intermittent or stop motion*. The plunger S *has an intermittent motion and cannot be operated without it*. The plunger S cannot be taken out of the Jensen patent and put into defendants' machine without destroying the operation of the machine. Neither can the can supports be taken out of the defendants' machine and put into the Jensen header without destroying the operation thereof. It is not denied by complainant but that the defendants' machine is *differently organized from the*

Jensen machine from beginning to end, and because of it being so differently organized, it has more than double the capacity of the Jensen machine, and its mechanism all through, except as to the feeder belt that carries the filled can into the machine, is also different from the Jensen machine. After passing the first feeder belt that carries the filled cans into the machines, there is not a single piece of mechanism that could be taken out of one of the machines and put into the other machine and made to operate in the place of any piece of mechanism that might be taken out of the other machine to make room for it.

If the defendants' can supports are not the mechanical equivalents of the Jensen plunger S, then the defendants have not used the combination of said claim nine, and in such case it makes no difference whether the defendants used the other mechanical elements of the claim or not.

The other elements of the claim are:

The conical guide situated above the cans;

The transversely-moving slides upon which the caps are received and held; and

A mechanism by which the slides are withdrawn as the can enters the cap.

The said conical guide is made of *two* slides TT, which reciprocates towards and away from each other. In the ends of the slides adjoining each other is cut out one-half of the conical guide, so that when the two slides are pushed together there is formed by them a

cone shaped hollow that is wider than the diameter of the can head at the bottom, and just wide enough at the top to allow the upper end of the can body to pass through it. It is placed directly over the plunger S. Just at the top of this cone shaped hollow there is cut out a small circular recess, the bottom of which forms a flange the thickness of a piece of tin. The diameter of the recess is just great enough to receive the can head, and in operation the can head is placed in said circular recess, with the edge of its rim resting upon said flange. The said can head is held in said position, and when the filled can standing upon the plunger S, is raised upwards, its upper end is guided by said conical hollow into the rim of the can head, and the can is thereby headed.

When the can is thus headed the slides TT are drawn apart so as to allow an opening large enough for the head to pass down through, and the plunger S is lowered and carries down with it the headed can.

These slides T, T are moved back and forth, by means of two other slides, the mechanism being described in the patent as follows:

“Above the feeder or carrier F, upon a suitable support, are two slides, a, moving in guides parallel with the direction in which the caps move between them from the bottom of the inclined chute to the position where they are placed upon the cans. These slides have inclined or cam shaped slots made in them, and pins a 1, project upward into these slots from the transversely moving slides which are situated below

them, so that as *these slides a are moved* backward and forward *they* will actuate the transverse slides T, so as to hold the cap above the can until the can has been pushed up into it, after which they are opened to release the cap and allow the can and cap to be depressed, as before described.

The slides a are united by a transverse arm or lever b, which connects with pins projecting upward from the slides a, so as to engage each end of this oscillating arm, which is pivoted or fulcrumed at the center. One of the slides is connected by an adjustable connecting rod, G, with the crank I, by which the sweep of the feeder is produced, so that the slides a, move simultaneously with the movement of the feeder, and thus operate the transverse slides T, as before described."

The Monteverde drawing No. five, in both figures, assist in explaining the foregoing described apparatus. Record, 497.

It will be noticed in the foregoing that both the slides, T, T, and a, a, are operated by *moving* mechanism and *no stationary cams are, or can be used in operating them, or either of them.*

The conical guides as a mechanical device in can-heading machines for guiding the upper end of a vertical can body into the head above it, was not new with Jensen. We have put in evidence a U. S. patent granted to Edmund Jordan, October 28th, 1884, for an automatic can heading machine in which such a device is used. A full sized model of the same is in evidence

as Exhibit E. The patent thereon is to E. Jordan and is in the record, pages 543 to 550, is defendants' Exhibit B.

The other patent put in evidence is Exhibit A. It is patent No. 265,617, dated October 10th, 1882, and was granted to George A. Marsh, for a machine for heading cans.

A model of this Marsh patent is put in evidence as Exhibit F.

The patents were put in evidence during the cross-examination of Mr. Seely. Record, pages 256 to 261.

We have already called the attention of the Court to these two patents and largely explained them. As the conical guide is one of the mechanical elements of claim nine, which is under discussion here, we refer to them briefly on account of their near relation to said claim.

The models were put in evidence during the examination of Defendant Burpee, and he has made full and intelligent descriptions and explanations thereof. Record, pages 328 to 337.

Beginning on page 337 and going to page 344, of the record, Mr. Burpee gives a good description of the conical guides of the Jensen patent, as well also as a description of the conical guides of the defendants, and of the mechanism by which they are actuated. We cannot improve on Mr. Burpee's description, and therefore refer the Court to the said pages of the testimony for such description, which includes a good and intelli-

gent comparison between the Jensen conical guide and the defendants' conical guide, as well as of the different mechanisms by which the two are operated. This testimony, when read in connection with the Jensen patent, the defendants' patent, and with the models and machines in evidence, is absolutely irrefutable, and *no attempt whatever has been made to refute it.* Mr. Burpee's testimony was so perfectly fair all through, and also, so full, comprehensive and exhaustive, that *not a single witness was put on the stand in rebuttal.* Mr. Burpee and Mr. James Fowler were the only witnesses sworn on the part of the defendants. There are only five pages of Mr. Fowler's testimony, which goes from page 361 to page 366 of the record. While there are only these two witnesses who testified on the part of the defendants, the complainants have paid their testimony a very high compliment by declining to make any attempt to contradict any of it.

Under these circumstances we think we may ask the Court to do, as the complainant has done, that is, accept the testimony of Mr. Burpee as absolutely true and irrefutable.

Going back now to pages 328 to 344 of the record, and reading that in connection with the exhibits which it refers to, and we find, first, that conical guides, as an elementary device for guiding the upper end of a vertical can body into the flange of a can head, in heading the can, was not new with Mr. Jensen, but the same was an old device as compared with the date of his invention.

Also that in so using said conical guide there was always a flange around the upper end of the conical guide, which was just large enough to receive and hold the can head in place with the edge of its rim or flange resting on such flange. See Figures 13, 14, 16 and 19 of the Jordan patent. Record, 546. Also Figures 6 and 5 of the Marsh patent, with the description thereof in its specifications. Record, pages 537 and 538.

We also find with these machines that when the upper end of the can body was forced into the can head by the use of the conical guide that there was mechanism by which the flange on which the can head rested was withdrawn so as to allow the head to pass through the opening so as to leave the can headed, and not pull the head off from the body. In other words, *so far as the conical guide was concerned, for guiding the upper end of the can body into the can head, combined with a flange for the head to rest on, and means for withdrawing the flange when the can was headed, the same were not new with Jensen.* We do not for a moment assert that because of these things Jensen could not make new combinations, and a new machine that involved invention. His machine as an entire machine might be a new machine, and the combinations and sub-combinations of mechanism might be new with him. This we are willing to concede. But when it comes to working out an infringement by treating the defendants' machine, which confessedly *is an entirely new organization, not built upon Jensen's plan of a heading machine, not containing any of his new ideas, not containing any of his new devices, and not contain-*

ing any of his sub-combinations, but instead thereof being constructed upon a plan so different from Jensen's that none of his new ideas can be found in it—none of his general organization can be found in it, and none of his new devices, or new ideas, or new sub-combinations of devices can be put into it without destroying the operation and mode of operation of the machine as an entirety, and also destroying the local operation of each and every part for which one of the Jensen devices or sub-combinations might be substituted, we rebel, and assert that no such infringement does or can exist.

In the defendants' machine there is mounted upon the carrier 14, a table 20, which rotates with the carrier. In this table 20, are four holes, and in these holes the caps are placed by the cap feeder 37. It is *these holes that center the caps, and not the slides*, which form the conical guides. This is one of the differences between the Jensen patent and the defendants' machine. Record, 339.

The devices used by Jensen for moving the slides that form the conical guides *could not be used for moving the defendants' slides. Nor could the defendants' mechanism be used for moving the Jensen slides.* The two mechanisms which are used in the respective machines are not mechanical equivalents of each other. This, we think, is proved beyond a doubt, and would be obvious without any proof, other than a comparison of the Jensen patent and the defendants' machine. Record, pages 339, 340, 341, 342 and 344. On these

pages it is shown that the mechanism used by the defendants for moving their slides are a *stationary* cam, an arm 54, and the ring 52, which is underneath the three slides 51. That the arm 54 *is carried around in a circle, and if it was not so carried around it would not be operative in the defendants' machine.* That there is nothing in the Jensen patent *that corresponds with that arm or that performs the same function.* That there is so much of the mechanism of the defendants' machine that revolves around a central axis that it makes *the entire organism of the defendants' machine different from the entire organization of the Jensen machine,* and also requires that the *individual devices which are put together to make up the entire machine must be of a different character and of a different operation* in nearly every instance where there is anything in the nature of corresponding individual devices used in the two machines.

In the said claim 9 the "mechanism by which the slides are withdrawn as the can enters the cap," constitutes one of the mechanical elements of the combination covered by the claim. *Neither that mechanism nor any mechanical equivalent of it is in the defendants' machine,* and for this additional fact the combination of said claim 9 is not in the defendants' machine and the claim is not infringed. Two of the mechanical elements of said claim 9 are absent from the defendants' machines. These are the vertically moving plunger S, and the mechanism which withdraws the slides when the can enters the cap.

Before quoting the next claim which is asserted to be infringed we will refer to the testimony of Mr. Burpee, wherein he shows in what respects the machines resemble each other, and also in what respects they do not resemble each other.

On page 419 of the record, on cross-examination, Mr. Burpee was asked whether there were not some fundamental resemblances between the defendants' and the complainant's machines, and he answered that there were, and named as such resemblances "the means by which the can is guided centrally into the cap, *but* "that *would also apply in the Jordan machine, on exhibit here, and the Marsh machine, on exhibit here.*" The conical guide situated above the can; in each of these machines, the can is operated upon *in an upright position*; there is a conical guide situated above the cans; there is an opening and closing mold, as it might be called, it is called by different names in different machines, which, when closed, form a complete circle, and there is a ledge upon which the can head rests. The circular or conical shaped opening acts to round up and size and guide centrally the can into the can head, which is a *fundamental principle in all of the four machines on exhibit here.* In some machines the can is raised into the cap, while in others the cap is lowered over the can.

Besides these there is the carrying belt that carries the cans into both the complainant's and into the defendants' machines, which is another resemblance, as is also the spacing devices that regulate the cans upon

the belts. These are the *resemblances* of the two machines. Pages 419 and 420.

The differences between the complainant's and defendants' machines we have been pointing out and will not repeat them here. They are fundamental and for this reason the two machines have different fundamental operations that require different methods of construction and different mechanism. These operations and mechanism are so fundamentally different that the mechanism of one machine cannot be used in the other machine, and are also so different that there is not a single combination of either one of the Jensen claims that is used, or that could by any possibility be used in the defendants' machines.

The resemblance which Mr. Burpee has so frankly, fully and intelligently pointed out does not result in finding in any of Jensen's claims any combination that is in the defendants' machines. These resemblances are many of them not new in the Jensen machine, but were contained in the prior Jordan and Marsh patents, and we submit that the resemblances which are common to the four machines could not lawfully be covered in Jensen's claims, and, *as a fact, they are not covered by the Jensen claims or any of them.*

We turn now to the remaining two claims which are asserted to be infringed. They are claims ten and eleven. On account of their close resemblance of each other we will treat them together. They are as follows:

“10. The vertically moving plunger by which the can is raised to receive the cap, and the guide into which the upper end of the can enters the transversely-moving cap-holding slides, in combination with the second plunger moving vertically above the cap and following it down by gravitation or otherwise, so as to steady the can in its descent after the cap has been applied, substantially as herein described.”

“11. The vertically moving plunger upon which the can is received, a carrier for placing the can upon the plunger, and a mechanism by which this plunger is reciprocated vertically in combination with a second plunger, which rests upon the top of the cap and steadies it while descending, and a mechanism for raising the second plunger before the arrival of the next cap, substantially as herein described.”

Each one of these claims is for a combination which includes as one of its mechanical elements the vertically moving plunger, which is of course the plunger S. This vertically moving plunger we have already discussed and need not repeat the discussion here. Unless this vertically moving plunger S, or a mechanical equivalent of it, is in the defendants' machine, the combination of each one of the claims is not in the defendants' machines, and neither of the claims is infringed. If, therefore, the Court sustains our contention that neither the plunger S, nor any mechanical equivalent of it is in the defendants' machines, then neither of these two claims are infringed, even though every other mechan-

ical element, that is included in the combinations, was used by the defendants just exactly as they are described and used in the Jensen patent. In such case there will be no need to examine the mechanical elements, other than the plunger S, of these two claims to see whether or not the defendants have used any of them.

Said claim ten includes in its combination as one of its elements the second plunger moving vertically above the cap and following it down by gravitation or otherwise so as to steady the can in its descent after the cap has been applied. This device is the plunger U, of the patent.

What is claimed by complainants to be the equivalent in the defendants' machine of this upper plunger U, of the Jensen patent, is a device called in the testimony a cap-presser. The two are described in Burpee's testimony. Record, 345 to 353. To that testimony we refer the Court for a description and comparison of the plunger U, and the said cap-presser.

At the upper end of the defendants' stationary vertical shaft 13, is a stationary radial cam 28. A carrier 24, is secured upon the rotating table 20, said carrier having four radial arms 24a, in which are held spindles 25. At the lower end of each of these spindles is mounted and carried a disk 26, adapted to press down upon the can caps. A collar 29, is adjustably secured to the top of each of the spindles 25, and from each of these collars another spindle projects inwardly and carries an anti-friction roller 30, adapted to engage

the stationary cam 28, whereby the spindle with the disk 26 at its lower end will be raised and lowered as required. It is this disk 26, that is called the cap-presser, and it is operated by the spindle 25, collar 29, and anti-friction roller 30, as the apparatus revolves around the stationary cam 28.

The object of this cap presser is to hold the can head in the opening 21, in the rotating table 20, when the can body is raised to enter the head. As is shown by the testimony, this cap presser *does not follow the headed can down and steady it as it goes down*. A sufficient comparison is made in Mr. Burpee's testimony, in the record, from page 345 to page 351, and we think it shows that the cap-presser is not the plunger U, of the Jensen patent, nor is it any equivalent of it. In the defendants' machine the can body is received and held in place on its support by guides 40 in the nature of radial arms secured to the support or stem 20a of the table 20, and having can holding recesses therein. See figure one of the defendants' patent drawings, and folios fifty-five to sixty, on page two of their specifications. Cut number seven, page 448, of the record, was supposed to represent said figure one of the defendants' drawings. It, however, does not have on it the can body recesses 40, which are shown in said figure one and explained in the specifications above referred to. This leaving off of the Monteverde cut seven the can body holders 40, was not quite fair since, in connection with that omission, the attempt was seriously made to make it appear that the defendants' headed can was steadied and secured in its place, while descending, by the cap

presser. Mr. Burpee shows in his testimony that this was not so, but that the recesses 40, etc., were the devices that held the can body to its place during the heading and discharging operation. Record, 349. A plunger as a device is old, and when the attempt is made to cover the plunger as an element of any working combination in the Jensen machine, *there must be enough of the mechanical elements read together to make an operative combination or operative sub-combination.* We will not make any extended criticism of this attempt to make the cap-presser of the defendants' the same thing as the plunger U of the Jensen patent. It is the same story, over and over again. *The defendants' machine acts upon the rotary principle, and Jensen's does not.* The consequence is that *there are no operative mechanical combinations that are used in one that can be used in the other.* The defendants' cap-presser is a machine in itself. It contains the spindle 25, the disk 26, at the bottom, the collar 29, and the roller 30. *The whole must swing around in a circle.* Jensen's plunger is differently constructed and operates differently, having only the direct vertical movement. It could not be used in the defendants' machine without changing its construction and its operation. The cap holding slides, elements of this claim, are also differently constructed, and are operated in a different manner from those of the defendants.

As to said claim 11 of the Jensen patent, it contains as an element of its combination the vertically moving plunger S, which we believe we have shown is not in the defendants' machine. The combination of this claim

also covers as a part of its elements a carrier for placing the can upon the plunger. This is the carrier F, and *carrier F is not in defendants' machine*, and the Circuit Court so decided. It also contains as a part of its elements the mechanism by means of which the plunger S is reciprocated vertically. This mechanism is not in defendants' machine. It also contains as part of its elements the second plunger U, which we have already discussed. It also contains as part of its mechanical elements the mechanism used for raising the second plunger U, and this mechanism is not in the defendants' machine.

On page 443 of the record is found a drawing that we believe was not put in evidence and there is not in the record any explanation of it. We believe that it represents the can body feeding belt of the second Jensen machine. We only mention this that the Court will not get puzzled in any way by finding the drawing in the record and no testimony regarding it.

The manner of working out infringements by the use of mechanical equivalents, by the complainant's experts, is so far fetched and so original, and yet so far outside of any rule of law that we should not notice them at all if it were not for the fact that the Circuit Court decided that there was an infringement of three of the Jensen claims.

The method of said experts can be illustrated by supposing that an inventor had invented an overshot water wheel, and had operated it for driving the machinery

of a cotton mill; and supposing further, that a later inventor had invented a steam engine and had used it for driving the machinery of a cotton mill.

According to the opinions of the complainant's experts, as the water wheel by the application of *water* to drive it furnished power to drive a cotton mill, and as the steam engine by the application of *steam* to it also furnished power to drive the cotton mill, the two were equivalents of each other. As the water was the means by which the water wheel was run, and steam was the element by which the engine was run the *steam* would be the equivalent of the *water*, notwithstanding that the water could not be used to drive the engine, nor the steam applied to driving the water wheel.

On pages 161 and 162 of the record Mr. Monteverde testifies that the cranks J, J and I, were the devices that actuated the *Jensen* feeder F; that these devices were not in the defendants' machine; yet that the gears 31 and 39 were the actuating devices that gave movement to the *defendants'* feeder 36, and that these actuating devices *took the place of the actuating devices that operated the feeder in the Jensen machine.*

After stating that the said cranks were the actuating devices of the *Jensen* feeder F, he is asked, in cross-question 167: "There is nothing in the defendants' machine that takes the place of those actuating devices, is there?" and he answered by saying:

“Certainly; the actuating devices that give movement to the feeder 36 in the defendants’ patent.”

Further in the same answer he shows that the defendants’ actuating devices are the gears 31 and 39, and further, on the same page, he swears that there is nothing in the defendants’ machine that operates as do the actuating devices that move the feeder F, by stop motions in the Jensen patent.

Evidently his construction is that as the said cranks actuate the stop motion feeder in the Jensen machine, and as the said gears operate the continuous moving feeders in the defendants’ machine, the gears are a mechanical equivalent of the cranks, although one could not be operated in the place of the other.

The witness Seely also testifies on page 249 of the record that he does not find the *Jensen feeder F*, in defendants’ machine, but he does find the *defendants’ feeder* there and actuating devices by which the motions of such feeders are produced.

Mr. Seely further testifies, on pages 243 and 244, that it would be absolutely impossible to take the defendants’ feeder out of their machine and put it into the Jensen machine; also that he could not put the sweeping feeder of the Jensen machine into the defendants’ machine without destroying its operation, yet he was clear in his mind that the rotary feeder 36 of the defendants’ machine was a mechanical *equivalent* of the Jensen sweeping feeder. On page 244 Mr. Seely talks about drawing claims to describe an invention so

as to protect the patentee *from any subsequent improvements*; and also about claims *being infringed by a subsequent invention*.

Of course no patent can so cover any invention that other and further improvements may not legally be made on it, and further, one patentable invention can never be an infringement of a prior patented invention. His idea of equivalents and of the scope which claims may be drawn to cover, are quite contrary to orthodox patent law.

No attempt has been made to reach and cover the defendants' machines except by the application of the doctrine of mechanical equivalents; and we insist that in every instance in which any device of the defendants has been claimed to be an equivalent of some corresponding device in the complainant's patent there has not been either that identity of means, or identity of operation, or identity of result, that is necessary to make one device the equivalent of another within the provisions of the patent law. We except from this statement the can body feeding wheel as an individual device, but nothing else.

Also, it is proved to an absolute certainty that the defendants' machine was an *invention made by them*, and was *patented to them*, and that there is not an outline or a shadow that is to be found in the Jensen patent, nor is there an outline or shadow of it it contained in the Jensen invention.

The Court will notice that in this brief we have treated the Jensen patent just as though its claims in-

cluded mechanical equivalents, to the broadest extent that equivalents can ever be covered by combination claims.

We believe that we have demonstrated and shown that the defendants' machines are not any infringement of any claim of the Jensen patent sued on, and that the decree of the Circuit Court should be reversed in so far as it adjudges that the defendants have infringed the patent sued on or any of its claims.

Respectfully submitted,

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United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

J. M. K. LETSON, et al.,
Appellants,

vs.

ALASKA PACKERS ASSOCIATION,
Appellee,

AND

ALASKA PACKERS ASSOCIATION,
Appellant,

vs.

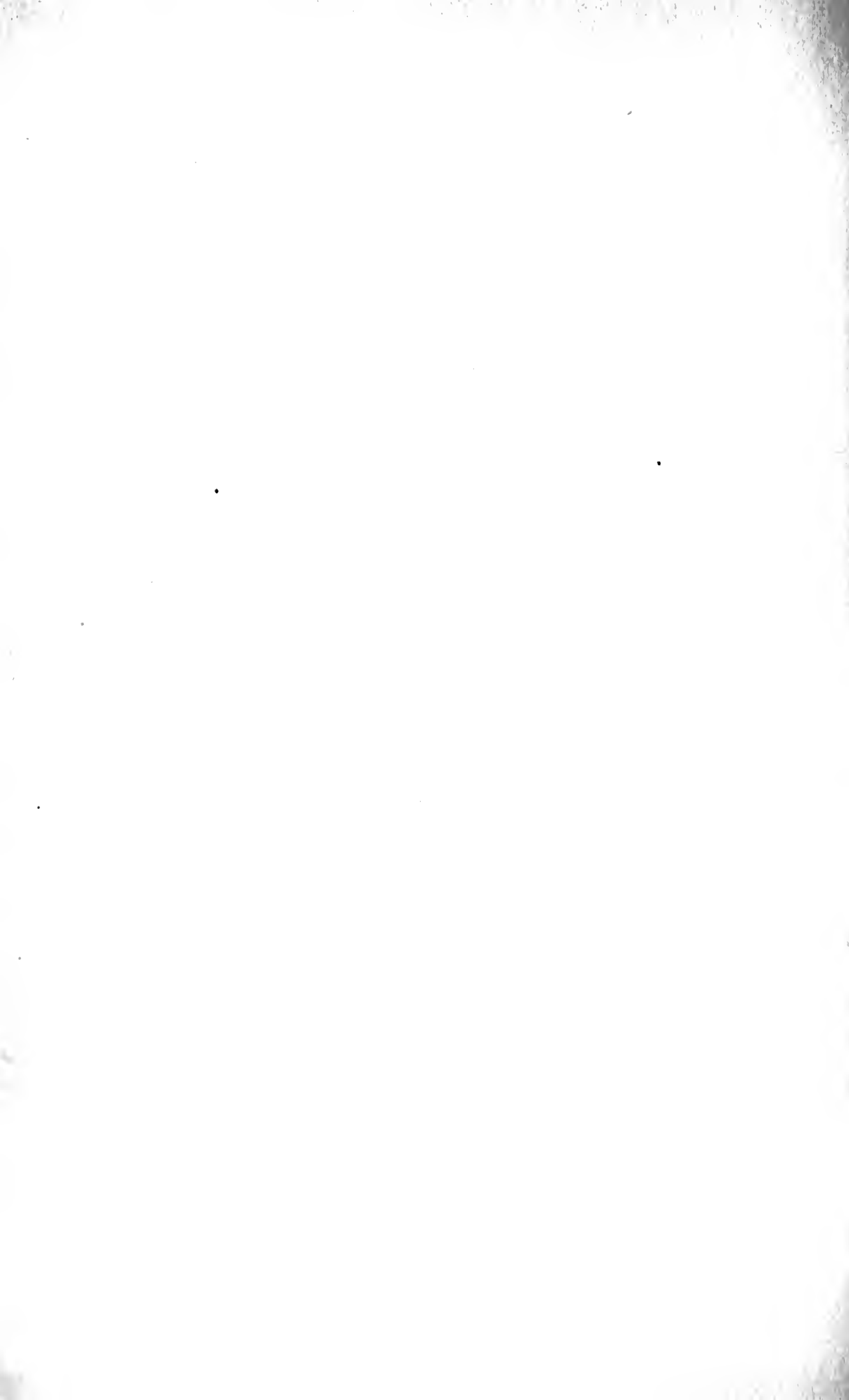
J. M. K. LETSON, et al.,
Appellees.

No. 944.

(May Term, 1903.)

Brief for Appellee, Alaska Packers Association.

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IN THE
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J. M. K. LETSON ET AL.,
Appellants,

vs.

ALASKA PACKERS ASSOCIATION,
Appellee.

} No. 944.

AND

ALASKA PACKERS ASSOCIATION,
Appellant,

vs.

J. M. K. LETSON ET AL.,
Appellees.

} No. 944.

**Opening Brief of Alaska Packers
Association.**

STATEMENT OF FACTS.

These are cross-appeals from a decree of the Circuit Court of the United States for the District of Washington.

The suit is in equity in the usual form, brought by the Alaska Packers Association, of San Francisco, against the firm of Letson & Burpee, of Fair Haven, for infringement of letters patent No. 376,804, dated January 24, 1888, for an improvement in can-capping machines, issued to Matthias Jensen.

There are sixteen claims in the patent; but only claims 1, 3, 5, 9, 10 and 11 were charged to be infringed. Of these the lower court found infringement of claims 5, 9, and 10, and non-infringement of claims 1, 3, and 11. Both parties have appealed, the complainant from that part of the decree adjudging non-infringement of claims 1, 3, and 11, and the defendants from that part adjudging infringement of claims 5, 9, and 10.

The decision of the lower court, rendered by Judge Hanford, is reported in 119 Fed. Rep., 599. The opinion appears in the record at page 434 *et seq.* We shall discuss both appeals in this one brief, and shall refer generally to the Alaska Packers Association as appellee and to Letson & Burpee as appellants.

THE INVENTOR.

The inventor and patentee is Matthias Jensen, of Astoria, Oregon, who has acquired no little celebrity in

can-making machinery, and whose name is already familiar to the court. He invented and secured patents for a complete system of automatic can-making machinery, including body-formers, solderers, fillers, crimpers, cappers, etc. One of the most celebrated of those machines is the Jensen can-filling machine now used all over the Pacific Coast and deemed indispensable to every well regulated cannery, the patent on which has expired.

After securing these patents, Jensen manufactured the devices covered thereby and put them into use. They proved to be machines of unusual merit, and extensive sales of them were made. He afterwards sold all of these patents to the Alaska Packers Association, the appellee herein, which company has used and is now using them in its salmon-canning business throughout Alaska and on Puget Sound. Its principal canneries on the Sound are at Blaine, Port Roberts, and Anacortes. In Alaska it operates canneries at Pyramid Harbor, Prince William Sound, Cook's Inlet, Karluk, Alitak, Chignik, Ugashak, Egigak, Naknek, Koggung and Nushagak. At all of these canneries the Jensen can-making machinery is used, and ninety-five of the patented can-toppers are in use in those canneries (Rec., 56).

The appellants Letson & Burpee are a manufacturing firm located at Fair Haven in Washington, engaged in the manufacture and sale of can-making machinery. They also have a factory at Vancouver in British Columbia, where they originally began the business. Having met with success there, they invaded the United States and established a factory at Fair Haven.

On July 25, 1899, *eleven years after the issue of the Jensen patent in suit*, a patent was issued to Letson & Burpee for a can-capping machine, being No. 629,574, and it is charged by the appellee that the machines made under this Letson & Burpee patent are an infringement upon the Jensen patent.

PRIOR LITIGATION.

An account of the prior litigation affecting the Jensen patents will prove interesting, and may possibly aid the court in construing the Jensen patent.

In 1891 the Norton Brothers brought suit against Jensen in the United States circuit court at Portland, claiming that the Jensen can-capping machine, constructed according to the patent here in suit, was an infringement upon the following patents owned by Norton Brothers: No. 267,014 of Nov. 7, 1882, to Edwin

Norton; No. 274,363 of March 20, 1883, to Norton & Hodgson; No. 294,065 of Feb. 26, 1884, to Norton & Hodgson; No. 307,197 of Oct. 28, 1884, to Edmund Jordan; No. 307,491 of Nov. 4, 1884, to Norton & Hodgson; No. 322,060 of July 14, 1885, to Edmund Jordan.

The case was tried before Judge Sawyer and resulted in a decree for Norton Brothers, holding that the Jensen machine was an infringement upon all of said patents.

Upon appeal taken from that decree, this court (Hanford, Hawley and Morrow, JJ., sitting) held that the Jensen machine was no infringement upon two of the specified patents, viz: No. 307,197 to Edmund Jordan and No. 307,491 to Norton & Hodgson, but was an infringement upon the Norton primary patent, No. 267,014, and the patents subsidiary thereto and improvements thereon.

This result was worked out by holding that the Norton patent, 267,014, covered an invention of a pioneer character, as shown by the record in the case. This ruling, however, was afterwards reversed in another case on the same patent, where a fuller showing of the state of the art was made, which case we shall refer to later.

The decision in this first case is reported in 49 Fed-

eral Reporter, at page 860, *et seq.* In the majority opinion, written by Judge Hanford, it is said *inter alia*:

“ We are of the opinion, however, that for some
 “ kinds of work the machine contrived by the appellant
 “ Jensen, *is an improvement upon any machines pre-*
 “ *viously constructed, and a very useful machine;* and
 “ that it is not an infringement of any rights of the ap-
 “ pellees under the patent issued to Edmund Jordan,
 “ No. 307,197, or the Norton & Hodgson patent, 307,-
 “ 491. * * * We hold that the Jordan ‘Can-End-
 “ ing Machine,’ Patent No. 307,197, by reason of being
 “ cumbersome and slow, in its operation, is not a prac-
 “ ticable machine for putting heads on tin cans of the
 “ size required for use in putting up fruits, vegetables,
 “ meats, fish, and similar materials for individual and
 “ family use; and, therefore, it cannot be infringed
 “ by the use of a *different machine which will do such*
 “ *work well at a reasonable cost.* * * * It is ob-
 “ vious that to move and operate upon well-filled cans,
 “ especially of liquid or semi-liquid substances, the
 “ cans must be in true vertical positions, and the move-
 “ ment must be so free from jarring or concussion as
 “ not to disturb the contents; whereas, one of the es-
 “ sentials of the (Norton & Hodgson) ‘Can-Ending
 “ Machine’ is a carrier or feeding chute so constructed
 “ as to bring the cans into such a position that by force
 “ of gravity they will drop into the half molds upon the
 “ periphery of the intermittently revolving belt. The
 “ machine will not operate upon filled cans in an up-
 “ right position without some additional device or sub-
 “ stitute for gravity to force the cans into the revolving
 “ half molds, for the clamp or mold has no attraction

“ for the cans or means for feeding them without the aid
 “ of an extraneous force. The contrivance of setting
 “ the can-ending machine in an inclined position and
 “ the adjustment of the feed and discharge chutes to
 “ work with it in that position can scarcely be consid-
 “ ered to involve the exercise of inventive genius, or any-
 “ thing more than mechanical skill; and being at best
 “ but partially successful in the accomplishment of its
 “ object, we cannot, under the law, as we understand it,
 “ hold that any right of the patentee has been infringed
 “ by the *Jensen machine, which the evidence shows to*
 “ *be in its operation upon filled cans a complete success.*
 “ The patent laws were not designed for the benefit of
 “ the man who *attempts* to originate a useful thing, but
 “ rather to reward the one who first *achieves success* in
 “ the production of it. It would be a perversion of the
 “ law to hold a machine which can do certain kinds of
 “ work to be an infringement of a patent for a different
 “ machine, which cannot do the same work.”

[Note.—The italics are ours.]

We understand the effect of the above-quoted decision to be a holding that the Jensen patent, here in suit, is good and valid. It is true that the Jensen patent was not sued on in that case, and for that reason the decision may, perhaps, not be a technical adjudication of validity. In that case, the Jensen patent was the one charged to be an infringement; but in determining that question, the Court of Appeals inquired into the novelty and utility of the Jensen invention and held that the

Jensen invention was one of very great merit, and thereby inferentially held, as we construe the decision, that the Jensen patent was good and valid. Whether or not we are right in this contention can be easily determined, inasmuch as this court undoubtedly knows what was intended to be held therein.

Shortly thereafter the Norton Brothers brought a second suit against Jensen, claiming that his original can-capping machine was an infringement upon Patent No. 214,292 of April 15, 1879, granted to William J. Gordan and assigned to and owned by the Norton Brothers. The lower court held that there was an infringement, and entered a decree in favor of the complainant. Upon appeal taken, this court held that there was no infringement and reversed the decree. The opinion was written by Judge Hanford, and is reported in 64 Fed. Rep., at page 600 *et seq.*

After the decision by this court in the original Jensen case, Mr. Jensen devised a new can-capping machine, differing materially in many respects from his original invention, and applied for and secured Patent No. 443,445 of December 23, 1890, covering the new invention. Thereupon the Norton Brothers brought suit against Jensen in the circuit court at Portland, claiming that this new Jensen machine was likewise an

infringement upon the Norton primary patent No. 267,014 and the Norton improvement patents thereon. A motion for a preliminary injunction was made and granted, from which Jensen prosecuted an appeal to this court. The decision was affirmed, on the ground that the appeal, being from an order granting preliminary injunction, the prior decision in *Jensen vs. Norton*, 49 Federal Reporter, was controlling. This decision is reported in 64 Fed. Rep., at page 62 *et seq.*, and the opinion was written by Judge Hanford. In that decision, we find the following:

“We recognize in the defendant’s new machine for
“bringing together the cylinders and heads or end
“pieces of tin cans and crimping the flanges with ac-
“curacy and rapidity, a useful improvement. Never-
“theless, we must disappoint his hopes at this time, for,
“until a complete determination of the controversy by
“the circuit court, this court cannot, consistently with
“good practice, pass judgment upon the main question.
“This machine does all the work of the previously pat-
“ented invention. That is a conceded fact. We must
“also concede the uncontradicted averments of the
“bill and the affidavits to the effect that said machine
“embodies all the elements in the combination claimed
“by the complainants and protected by their patent,
“and that it does infringe said patent. Without al-
“legations or testimony on the part of the defendant,
“we have no right to decide that, as a matter of law, the
“use of a new machine which operates so as to produce

“ the same result as previously patented inventions is
“ not an invasion of the rights granted by the patent,
“ unless it appears to us to be so obvious that infringe-
“ ments have been avoided that intelligent persons can-
“ not honestly differ in their opinions upon that sub-
“ ject. * * * Manifestly, therefore, the court can-
“ not, upon a mere application for a preliminary in-
“ junction, decide the disputed question affecting the
“ merits of the main controversy. * * * In view
“ of the admitted facts and the uncontradicted evi-
“ dence, the defendant’s contention appears to us to be
“ unreasonable. Duty does not require this court, in
“ advance of a final hearing in the circuit court, to take
“ up the challenge of counsel to prove by a comparison
“ of the rival machines in detail and a complete analy-
“ sis that they are substantially identical. We leave the
“ circuit court free to decide the case in the first in-
“ stance untrammelled by any expression of opinion by
“ this court upon the merits.”

Thereupon the case was remanded to the circuit court at Portland, and later on we shall detail its subsequent history. At present we are following the chronological order of the litigation.

About the same time as the above, the Norton Brothers brought suit in the circuit court at San Francisco against Milton A. Wheaton, claiming that a can-capping machine, made by Mr. Wheaton, was an infringement upon the Norton primary patent No. 267,014.

The case was tried before Judge McKenna in the

circuit court, who followed the decision of the court of appeals in the original Jensen case, and held that the Wheaton machine was an infringement of the Norton patent. An appeal was taken to the circuit court of appeals, and the decision upon that appeal is reported in 70 Federal Reporter at page 833 *et seq.* The decision was written by Judge Ross.

In this Wheaton case a full and complete showing of the state of the art was made, which had not been made in the original Jensen case, and upon such showing this court held that the Norton patent, No. 267,014, which, in the Jensen case had been held to be of a pioneer character, was not of a pioneer character and did not cover a primary invention, but merely an improvement over prior devices. This changed the whole phase of the controversy, and this court reversed the decree in the Wheaton case, holding that there was no infringement, and ordered the suit dismissed.

The decision in this Wheaton case virtually overrules the decision in the original Jensen case, reported in 49 Federal Reporter; for it is apparent, that if the evidence as to the state of the art, which was offered in the Wheaton case, had been introduced in the original Jensen case, then the same ruling would have been made in the original Jensen case that was made in the Wheat-

on case. Anyway the *Wheaton* case establishes the present *status* of the Norton patent and is now the law of this circuit, and the decision in the original Jensen case is no longer the law on that subject.

After the decision in the *Wheaton* case, a trial was had at Portland, before Judge Bellinger, of the second Jensen case hereinabove referred to, wherein it was claimed by the Norton Brothers that Jensen's second or improved can-capping machine was an infringement of the Norton patent. Judge Bellinger followed the decision in *Norton vs. Wheaton*, and held that there was no infringement, and that decision was affirmed on appeal, in an opinion written by Judge Morrow. (See *Norton vs. Jensen*, 90 Fed. Rep., 415.)

In addition to the foregoing litigation suit was brought by the Norton Brothers against Jensen in the circuit court at Portland, claiming that the can-body forming and soldering machines of Jensen were infringements upon various and sundry patents owned by Norton Brothers. A decree was rendered in favor of complainant in that case by the circuit court; but on appeal the decree was reversed and the bill was dismissed on the ground of non-infringement. This case was *Jensen vs. Norton*, 67 Fed. Rep., 236 *et seq.* The opinion was written by Judge Hanford. It does not particularly affect the present litigation regarding the

can-capping machine, inasmuch as it involved the can-body making and soldering machines, but we refer to it merely for the purpose of giving a complete history of the prior litigation.

From the foregoing, it will be seen that after a decade of litigation the Jensen patents for capping, crimping, body-forming, and soldering stand unchallenged as to validity, and are not infringements upon the rights of other inventors. It is not often that a bunch of patents acquires such a favorable standing before the courts prior to any suit brought directly on them for infringement, and this fact attests the great worth of the Jensen patents.

We now pass to another subject.

GENERAL SCOPE OF THE JENSEN INVENTION.

The Jensen patent contains sixteen claims, but we charge infringement of only claims 1, 3, 5, 9, 10, and 11. The validity of these claims is not assailed by the defendants. The sole defense made is non-infringement.

A portion of the machine relates to a crimping mechanism, and six of the sixteen claims are intended to cover such a device. The defendant's machine does not contain any crimping mechanism, leaving that operation to be performed by a separate independent machine. Consequently, all that portion of Jensen's ma-

chine relating to the crimper may be dismissed from consideration.

The primary object of the Jensen machine is to put caps on cans *already filled*, and more particularly upon cans filled with fish. The specification says: "This apparatus is especially intended to receive cans which have been filled with fish or other material."

Prior to the Jensen invention machines for placing caps on cans were almost numberless, but they were all intended to operate only upon *unfilled* cans. In the operation of canning perishable products the cans were first filled and then the caps were placed on *by hand*, requiring skilled labor therefor. In the salmon canning industry this capping of the cans by hand was a particularly difficult operation. Unless it was done accurately and nicely, many cans were spoiled, and, consequently, skilled labor was necessary; and being done by hand, the operation was necessarily slow. And furthermore, the hands of the workmen were liable to become lacerated and cut by the sharp tin, and the liquid contents of the cans entering these cuts and lacerations, caused the hands of the workmen to become sore and chapped, so that it was not an unfrequent occurrence in the old operation that the workmen would be disabled by reason of sore hands and compelled to quit

work. Besides this, in the hand operation the constant and delicate manipulation of the fingers caused them to tire quickly, and the workmen would have to stop to rest. This was a constant source of annoyance. It is obvious at a glance that a machine, which would automatically place the caps on these filled cans would be a very useful thing in the canning industry.

Now, as stated above, prior to the Jensen invention there was no automatic machine known or in existence which would successfully place caps on filled cans. Mr. Jensen was absolutely the first in the art to devise a machine for performing that operation, and the fact that the machine in question did and does successfully perform that operation is beyond all peradventure of a doubt.

Mr. Bradford, who has had an experience of twenty-seven years in the business, testified that the Jensen machine was the first one in the art which successfully headed filled cans, and that the operation of heading filled cans had formerly all been done by hand. (Dep. Bradford, Rec., p. 55.)

F. A. Robbins, who has perhaps had more experience in building can machinery than any other person on the Pacific Coast, testified to the same effect, saying: "Up to that time (three years ago) it really was the

“only successful can-topping machine in existence; “that is, for heading filled cans.” (Dep. of Robbins, Rec., p. 62.)

Wm. Munn, superintendent of the complainant's canneries and a practical can-making machinist, was equally emphatic. His testimony is particularly valuable because he assisted Jensen in getting up the machine and building and operating the first ones constructed. He is probably more familiar with the machine than any other person, except Jensen himself. He testified that prior to this invention filled cans had always been capped by hand; that experts were required therefor, and it was difficult to get them because they had to be taken from San Francisco to Alaska; that one of these experts could cap only about 12 cans per minute, whereas one Jensen machine could cap 90, and sometimes as many as 100; furthermore, that by the hand operation, the caps could not be put on so tight as by the machine, a fact which is quite evident. He further testified that it was a very valuable machine and that “they are used in every cannery in Alaska “where they can get them.” (Dep. of Munn, Rec. 269-275.)

Defendant Burpee likewise testified to substantially the same effect. He said he had known of the Jensen

machine since the litigation with Norton and he knew of no automatic machine for heading filled cans in practical use prior to the Jensen header. (Dep. of Burpee, Rec., X. Q., 296, p. 496.)

He likewise testified that several machines had been invented and patented for capping filled cans since the date of the Jensen patent and within the last few years. As a matter of fact, these subsequent machines have all been invented within the last three years, as is apparent from the testimony of Mr. Robbins, who states that until within the last three years the Jensen machine was the only successful one in existence for capping filled cans. (Dep. of Robbins, Rec. q. 24, p. 62.) Under these circumstances, we have a case where the patent sued on is the first of its kind in the art, where it immediately went into general and extensive use, and after ten years of successful use imitators brought out so-called improvements thereon, which we contend are infringements thereof.

At the oral argument in the lower court, it was admitted by counsel for defendants that the Jensen machine is of a pioneer character, standing at the head of the art, for capping filled cans, and that prior thereto no automatic machine for that purpose was known or in use.

In this connection we may also refer to the fact that in the original Norton-Jensen case, reported in Vol. 49 of the Federal Reporter, the learned counsel for defendants herein (Mr. Wheaton) was the attorney for Mr. Jensen, and he there argued most successfully in behalf of the merits of the Jensen machine. Referring to his argument in that behalf this court said:

“Appellant contends that Jensen’s invention was brought about by the necessities of the salmon canning industry; that his machine is especially adapted to putting the final heads on cans filled with fish or other substances; *that it is the only machine for heading cans that can practically be used for this purpose.*”

The gentleman was clearly right in the foregoing statements. The Jensen invention *was* brought about by the necessities of the salmon canning industry and *was* at the time stated the *only* machine for heading filled cans that could practically be used for that purpose. It marked the beginning of the art.

Under these circumstances the court will look with favor upon this highly useful invention and will give it a broad and liberal construction as one standing at the very head of the art, which successfully accomplishes a useful result never accomplished before.

The law governing such cases is too well known to

the court to require a lengthy citation of authorities. It is sufficient to refer to a limited number.

As early as 1857 Mr. Justice Grier, in the case of *McCormick vs. Talcott*, 20 How., 402, speaking for the supreme court, said:

“The original inventor of a device or machine will have a right to treat as infringements all who make machines operating on the same principles and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original and patentable as such.”

Later on Mr. Justice Bradley, speaking for the court in *Railway Co. vs. Sayles*, 97 U. S., 554, said:

“Where an inventor precedes all others in a particular department and invents a new machine never used before and procures a patent for the same, he acquires a monopoly as against all merely formal variations thereof.”

And finally, in the case of *Morley Machine Co. vs. Lancaster*, 129 U. S., 273, Mr. Justice Blatchford, speaking for the same court, said:

“Where an invention is one of a primary character and the mechanical functions performed by the machine are as a whole entirely new, all subsequent machines which employ the same means to accomplish the same result are infringements, although the sub-

“sequent machine may contain improvements in the
“separate mechanisms which go to make up the ma-
“chine.”

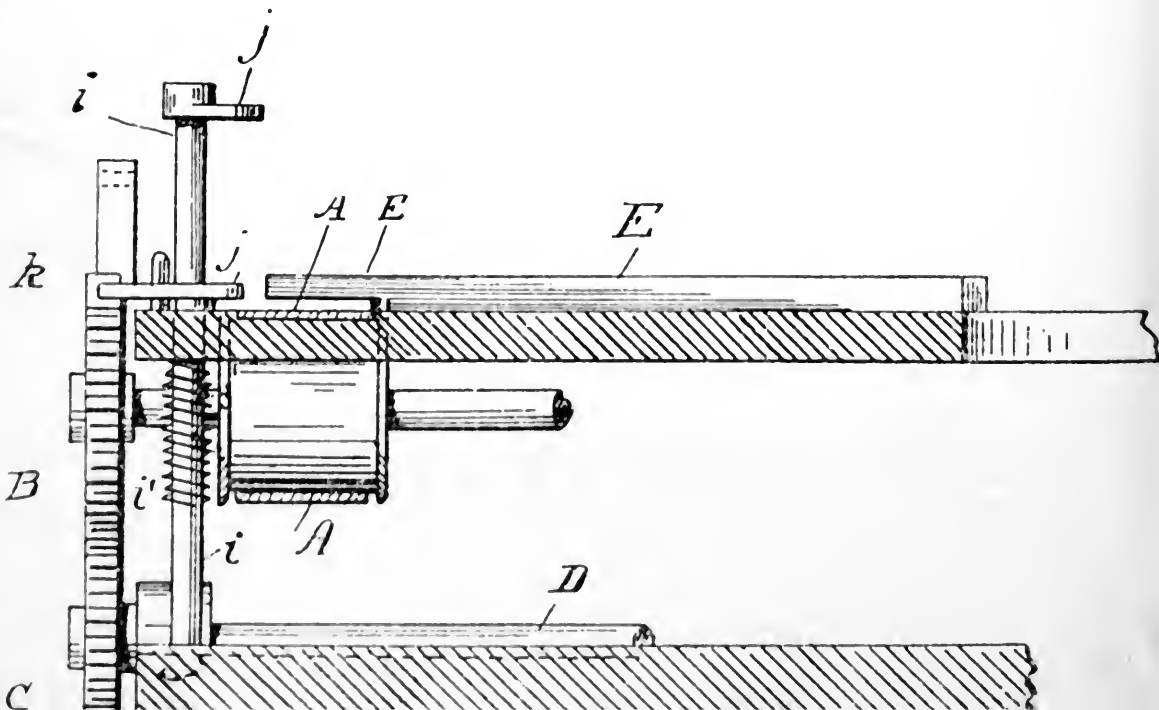
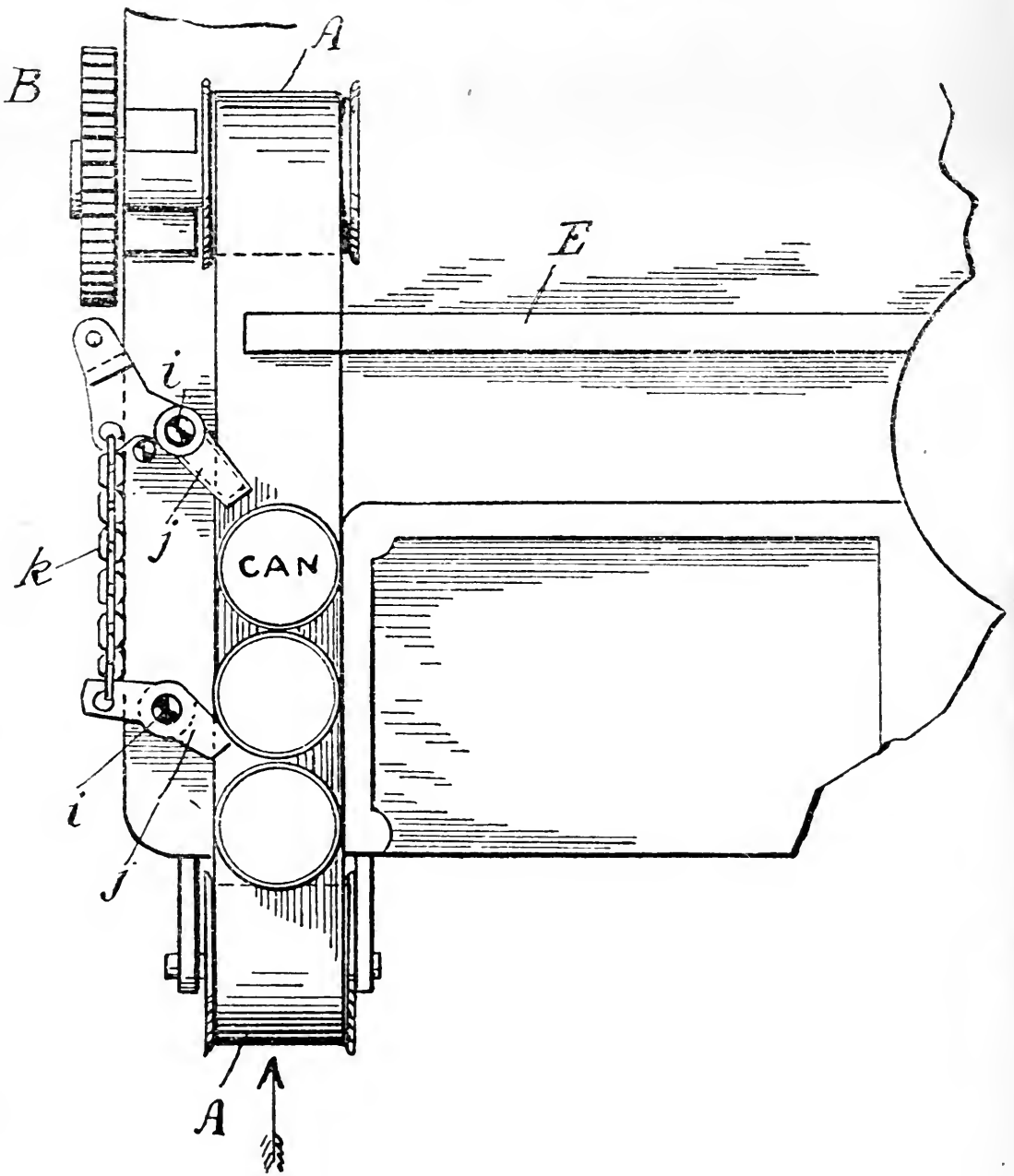
Later on we shall refer to these cases more in detail, but at this stage of the brief it is sufficient merely to refer to them generally.

DESCRIPTION OF THE JENSEN MACHINE.

The machine disclosed in the patent is most ingenious in construction and reflects great credit upon the inventive skill of its designer. At first glance it appears quite complicated in its mechanism; but when carefully analyzed, it will be found to be comparatively simple, embodying easy and graceful movements and working with the precision of clock-work. Fundamentally it consists of the following elements:

1. *An endless can-feeding belt for feeding the cans to the machine.*
2. *Arms swinging over the belt to render the delivery of the cans from the belt to the feeder exact.*
3. *A stop extending transversely across the belt to arrest the forward movement of the cans and change their direction.*





4. *A feeder, which by a circular sweeping motion transfers the cans from the belt to the capping mechanism.*

5. *A cap-feeding device consisting of an inclined chute and connecting mechanism for supplying the caps one by one.*

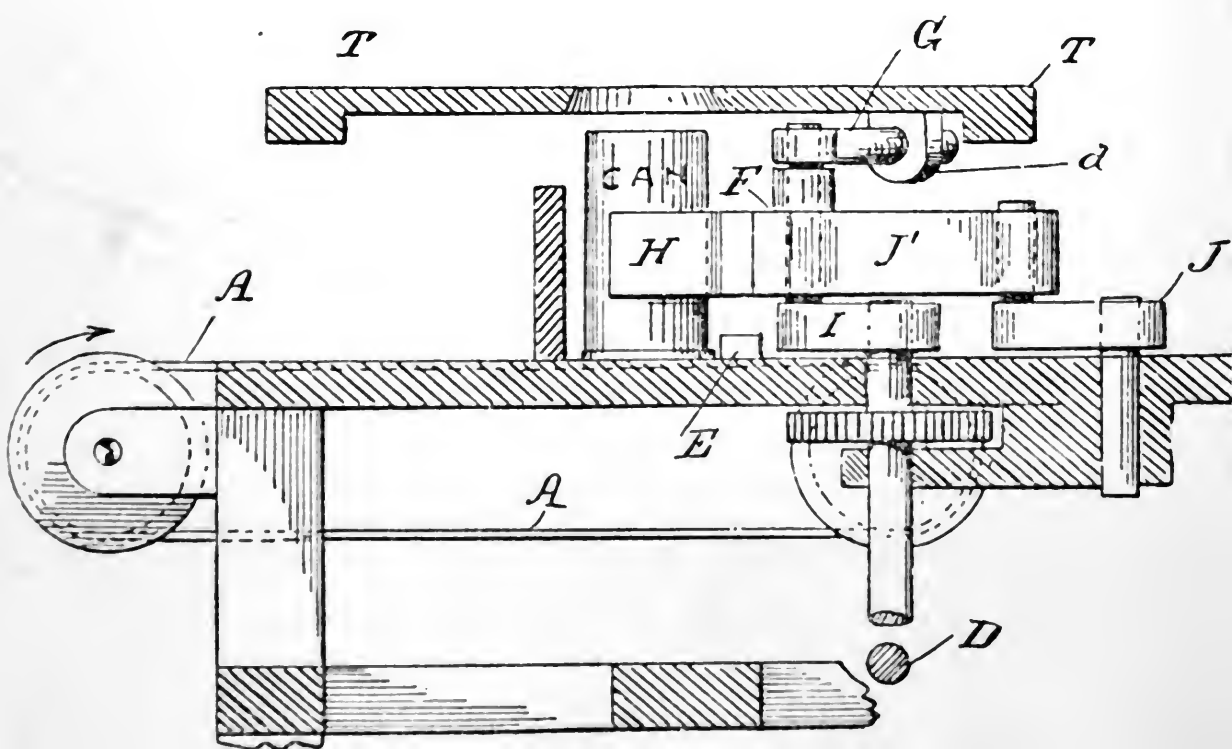
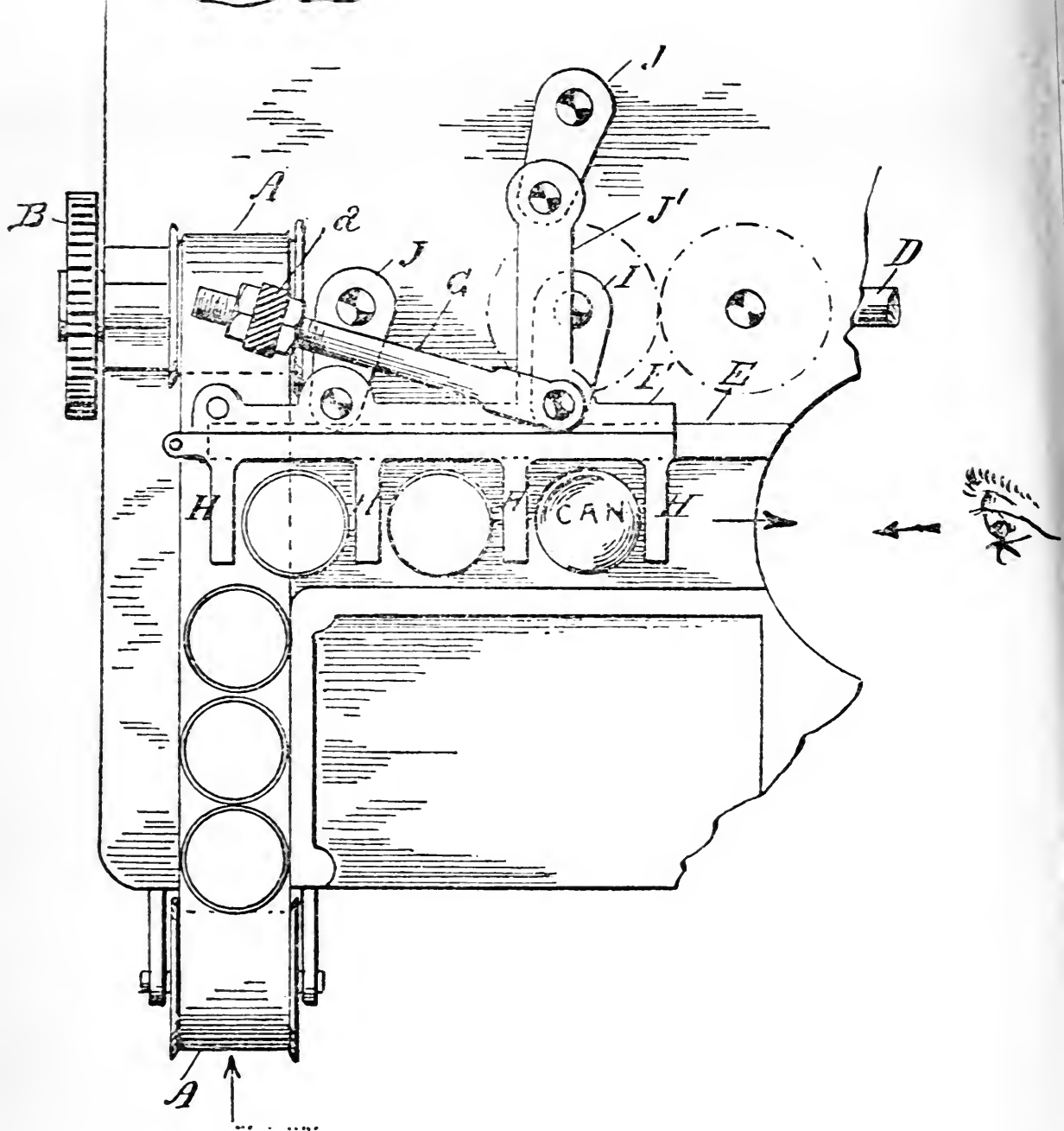
6. *A mechanism whereby each can releases its own cap, consisting of a stop in the path of the caps, a trigger in the path of the cans, and a connecting mechanism between the stop and the trigger, so arranged that the can pulls the trigger and thereby releases the cap.*

7. *A capping mechanism, consisting of two oppositely disposed vertically reciprocating plungers, a conical guide for sizing the upper end of the can-body, and transversely moving cap-holding slides.*

In addition to the above elements, there is a crimping mechanism for crimping the caps on the cans; but, as this element is not found in the defendant's machine, we dismiss it from further consideration.

For greater perspicuity we will take up these elements *seriatim* and illustrate them by drawings. In the cut on the adjoining page, marked "Cut I, Jensen's Can-feeding Mechanism," the endless traveling belt is designated by the letter A. It is called in the patent a

“feed belt,” and the filled cans are placed upon that belt by hand in a vertical position with their open ends upwards. The belt passes around drums or rollers at each end in the usual manner of such belts. The drum at the inner end is mounted upon a shaft, having a gear wheel B on its outer end, which engages with a pinion on the main driving shaft, thereby imparting motion to the belt, though any other appropriate mechanism may be used for that purpose. The devices marked “jj” are used as spacing devices for the cans. They are described in the patent as arms projecting above the belt to control the movement of the cans, and only allow them to move forward so as to arrive at the feeder in the proper time to be received by it and carried forward. These arms are connected together by the chain “k,” or any other flexible connection, and have an intermittent motion back and forth longitudinally of the belt. They are also similarly connected to the feeder, not shown in this cut. The letter “E” in the drawing designates the transverse stop, which, in this instance, consists of a stationary bar, and which arrests at that point further forward progress of the can and changes its direction. By the above described mechanism the cans are carried one by one to the point on the belt where their forward motion is arrested by the stop “E,”

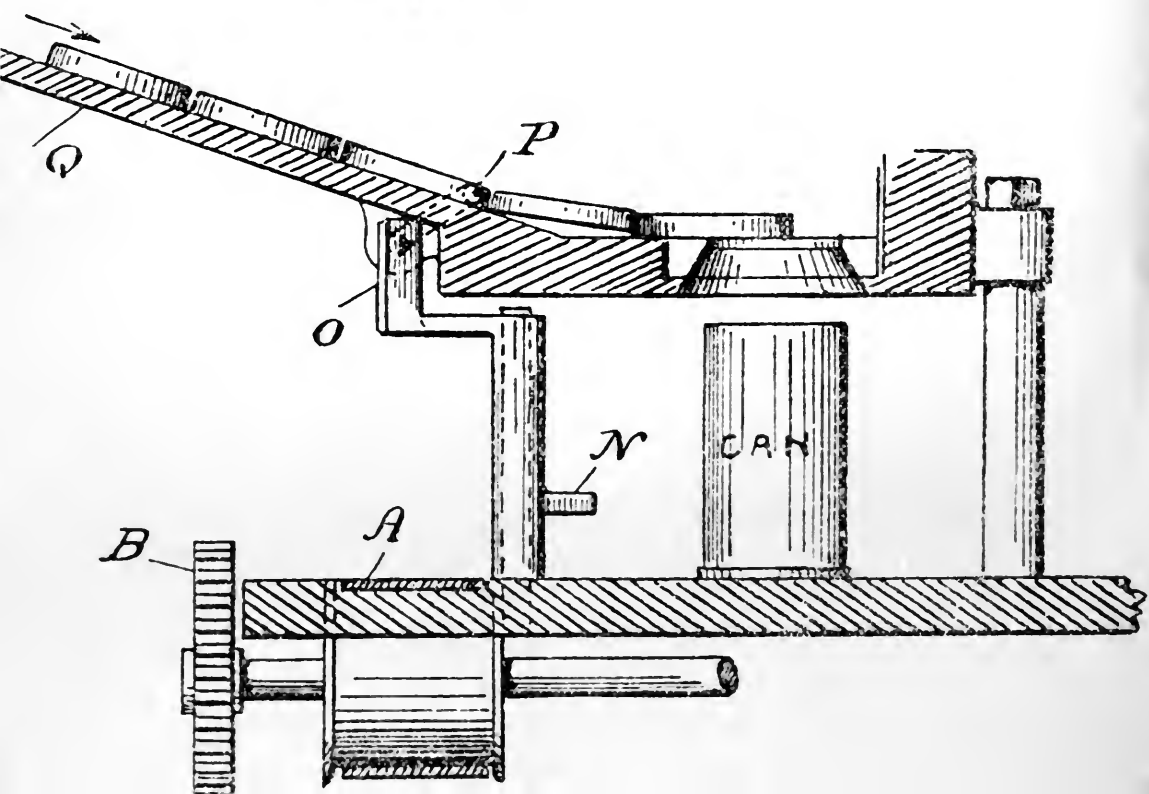
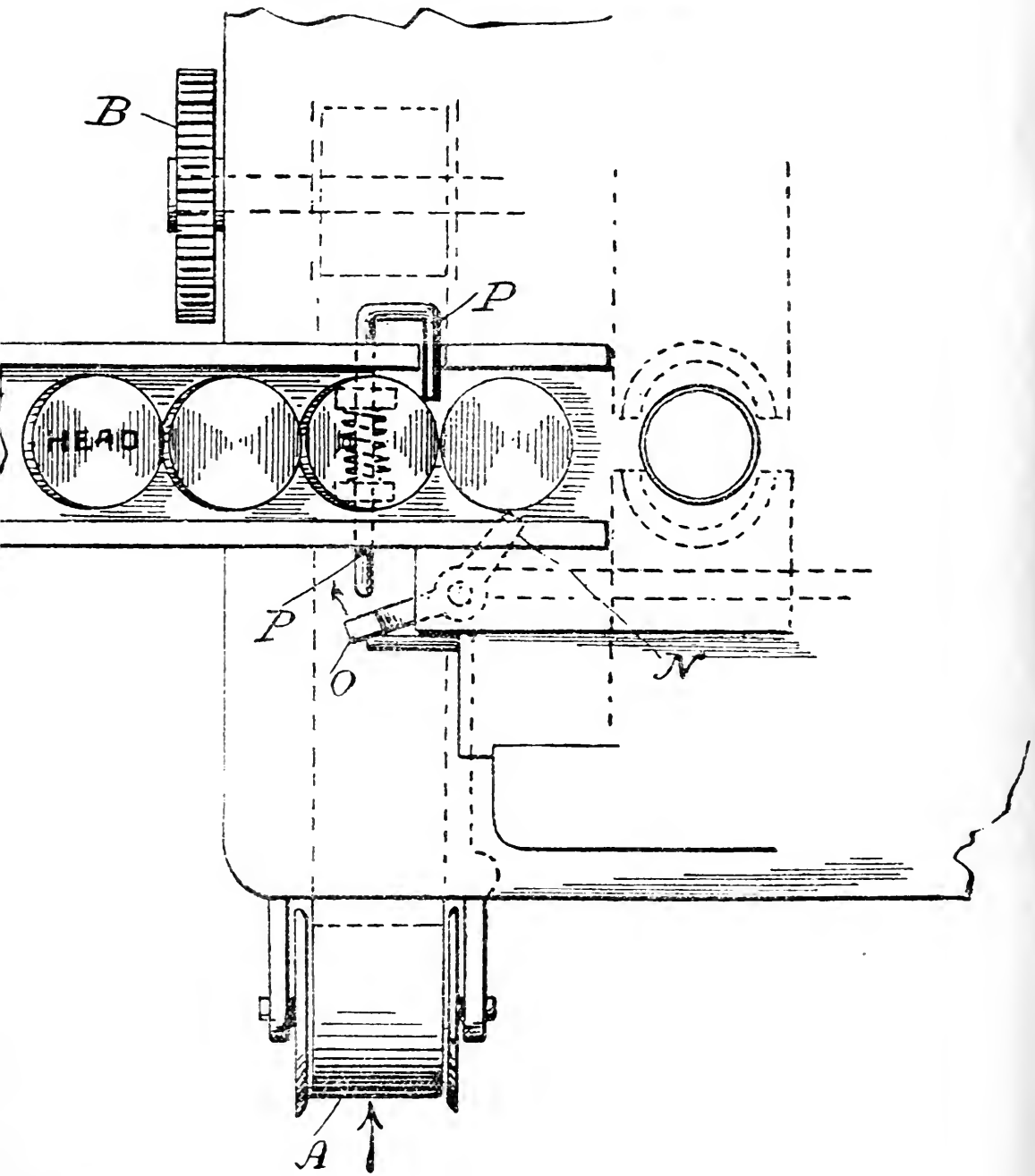


the arms "jj" reciprocating back and forth longitudinally of the belt for that purpose to insure accurate delivery of the cans, one by one, and to prevent crowding, or delivery at the wrong time.

The next element in the machine consists of the feeder, which device receives the can at the point where forward motion is stopped, and transfers it from the belt to the capping mechanism. The cut on adjoining page marked "Cut II, Jensen's Feeder," illustrates the device. This feeder is designated in the drawing by the letter F. It consists substantially of a transverse bar with four arms attached thereto at right angles, and marked in the drawing by the letter H. These arms are spaced equally so as to provide three pockets or receptacles into which the can fits. The actuating mechanism of this feeder consists of three cranks, lettered JJJ, to which motion is imparted from the main driving shaft, producing "a circular sweeping motion of the feeder." The can is first delivered between the first two arms of the feeder, and by them swept off of the belt by a circular sweeping motion, and left in a certain position on the table. The feeder then swings back for another can, leaving the first can stationary momentarily upon the table, and by the next movement of the feeder, the first can is grasped between the second two arms and carried a step further, and placed upon

the lower plunger beneath the capping mechanism, where the cap is applied by a mechanism to be hereafter described.

The next drawing, reproduced on the adjoining page and marked "Cut III, Jensen's Cap-Feeding Mechanism," shows the further mechanism of the machine, consisting of the apparatus for feeding the caps. The caps are fed to the machine, one by one, from an inclined chute, designated by the letter Q. At the bottom of the chute is mounted a spring arm P, the upper end of which is curved and extends into or above the cap chute, and thus normally stops the caps and prevents them being moved any further down the chute until the proper time arrives for releasing them. The letter N designates a trigger-arm, placed directly within the line of travel of the moving cans, so arranged that each can will strike against it. This trigger has attached to it another arm O, projecting upwardly, so as to press against the spring arm P, as shown by the arrow in the plan view. When the can presses against the trigger N, the arm O in turn presses against the spring-arm P, and thereby moves its curved opposite end from the path of the caps and allows a cap to pass down the chute towards the capping mechanism. As soon as this cap passes down, the spring in the spring-arm P causes said





arm to resume its normal position and thereby prevents the other caps in the chute from passing down the same. By the operation of this mechanism, it will be seen that a cap is released by the operation of the can striking against the trigger N, *so that each can-body releases its own cap.* This particular feature of the machine, whereby each can is caused to release its own cap from the chute, is absolutely novel with Mr. Jensen. Prior to his invention there was no such device, nor anything resembling it in the remotest way in existence. One of the claims of the patent covers this invention broadly as a pioneer invention.

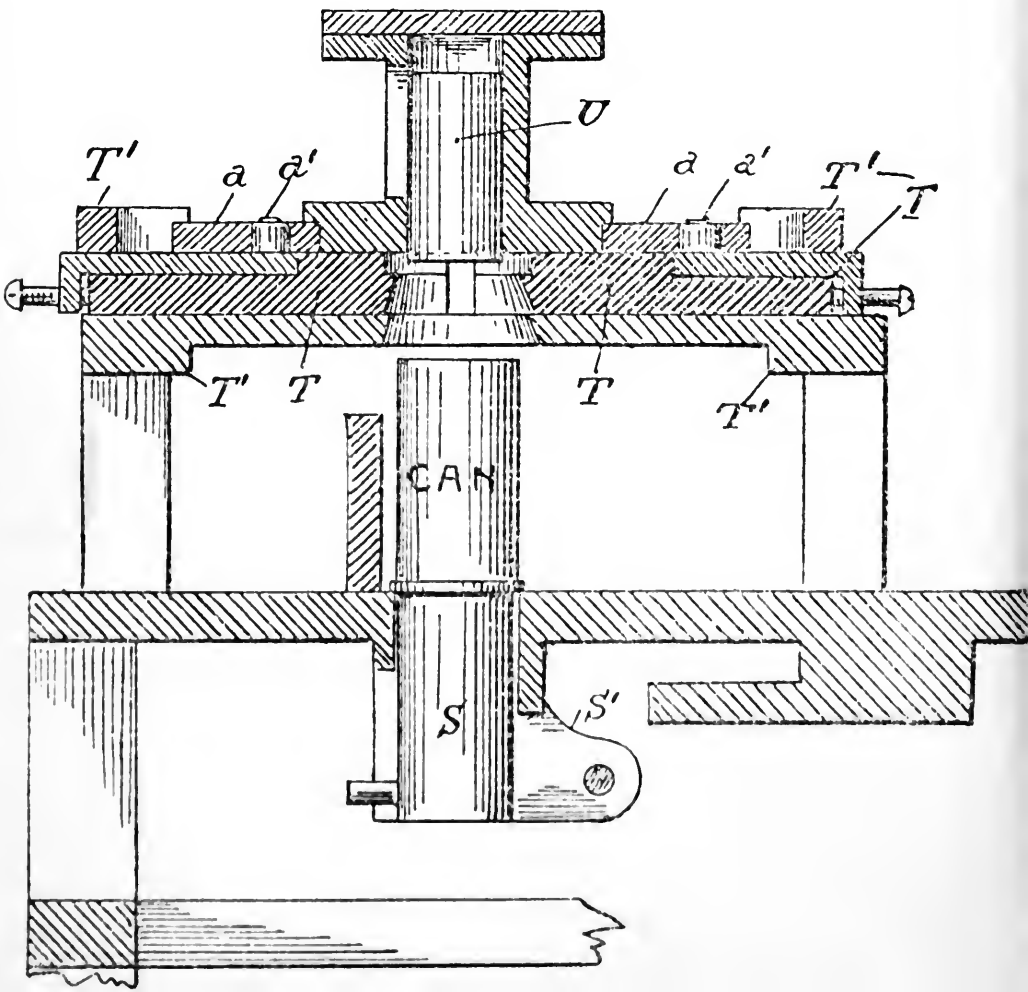
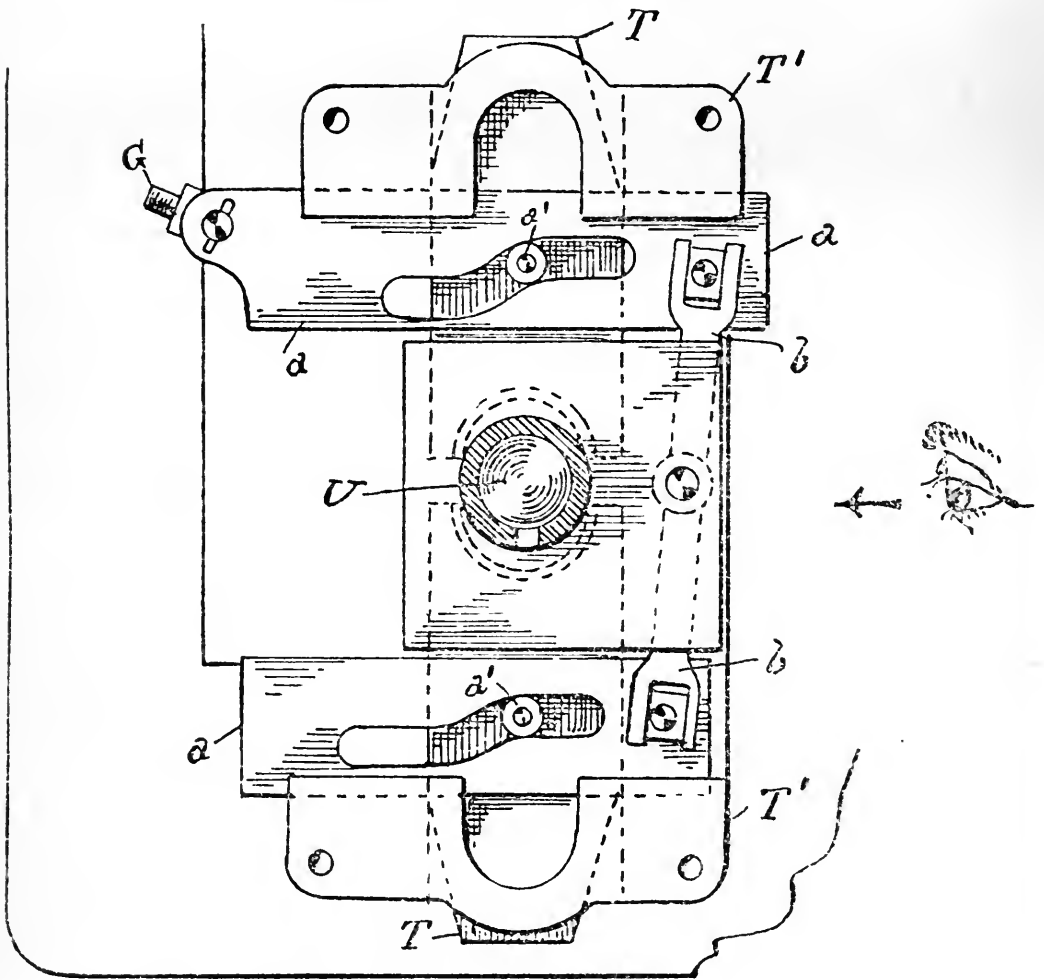
After a cap has been thus released from the chute, a further mechanism is provided which acts positively to grasp the cap and carry it to the capping mechanism. This device, however, is not material to the point now under investigation, and therefore, we have omitted it from the drawing. Our desire is to illustrate only the necessary parts which go to make up the claim, and this we do for purposes of perspicuity.

It remains only to describe the capping mechanism. This consists of a lower plunger upon which the can is delivered from the feeder, a conical guide within which the upper end of the can is forced, two slides adapted to move towards each other transversely, and

having their ends shaped in a semi-circle, so that when they come together they form a complete circular space. An annular rim, or shoulder, is cut in the face of these semi-circular slides, so that when they are brought together a seat is formed upon which the can cap rests. An upper plunger is located immediately above this circular space. When the can is placed upon the lower plunger, this plunger rises upward by appropriate mechanism and pushes the upper end of the can through the conical guide, which serves to size or round up the upper end of the can-body, also to bring the can in line with the cap and to compress the fish or other material which may project slightly above the top of the can, so that it will be properly inclosed and forced into place when the cap is put on. In this way the upper end of the can-body is forced upward into the can-head. Then the upper plunger descends upon the top of the capped can, while the semi-circular slides recede and allow the capped can to pass through the conical guide and descend to its position on the table, being followed down by the upper plunger. When the capped can reaches its initial position on the table, it is grasped between the last two arms of the feeder and transferred to the crimping mechanism.

For a clearer understanding of the construction of the capping mechanism, we refer to the drawing on

FIG. IV.
Jensen's Capping Mechanism.



adjoining page, marked "Cut IV, Jensen's Capping Mechanism." In that drawing the lower plunger is marked S, and a can is represented as having been placed thereon. Immediately above the top of the can will be seen the conical guide consisting of two parts, marked T'T', which is nothing more than a conical hole in the table. Immediately above this conical hole are the transversely moving slides TT. They are so arranged that, as they move together, they form a circular hole immediately over the conical guide, with a ledge or rim cut on the inside of the circle upon which the can cap rests. This annular rim is of the thickness of the tin forming the can, and while the cap rests on this rim as a seat, it is prevented from falling through the conical hole beneath, thereby enabling the upper end of the can to be inserted into the cap. This annular rim or space is the famous old "annular space," which formed the subject of controversy in the Norton cases.

The upper plunger is designated by the letter U. After the upper end of the can has entered the cap, the transversely moving slides are withdrawn, thereby allowing the capped cans to pass downward through the conical guide, and the upper plunger U, resting on the top of the capped can, follows it downward and steadies

it in its downward passage. This upper plunger also acts as a back-plate, or resisting surface, when the can-body is forced into the cap.

We have not shown on this drawing the details of mechanism which operate the plunger, as that is not material for our purpose. No claim is made to any invention in the form of those operating mechanisms, the claims calling generally for "operating mechanisms" in that regard.

We have now described the basic elements of the machine, as called for by the claims. There are other devices shown in the patent, consisting of auxiliary devices, such as the mechanism for delivering the released caps from the bottom of the chute to the capping mechanism; also certain forms of driving and operating mechanisms for the plungers, slides, and feeder; but they are not material to the claims under consideration, and, therefore, we omit detailed description thereof.

THE CLAIMS IN SUIT.

As already stated, the claims charged to be infringed, are Nos. 1, 3, 5, 9, 10, and 11. They read as follows:

1. An endless traveling carrying belt, a stop E, ex-

tending across it to change the direction of the cans, and arms swinging over the belt, whereby the delivery of the cans from the belt to the feeder is rendered exact, substantially as herein described.

3. In combination with a transverse belt, the feeder having the projecting arms between which the cans are received from the belt and the actuating devices by which the motions of the feeder are produced, substantially as herein described.

5. The inclined chute into which the caps are placed and a stop extending across said chute, so as to prevent the caps from moving downward, in combination with a trigger extending across the path of the cans moved toward the capping table, said trigger being connected with the stop, so that as it is moved backward by the passage of the can, it withdraws the stop to allow a cap to move down the chute, substantially as herein described.

9. The vertically moving plunger upon which the cans are delivered by the feeder, in combination with the conical guide situated above the cans, and the transversely moving slides upon which the caps are received and held, with a mechanism by which the

slides are withdrawn as the can enters the cap, substantially as herein described.

10. The vertically moving plunger by which the can is raised to receive the cap, and the guide into which the upper end of the can enters the transversely-moving cap-holding slides, in combination with the second plunger moving vertically above the cap and following it down by gravitation or otherwise so as to steady the can in its descent after the cap has been applied, substantially as herein described.

11. The vertically moving plunger upon which the can is received, a carrier for placing the can upon the plunger, and a mechanism by which this plunger is reciprocated vertically in combination with a second plunger, which rests upon the top of the cap and steadies it while descending, and a mechanism for raising the second plunger before the arrival of the next cap, substantially as herein described.

The next matter of inquiry will be as to the state of the art, so that we can properly determine the construction of these claims.

STATE OF THE ART.

That our construction as to the scope of the Jensen claims is correct is sustained by the showing of the state of art made by the defendants. Only two prior patents were offered by them for that purpose, those of Edmund Jordan, No. 307,197, dated October 28, 1884, for a can-heading machine, and that of George A. Marsh, No. 265,617, dated October 10, 1882, for a machine for making cans.

The Jordan machine illustrated between pages 542 and 550 of the Record shows a segmental clamp-chuck, mounted on a vertical shaft and controlled by a mechanism which gives it two motions, one horizontal and the other vertical, so that the result of the two motions is an inclined plane. The chuck is composed of several segments operated by a spring, which segments, when brought together, form a circle with a beveled mouth below and an annular space at the top. Two rotating tables are ranged, one for the purpose of feeding the cans and the other the caps. The cans and caps are placed upon these rotating tables by hand, and the chuck swings around and grasps a can-cap, then ascends and swings over the can-body and places the cap on.

How this patent can have any relevancy to the issues

involved in this case passes our comprehension. We surmise that the part of the Jordan machine, which counsel lays stress on, is the segmental clamp-chuck, and that he will use it for the purpose of contending that the capping mechanism in the Jensen machine, consisting of the conical guide and transversely moving slides, was not novel with Jensen. If so, the point will be without force, inasmuch as Jensen does not claim that mechanism by itself as a separate and independent invention. True, it is *one* of the elements in *some* of his claims, but it is only one of the elements, not the whole combination. He had a perfect right to make use of anything which was old in the art, and if he found in the art a conical guide with transversely moving slides, he had a perfect right to put them into combination with other elements and thereby form a new and useful machine.

This Jordan patent is one of the patents sued upon in the case of *Norton vs. Jensen*, 49 Fed. Rep., 859, concerning which this court used this language at page 874 of the report:

“We are of the opinion, however, that for some kinds
“ of work the machine contrived by the appellant Jen-
“ sen, is an improvement on machines previously con-
“ structed, and a very useful invention, and that it is not
“ an infringement of any rights of the appellees un-

“der the patent issued to Edmund Jordan, No.
“307,197. * * * We hold that the Jordan can-
“ending machine patent, 307,197, by reason of
“being cumbersome and slow in its operations
“is not a practicable machine for putting heads
“on tin cans of the size required for use in put-
“ting up fruits, vegetables, meats, fish and similar ma-
“terials for individual and family use; and therefore
“it cannot be infringed by the use of a different ma-
“chine which will do such work well at a reasonable
“cost. It is true that Mr. Norton has testified that a
“Jordan machine, set up in his factory, has been oper-
“ated successfully. But this is only the conclusion of an
“interested witness. He states no particulars as to the
“time during which the successful operation of the ma-
“chine continued, nor the number of cans, whether one
“or a dozen or more, that were successfully operated
“upon; and he does not state whether or not the ex-
“pense attending the successful operation was or was
“not the cause of discontinuing the same; and besides
“this same witness admits that this machine is too slow
“in its operation to be profitably employed in heading
“cans of the size required in the largest numbers. The
“most that he claims for it is that it is a splendid work-
“ing machine for putting covers on gallons or other
“large cans, a class of work for which, so far as the
“evidence discloses the fact, the Jensen machine has
“not been used. Mr. Jordan is not the inventor of the
“molds or discoverer of the principle of the segmental
“clamp described in the specification for his patent.
“His invention consists of a new use of these appli-
“ances in combination with others to produce certain
“results.”

In view of this adjudication regarding the Jordan patent, it is difficult for us to see how the learned counsel for appellants can hope to convince the court that the said Jordan patent in any way affects the Jensen invention. According to that adjudication, the Jordan machine cannot do the work of the Jensen, but can only head gallon and other large cans, a class of work which the Jensen machine was never intended for.

And, furthermore, it is plainly apparent from the Jordan patent that it was never intended for putting caps on filled cans. No mention of any such proposed operation is even vaguely hinted at in the Jordan specification. On the contrary, it is there shown to be a device for putting the two ends, top and bottom, on can-bodies.

The witness Burpee expressed the opinion that the Jordan machine might be used for putting caps on filled cans, and he bases this opinion solely on the fact that the can-bodies are supplied to the chuck in an upright position. In this view the witness is, in our judgment, entirely mistaken. It is plainly apparent that the Jordan machine cannot be successfully used, as shown in the patent, for placing caps on *filled* cans. Indeed this court held in the Norton-Jensen case that it could not be used successfully for placing caps on any

kind of cans, whether filled or unfilled. It may be true that the vertical position of the can in the Jordan machine might admit of a cap being placed on the can when said can is filled, but it must be remembered that the vertical position of the can is not the only element in the problem of placing caps on filled cans. It is only *one* of such elements, and the mere fact that the cans are shown in a vertical position in the Jordan patent does not imply that the machine will successfully operate on filled cans. To cap filled cans is much more difficult than to cap unfilled cans, and it would be necessary to supply other devices than those shown in the Jordan patent to make it a successful machine for operating on filled cans. We think it too palpable for further argument that the Jordan machine was never intended to operate on filled cans, and that it would be an utter impossibility for the machine, as described in the patent, to successfully operate on filled cans. As a matter of fact it was never used for filled cans.

Regarding the other patent cited by the defendant, that of Marsh, No. 265,617, dated October 10, 1882, only a word will be necessary. It is shown between pages 536-9 of the Record. This device is not an automatic machine at all. It is a hand implement, known as a *bench-header*. It is a small contrivance to

be placed on a workman's bench and operated by hand or possibly by a treadle. It has no cap-feeding device, no can-feeding device. The caps and the cans are to be delivered by hand. In other words, the workman picks up and places the can-body in the machine by hand, then picks up a cap and places that in the machine by hand, after which he telescopes the two together by hand power. Clearly such machine has no relevancy to an automatic can-heading machine. The only feature in it claimed to resemble the Jensen is a conical guide for guiding the upper end of the can into the cap. But Jensen does not lay any claim to such device alone. It was old in the art when he appeared upon the scene, and if he desired to use it in his new combination as one of the elements thereof, he had a right to do so.

The witness Burpee was asked by his counsel whether this Marsh machine would cap filled cans, and he answered that it would. But it is apparent that it would not cap a filled can any better or in any different way than a workman could cap a filled can by hand, without the aid of any mechanism. It is not a machine for capping filled cans. It was not intended for that purpose, nor is it well adapted for that purpose, and it is verging dangerously on the ridiculous to cite this Marsh patent as having any relevancy to this case.

The state of the art as thus shown by the defendant Burpee's testimony serves only to magnify the value of the Jensen invention. It shows as clearly as possible that prior to Jensen there was no known machine for placing caps on filled cans, certainly no automatic machine, and no machine of any kind whether automatic or otherwise, that was intended for that purpose. Jensen was the first to produce an automatic machine for placing caps on filled cans, and that fact stamps his invention as one of a pioneer character. No one knows this better than the learned counsel for appellants Letson & Burpee. He has acted as the attorney for Mr. Jensen in the litigation heretofore had, and in that litigation he argued ably and successfully for the Jensen invention. If we should now read to your Honors from his brief in that litigation, the language there used in favor of the Jensen machine would perhaps appear quite as strong as any we have used in this brief. The admission made by him at the oral argument in the lower Court as to the pioneer character of that invention is all that we could desire.

CONSTRUCTION OF THE CLAIMS.

Having now firmly in mind the state of the art, we are prepared to construe the Jensen claims charged to be infringed, and in so doing we take them up seriatim.

CONSTRUCTION OF CLAIM ONE.

“ An endless travelling carrying-belt, a stop E, extending across it to change the direction of the cans, and arms swinging over the belt, whereby the delivery of the cans from the belt to the feeder is rendered exact, substantially as herein described.”

The function of this claim is the supplying of cans to the feeder, and the elements going to make up the combination are (1) the belt, (2) a stop extending transversely across the belt, (3) arms swinging over the belt. It will be seen that this combination accomplishes one of the preliminary steps in the general operation of the machine, to wit., the supplying of the cans to be headed. It is, therefore, a sub-combination; but is a most material and substantial part of the general operation of the machine. It is very frequently the case that the ultimate result accomplished by a pioneer machine is made up of several independent and successive steps or results performed by independent mechanisms, and these are known in patent law as sub-combinations. This claim, therefore, is one of the features which go to make up the pioneer machine. In view of the state of the art the combination is of a pioneer character. Prior to Jensen there was no machine known for successfully capping filled cans. Con-

sequently, there was no occasion or necessity for a combination of the kind called for by this claim for supplying filled cans to a machine to be capped. Nor have the appellants made any effort to anticipate this claim, and it stands, according to the proofs, as a claim for a pioneer invention.

It cannot be denied that this record shows conclusively that Jensen was the first in the art to automatically cap filled cans. Prior to the date of his invention these cans had been capped by hand and by hand alone. He was, beyond all question, the first in the art to use an automatic machine for capping filled cans, and according to all the authorities, he must be considered a pioneer inventor.

The only part of the claim against which objection is urged by our adversaries is that portion which specifies "a stop E." It is contended by them that this language is specific and defines a specific invention. They freely admit the broad and pioneer character of the invention *actually made* by Jensen, but insist that the language of the claim, as a mere matter of language, is not sufficiently comprehensive to cover that broad invention, and consequently, the claim must be limited in scope to a narrow invention. It is our contention, however, that this claim is drawn in strict compliance with the statute, and being so drawn, *perforce* it covers the

actual invention made, which we have already shown was broad and generic. In other words, it is our contention that the device referred to in the claim as "a stop" is not limited to that form of stop specified by the letter E, but includes and covers any and all forms of stopping devices used in this particular connection in accomplishing this particular purpose. The stop E is shown in the patent as a rigid stationary bar extending transversely across the belt, which acts to stop the forward motion of the cans by operating as an obstruction in their pathway, and thereby enabling the cans to change their direction from a longitudinal travel and be carried transversely into the capping mechanism. Another form of device which performs this function, whether it be called a "stop," or by any other name, would be a mechanical equivalent of the stop E, and consequently, within the scope of the claim.

To put it in another form, the mere fact that this portion of the claim is specific in language does not prevent it from receiving a broad construction in view of the pioneer character of the invention. Claims for pioneer inventions, though couched in specific language, are entitled to a construction commensurate with the scope of the actual invention unless there be a manifest intention apparent on the face of the patent to limit

the claim to its specific form and to dedicate the broad feature to the public. Indeed, according to the letter of the statute, all claims, whether for broad or narrow inventions, should be couched in specific terms. We are aware that the modern tendency of patent solicitors is to draft claims in generic language, but this is not in accordance with the letter of the law. While we do not go so far as to contend that a claim for a generic invention couched in generic language is bad, we do assert that a claim for a generic invention couched in specific language is good.

A careful analysis of the law on this subject will prove the correctness of our position.

Prior to 1836, it was not necessary for a United States patent to contain any claim at all. The first patent act passed by Congress, that of 1790 (First Statutes at Large, 109), provided that a person who had made an invention and desired to secure a patent therefor, might file a petition with the Secretary of State, Secretary of War, and the Attorney-General, setting forth that he had made an invention and desired to secure a patent therefor; whereupon it became lawful for the said officials, or any two of them, if they deemed the invention sufficiently useful and important, to cause letters patent to be made out therefor, reciting the allegations and

suggestions of the petition, “and describing said invention or discovery clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using and vending to others to be used, the said invention or discovery.”

These letters patent were then delivered to the Attorney-General of the United States, whose duty it was to examine the same and see if they were in conformity with the act, and they were then presented to the President, who caused the seal of the United States to be affixed thereto.

The act further provided that the patentee, at the time that the patent was granted to him, should deliver to the Secretary of State “a specification in writing, containing a description, accompanied with drafts or models and explanations of models (if the nature of the invention or discovery will admit of a model) of the thing or things by him invented or discovered and described as aforesaid in the said patent, which specification shall be so particular, and said model so exact, as not only to distinguish the invention or discovery from other things before known and used, but

“ also to enable a workman or other person skilled in
“ the art of manufacture whereof it is a branch, or
“ wherewith it may be nearest connected, to make, con-
“ struct, or use the same, to the end that the public may
“ have the full benefit thereof after the expiration of
“ the patent term.”

No technical “ claim ” was required, but merely a definite description of the invention.

The foregoing act was repealed on February 21, 1793, and a new patent act, known as the patent act of 1793, enacted in its stead. (First Statutes at Large, 318.) This second patent act provided that the petition should be presented by the inventor to the Secretary of State, praying that a patent be issued for the invention, and that the Secretary of State should thereupon cause letters patent to be made out reciting the allegations and suggestions of the said petition, and “giving
“ a short description of the said invention or discovery.” These letters patent were then delivered to the Attorney-General as before, and the letters patent were then sealed and delivered. The act further provided that before the inventor could receive his patent, he should make oath that he verily believed himself to be the true inventor, and “shall deliver a written description
“ of his invention and the manner of using or process of
“ compounding the same, in such full, clear, and exact

“ terms as to distinguish the same from all other things
 “ before known, and to enable any person skilled in the
 “ art or science of which it is a branch or with which
 “ it is most nearly connected, to make, compound, and
 “ use the same. And in case of a machine, he shall fully
 “ explain the principle and the several modes in which
 “ he has contemplated the application of the principle
 “ or character by which it may be distinguished from
 “ other inventions; and he shall accompany the whole
 “ with drawings and written references, where the na-
 “ ture of the case admits of drawings, or with specimens
 “ of the ingredients and of the composition of matter
 “ sufficient in quantity for the purpose of experiment,
 “ where the invention is a composition matter, which
 “ description, signed by himself and attested by two
 “ witnesses, he shall file in the office of the Secretary of
 “ State.”

Neither did this act make any provision for a techni-
 cal “claim,” but merely for a written description. In-
 termediately between this act and that of 1836, various
 and sundry amendments were enacted, but none of them
 referred to the subject matter under consideration, and
 therefore need not be considered.

In 1836 Congress passed the patent act which is the
 foundation of our present patent system and a radical

departure from anything which had preceded it. By that act, the Patent Office was established, and the elaborate system of business, substantially as at present conducted by that office, was inaugurated. The manner of securing patents ordained by that act was by the filing of a petition and specification with the commissioner of patents, and an examination and allowance by the Patent Office, and the issuance of a patent therefor. Among other things, it was provided that before an applicant could receive a patent "he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it pertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine he shall fully explain the principle and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; *and shall particularly specify and point out the part, improvement, or combinations which he claims as his own invention or discovery.*"

The last clause, put in italics by us, was a new fea-

ture, and is the provision requiring the applicant to make a technical "claim." Ever since then, all patents are required to have a claim.

The act of 1836, after being amended from time to time, finally culminated in the consolidated patent act of 1870, and this was substantially embodied in the revised statutes, which constitute the present law of the land. By section 4888 of said revised statute it is provided as follows:

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor in writing to the commissioner of patents, and shall file in the Patent office a written description of the same and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in the case of a machine he shall explain the principle thereof and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; *and he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery.*"

The last clause, put in italics, is the same as the corresponding clause of the act of 1836, and is the one which

provides for a "claim." Note carefully the language thereof—he shall *particularly point out and distinctly claim* the part, improvement or combination which he claims as his invention or discovery. This language is not meaningless. It conveys a definite and exact thought. After the patentee has, in his specification, fully described his invention, he must then *particularly and distinctly* claim that part of it for which he desires protection. An invention (we are now referring to machines) must be embodied in concrete form. The drawings must show it in such form, and the specification must so describe it. It must likewise be shown and described only in one form, which, according to the act, must be "the best mode in which he has contemplated applying that principle." After this is done, the law requires nothing more than that the applicant shall *particularly and distinctly* point out the part or parts of that described machine which he claims as his invention. If it be a particular lever, cam, screw, or clutch, he must *particularly and distinctly* claim such lever, cam, screw, or clutch, and in so doing he must call it by its appropriate and specific name. When he does that, he has "claimed" his invention strictly according to the statute. The law does not assume that he is a rhetorician, or skilled in dialectics, nor require

that he shall adopt broad and generic language in order to get full protection. It merely requires that he shall claim the thing which he has invented, and in so claiming may call it and designate it by its own particular name. This is true, whether the invention be broad or narrow, pioneer or improvement, because the statute has made no distinction in claiming different kinds of invention. They must all be claimed in one and the same manner.

We are certain, therefore, that according to the statute it is sufficient for a patentee to claim his invention *in the specific forms shown by the drawings and specification*, whether that invention be a broad or narrow one, and that there is no provision of the law for framing the so-called "generic" claims of modern days.

When it comes to the matter of construing these claims, then a different question arises. The mere fact that the claim is drawn to the specific form shown does not necessitate a narrow construction, because that is the form of claim, and the only form, provided for by the statute, and whether or not the claim shall be limited to that specific form, or extended to cover other forms, depends solely and entirely upon the scope of the actual invention made. If the invention be a narrow one, then the claim will be limited to the specific form

shown and claimed; if it be a broad, pioneer invention, then the claim will not be so limited, although couched in specific language, but will be extended to other forms in which the invention may be embodied. In every case, therefore, we must go to the state of the art and ascertain what is the actual scope of the invention. That is the pivot on which every other question turns in a patent case. As stated above, we do not go so far as to contend that the modern generic claims are absolutely void, because that is not necessary to the argument, but what we do claim is that the statute authorizes—in fact, commands—that all claims must be drawn in specific terms, and, consequently, a claim for a pioneer invention, drawn in specific terms, will and must receive just as broad a construction as though framed in the broadest and most generic terms.

While this particular question has never been raised in the manner in which it is now put, so far as we are aware, still there is abundant authority to be found in the books for our contention.

Winans vs. Denmead, 15 How., 330, is an apt illustration of the point under discussion. The case is so familiar to all that it would be a waste of time to refer to it in detail. The claim of the patent read as follows:

“ Making the body of a car for the transportation of

“ coal, etc., *in the form of a frustum of a cone*, substantially as herein described, whereby the force exerted by the weight below presses equally in all directions and does not tend to change the form thereof, so that every part resists its equal proportions, and by which also the lower part is so reduced as to pass down within the direct frame and beneath the axle to lower the center of gravity of the load without diminishing the capacity of the car, as described.”

Eliminating the descriptive part, it will be seen that the claim is, in substance, for a coal-car made *in the form of a frustum of a cone*. The language is severely specific, and was drawn to the exact form shown in the specification and drawings. The illustration was a coal-car made in the form of a frustum of a cone. The description of the invention was the same. The claim was likewise the same, thus placing the patentee directly within the statute, which orders him to *particularly and distinctly* point out the part of the device which he claims as his invention. There could not be conceived a clearer case for the illustration of our position.

The question for the court to determine was the proper construction of this claim. Should it be limited to the form of a frustum of a cone, or could it lawfully be extended to cover other forms, for instance, the frustum of a pyramid? The court held that the solution of the question depended upon the scope of the actual

invention. If the invention was generic, the claim would receive a generic construction. If specific, then it would receive a specific construction and be limited to the conical form. The court held that the invention was generic, gave it a broad construction, and adjudged that the defendant's car, which was made in the form of the frustum of a pyramid, was an infringement. In delivering the decision of the court, Mr. Justice Curtis used the following language, which has become classic in the history of patent cases:

“ It is generally true, when a patentee describes a machine and then claims it *as described*, that he is understood to intend to claim, and does by law actually cover, not only the precise form he has described, but all other forms which embody his invention, it being a familiar rule that to copy the principle or mode of operation described is an infringement, although such copy should be totally unlike the original in form or proportion. * * * Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. The exclusive right to the thing patented is not secured if the public are at liberty to make substantial copies of it, varying its form or proportions. And, therefore, the patentee, having described his invention, and shown its principles, and claimed it *in that form*

“ *which most perfectly embodies it*, is, in contemplation of law, deemed to claim every form, in which his invention may be copied, unless he manifests an intention to disclaim some of those forms.”

In other words, this court construed the claim as if it had read: “ Making the body of a car for the transportation of coal, etc., *in a downwardly tapering form,*” etc., etc.

This case was afterwards followed and approved in:

Western Elec. Co. vs. La Rue, 139 U. S., 606.

Hoyt vs. Horne, 145 U. S., 309.

Eddy vs. Dennis, 95 Id., 569.

Frost vs. Silverman, 62 Fed. R., 465.

Hoe vs. Scott, 65 Id., 609.

McCormick vs. Altman, 69 Id., 394.

Heap vs. Greene, 91 Id., 794.

Norton vs. Jensen, 49 Id., 866.

Long vs. Pape, 75 Id., 838.

Independent E. L. Co. vs. Jeffrey, 76 Id., 991.

Metalic Ex. Co. vs. Brown, 104 Id., 353.

Reece vs. Globe Mch. Co., 61 Id., 958.

Devlin vs. Paynter, 64 Id., 398,

and many others.

It will thus be seen that the case of *Winans vs. Denmead* has, for the last half century, been consistently

followed by the federal courts, both appellate and *nisi prius*, and never once doubted. It is to-day the law of the land, and under its authority Jensen was fully justified in framing his claim 1 in the form in which it appears in his patent.

One of the most eminent judges who ever decided patent cases was the late Mr. Justice Bradley. He is often referred to as a "strict constructionist" in the interpretation of patent claims; yet no one could be more liberal than he, where he was satisfied that the patentee had made a meritorious invention but had been unfortunate in the choice of terms in his claims, and that the defendant was relying upon a mere verbal distinction to save himself from the penalty of infringement. A notable instance of this is seen in the case of *Ives vs. Hamilton*, 92 U. S., 426. The invention related to a method for hanging a saw in a saw-mill, and was one of great value. The claim was couched in the following awkward phraseology:

"Giving to the saw in its downward movement a rocking or rolling motion by means of the combination of the cross-head working in *curved* guides at the *upper* end of the saw, the lower end of which is attached to a cross-head working in *straight* guides and pivoted to the pitman *below* the saw, with the crank-pin substantially as described."

This claim described the cross-head as working in *curved* guides, at the *upper* end of the saw, and the *lower* end of the saw attached to a cross-head working in *straight* guides and pivoted to the pitman *below* the saw. The defendant was able to evade the letter of the claim by discarding the *curved* guides for the upper cross-head and using instead thereof *angular* guides, and by pivoting the lower end of the saw to the pitman *below*, instead of *above*, the cross-head. In the court below the case was tried by a jury, resulting in a verdict for the plaintiff, and on motion for new trial (6 Fish., 244) Judge Longyear sustained the verdict, and rendered a most able opinion in support of the patent. These views were concurred in by Mr. Justice Bradley, who affirmed the judgment and gave a sufficiently broad construction to the patent to include the defendant's machine. The claim had been drawn to the precise mechanism shown in the patent. The patentee had *particularly* pointed out and *distinctly* claimed the part of the machine which was his invention, as required by law, and it being a broad invention, the claim was held broad enough to cover the variations from that form which accomplished the same result. Had the claim been worded in generic terms, the defendant doubtless would not have contested the point; but, as it

was worded in specific terms, he urged that it must be limited to the specific form. But the court held otherwise. This case is a direct authority for our proposition, that, where the invention is a broad one, it is sufficient to claim it in the form shown in the patent, and the claim will be construed to cover and include all other forms which accomplish the same result in substantially the same manner.

The case of *Clough vs. Barker*, 106 U. S., 166, is another instance in point. The invention was an improvement in gas-burners, and the second claim of the patent read thus:

“ In combination with the bat-wing burner, perforated at the base and surrounding tube, the tubular valve for regulating the supply of external gas to the burner, substantially as described.”

This claim was drawn to the precise structure shown, *particularly and distinctly*, as the statute requires. It appeared that in no prior structure had a valve arrangement been applied to regulate the flow of gas in such a combination, and, consequently, the claim was entitled to a broad and liberal interpretation. The defendant had varied the form of construction, but the court held that the claim must be given a sufficiently broad construction to include the defendant's burner.

The decision, rendered by Mr. Justice Blatchford, used the following language:

“Although in the Clough structure the burner and
 “surrounding tube revolve together in adjusting their
 “position in reference to that of the tubular valve, so
 “as to let in or turn off the supply of gas through the
 “perforations, and although in the Clough structure
 “the flame revolves by the revolution of the burner,
 “and although in the defendant’s burners the revolu-
 “tion of the surrounding tube regulated the supply of
 “gas through such perforations, and neither the burn-
 “er nor the flame revolved, the defendant’s valve ar-
 “rangement must be held to have been an equivalent
 “for that of Clough to the full extent to which that of
 “Clough goes, involving, perhaps, improvements, but
 “still tributary or subject to the patent of Clough. It
 “is true that that patent describes the tubular valve as
 “being inside of the burner tube. But Clough was the
 “first person who applied a valve regulation of any
 “kind to the combination to which he applied it, and
 “the first person who made such combination, and he
 “is entitled, under decisions heretofore made by this
 “court, to hold as infringements all valve regulations,
 “applied to such a combination, which perform the
 “same office in substantially the same way as, and were
 “known equivalents for, his form of valve regulation.”

Another apt case is that of *Western Electric Co. vs. La Rue*, 139 U. S., 601, where the opinion was rendered by Mr. Justice Brown. The invention was stated

in the specification to relate to "telegraph keys," and the claim involved read as follows:

"The combination in a *telegraph key* of a lever, fulcrumed upon the torsional spring, with the adjusting screws 'HH' for regulating the amplitude of the lever movement and the retractile resistance of the torsional spring, substantially as described."

It will be observed that the claim distinctly refers to a "telegraph key," which is an instrument used for sending messages, not for receiving them. The defendant had used the same combination in a "telegraph sounder," which is an instrument used for receiving the message at the opposite end of the line. The question was whether this claim should be limited by the exact language used, or whether it should be given a construction broad enough to include other instruments than a telegraph key. This court held that, inasmuch as the patentee was the first in the art to apply the principle of a torsional spring to telegraph instruments of any kind, his claim should be given such construction as would include the use of the spring in all such instruments, whether they be keys for the transmission of messages or sounders for the receipt of messages. The patentee had *particularly* and *distinctly* claimed his invention in the form shown in his patent, but as it was of a pioneer character, the claim in that form was held

to be sufficient to cover other forms. In deciding the case, Mr. Justice Brown used the following pertinent language, at page 606:

“ Against this analogous use of his combination, the
“ patentee is as much entitled to protection as if the
“ word ‘sounder’ had been expressly inserted in his
“ claim. Since the case of *Winans vs. Denmead*, 15
“ How., 330, it has been the settled doctrine of this
“ court, as expressed in the opinion of Mr. Justice Cur-
“ tis, p. 343, that the patentee, having described his in-
“ vention and shown its principle and claimed it in that
“ form which most perfectly embodies it, is in contem-
“ plation of law, deemed to claim every form in which
“ his invention may be copied, unless he manifests an
“ intention to disclaim some of these forms.”

The next case in point, also decided by Mr. Justice Brown, is *Hoyt vs. Horne*, 145 U. S., 302. The invention related to a rag-engine for making paper, and the claim read as follows:

“ The improvement in beating rags to pulp in a rag-
“ engine, having a beater-roll and bed-plate knives, con-
“ sisting in circulating the fibrous material and liquids
“ in vertical planes, drawing the same between the
“ knives at the bottom of the vat, carrying it around
“ and over the roll, and delivering it into the upper sec-
“ tion of the vat, substantially as described.”

The circulation of fibrous material and liquid in vertical planes resulted from passing that material alter-

nately under and over a horizontal partition; whereas in the prior art that material had been circulated horizontally around a vertical partition. The defendant's apparatus was provided with a horizontal partition at one end and a vertical partition at the other, and therefore, the pulp in it did not circulate in vertical planes, as called for by the plaintiff's patent. In rendering the decision, Mr. Justice Brown said (p. 308) :

“ It is insisted by the defendant, in this connection, that there is no infringement of the first claim of the Hoyt patent, since the pulp is not circulated in vertical planes, nor is it delivered by the beater-roll into the upper section of the vat as specified in that claim. Literally, it is not. A technical reading of the specification undoubtedly requires that the mid-feather should run horizontally instead of vertically; but the object of this was that the pulp should be received and delivered by the beater-roll along its entire length, viz: across the entire width of the tub, and this is accomplished in the same way in both devices. * * * The substitution of a vertical for a horizontal mid-feather at the inoperative end of the tub is merely the use of an old and well-known mechanical equivalent, and obviously intended to evade the wording of the claim of the Hoyt patent. (*Winans vs. Denmead*, 15 How., 330.) Indeed, the ingenuity displayed in this evasion is only equalled by the ingenuity with which it is concealed in the specification of the defendant's patent.”

In the case of *Sessions vs. Romadka*, 145 U. S., 29, where the opinion was rendered by Mr. Justice Brown, the invention related to a trunk-fastener, and the claim was couched in the following narrow specific terms:

“The spring catches, I, constructed and applied to the front of the body, as described, in combination with the tongues or hasps J on the top, when arranged to operate as set forth.”

It would scarcely be possible to conceive of language more narrow in scope than that of this claim. It even goes to the extent of designating the elements by specific letters. It also does another, and a most unusual thing, that is, in the body of the claim, after specifying one of the elements by letter, it adds the words “as described”; and at the end of the claim it adds the following unusual form of limitation, viz: “When arranged to operate as set forth.”

If there ever was a case on record where the language of the claim was specific, this is the case. The patentee had, with the most servile fidelity, adhered to section 4888 of the revised statute in *particularly* and *distinctly* pointing out the part of the machine which he claimed. The defendant, of course, had used a different form of construction, and thereby had avoided the language of the claim. But it appeared from the evidence that

the invention was pioneer in character, and this court, without any hesitation whatever, held that it was entitled to a broad construction, and was not limited to the specific devices called for by the language of the claim. Said Mr. Justice Brown, in rendering the decision of the court:

“In view of the fact that Taylor was a pioneer in the art of making a metallic trunk fastener, and invented a principle which has gone into almost universal use in this country, we think he is entitled to a liberal construction of his claim, and that the Romadka device, containing as it does all the elements of the combination, should be held to be an infringement, though there are superficial dissimilarities in their construction.”

Compare this case with *Sutter vs. Robinson*, 119 U. S., 531; *Keystone Bridge Co. vs. Phoenix Iron Co.*, 95 U. S., 274, and *Hendy vs. Iron Works*, 127 U. S., 370, where the elements of the claims were referred to by reference letters and the claims construed narrowly and limited to the specific form shown, not because the language was narrow, but because the invention was narrow.

It is shown by the evidence that the principle embodied in the machine of each of said cases was old and that the invention was a narrow one. Consequently, this court limited the claim in each case to the pre-

cise construction shown, and held that an apparatus of a different construction, though embodying the same principle, was no infringement.

The point we are discussing is very clearly illustrated by the decision of this court in the case of *Deering vs. Winona Harvester Works*, 155 U. S., 286, involving the patent of one Olin relating to a harvester.

The claim was drawn to the specific construction shown, as the statute requires, and the question at issue was what construction should be placed upon the claim. It appearing that the invention itself was a narrow one and not of a pioneer character, a narrow construction was placed on the same, which was limited to the specific mechanism shown. In rendering the decision of the court Mr. Justice Brown, said:

“ If Olin had been the first to devise the contrivance
“ of this description for adjusting the flow of grain
“ upon the main elevator, it is possible that under the
“ cases of *Ives vs. Hamilton*, 92 U. S., 426, and *Hoyt*
“ vs. *Horne*, 144 U. S., 302, a construction broad
“ enough to include defendant’s device might have been
“ sustained. But in view not only of the prior devices,
“ but of the fact that his invention was of doubtful util-
“ ity and never went into practical use, the construc-
“ tion claimed would operate rather to the discouragement
“ than the promotion of inventive talent.”

In other words, the mere wording of a claim is not of any great moment in determining its construction; but the scope of the invention itself is the important feature. If the invention is a broad one, the court will give the claim a broad construction, notwithstanding the fact that the claim is framed in specific language; but if the invention is a narrow one, then the court will place upon the claim a narrow construction and limit it to its exact language.

As bearing on the point we may refer also to the case of *Westinghouse vs. Boyden Power Brake Co.*, 170 U. S., 568, where it is said:

“ We have repeatedly held that a charge of infringement is sometimes made out though the letter of the claim be avoided. (*Machine Co. vs. Murphy*, 97 U. S., 120; *Ives vs. Hamilton*, 92 U. S., 426; *Morey vs. Lockwood*, 8 Wall., 230; *Elizabeth vs. Pavement Co.*, 97 U. S., 126; *Sessions vs. Romadka*, 145 U. S., 29; *Hoyt vs. Horne*, 145 U. S., 302.”

A most instructive case, from a *nisi prius* court, however, is that of *Murphy vs. Eastman*, 5 Fish., 306, decided by Judge Shepley a great many years ago. The invention related to a brush-head, and was described in a specific geometric form and claimed in that form. The defendant had used a different geometric form and thereby evaded the strict wording of the claim; but

the invention being one of a pioneer character, infringement was found. In deciding the case Judge Shepley used the following language:

“ The patentee does not, as is sometimes done, claim
“ in terms the thing patented, however its form and pro-
“ portions may be varied; but the law so interprets the
“ claim without the addition of these words. In con-
“ templation of law after he has fully described and
“ claimed it in a form which perfectly embodies it, un-
“ less he disclaims other forms, he is deemed to claim
“ every form in which his invention may be copied.”

Another case of like import is that of *Metallic Ex- traction Co. vs. Brown*, 104 Fed. Rep., 346, which was decided by the circuit court of appeals for the eight circuit. The invention related to an ore-roasting furnace, and the claim read as follows:

“ In an ore-roasting furnace having means for stir-
“ ring and advancing the ore, a supplemental chamber
“ *at the side of the* main roasting chamber and cut off
“ from said main chamber by a wall or partition, and
“ carriers in said supplemental chambers connected
“ with the stirrers, but removed from the direct action
“ of the heat, fumes and dust, substantially as herein
“ described.”

It will be observed that the language of this claim required that the supplemental chamber should be located *at the side* of the main roasting chamber. It was

so shown in the drawings and described in the specification without any statement or intimation that it could be located at any other place. The defendant had located his supplemental chamber *under* the main chamber instead of *at the side*, and the question was whether the claim must be limited by the language used to a supplemental chamber, placed at the side of the main chamber, or whether it could be construed to cover a chamber placed underneath, instead of at the side of the main chamber. The court found that the invention was of a pioneer character, and, consequently, held that the claim was not limited to a supplemental chamber placed at the side of the main chamber, but was sufficient to cover one placed underneath. The judgment went for the patentee. If the court had found that the invention was not of a pioneer character, then the claim would have been limited to the language used and no infringement would have been adjudged.

Another instructive case is that of *McCormick Harvesting Machine Co. vs. Aultman*, 69 Fed. Rep., 371, decided by the circuit court of appeals for the sixth circuit, wherein the opinion was rendered by Judge Taft. The invention was for a grain binder, and the claims were most narrow and specific in terms, reading as follows:

“ 3. The reciprocating segments C₄, having the
 “ feed teeth C₆, in combination with the guides D, as
 “ and for the purpose specified.

“ 10. The flexible strap g, arranged in receptacles
 “ G, to operate the trip lever H, in the manner substan-
 “ tially as and for the purposes described.

“ 11. The combination of the binding strap and
 “ cord g, with the bundle receptacle G, and tooth-feed-
 “ ing segments C₄, substantially as and for the purpose
 “ described.”

It was found by the court that these claims covered inventions of a pioneer character, and, consequently, they were given a broad construction, notwithstanding their specific language.

In deciding the case Judge Taft used the following language:

“ It is further pressed upon the court that the mere
 “ fact that the claims of the Gorham patent are ex-
 “ pressed by reference to the lettered parts of the ma-
 “ chine, as shown in the drawings, must lead to a literal
 “ and formal construction of the claims, and limit their
 “ scope exactly to the form of the device used and sug-
 “ gested by Gorham. * * * Whether he specific-
 “ ally claims in his patent the benefit of equivalents or
 “ not, the law allows them to him according to the
 “ nature of his patent. If it is a mere improvement on
 “ a successful machine, a mere tributary invention, or
 “ a device the novelty of which is confined by the past
 “ art to the particular form shown, the range of equiva-

“ lents is narrowly restricted. If it is a pioneer patent
 “ with a new result, the range is very wide, and is not
 “ restricted by the failure of the patentee to describe and
 “ claim combinations of equivalents. Nothing will re-
 “ strict a pioneer patentee’s rights in this regard save
 “ the use of language in his specifications and claims
 “ which permit no other reasonable construction than
 “ one attributing to the patentee *a positive intention* to
 “ limit the scope of his invention in some particular to
 “ the exact form of the device he showed, and a conse-
 “ quent willingness to abandon to the public any other
 “ form, should it be adopted and prove useful.”

The syllabus of the case on this point is as follows :

“ The mere use of reference letters in the claims of
 “ a combination patent does not of itself, where the in-
 “ vention is really of a primary and pioneer character,
 “ limit the scope of the claims to the exact form shown.
 “ On the contrary, nothing will restrict a pioneer pat-
 “ entee’s rights, save the use of language in his specifica-
 “ tions and claims which permits of no other reasonable
 “ construction than that he positively intended to limit
 “ the scope of his invention to the particular form
 “ shown, thus indicating a willingness to abandon to
 “ the public any other form.”

The question was again examined by that court in the case of *National Hollow Brake Beam Co. vs Interchangeable Brake Beam Co.*, 106 Fed. Rep., 714, where the claim under discussion read as follows :

“ The combination in a brake beam of a hollow beam, “ a strut *end plugs or caps 8, and a truss rod 3*, which “ extends through *the caps 8*, and is provided with nuts, substantially as and for the purposes specified.”

In the opinion rendered by Judge Sanborn it is there said:

“ Finally it is said that the patent is limited to the “ precise geometrical form of end caps shown in the “ specification and drawings, by the fact that the figure “ ‘8’ appears after the words ‘end caps’ in the claim. “ There are cases wherein the form of a device is the “ principle of the invention. There are other cases “ wherein the state of the prior art and the specific terms “ of the specification and drawings leave no doubt of the “ intention of the applicant to restrict his claim to the “ specific form of the device or element he points out. “ In such cases claims of patents are sometimes limited “ to the specific forms of the devices pointed out by “ letters or numbers in the claims or specifications. “ (*Weir vs. Morden*, 125 U. S., 98, 107; *Railroad Co. “ vs. Kearney*, 158 U. S., 461, 469; *Crawford vs. Hey- “ singer*, 123 U. S., 589; *McCormick Harvesting “ Mach. Co. vs. Aultman, Miller & Co.* (C. C.), 58 “ Fed., 773; *Newton vs. Manufacturing Co.*, 119 U. S., “ 373; *Bragg vs. Fitch*, 121 U. S., 478; *Dryfoos vs. “ Wiese*, 124 U. S., 32; *Hendy vs. Iron Works*, 127 U. “ S., 370, 375.) But this is not a case of that character. “ The form of the caps and the specific mechanical de- “ vices by which they should be locked with the brake- “ head and brake beam were immaterial to the principle “ of this invention. Caps of many forms, many obvious

“ mechanical devices for fastening them to the compres-
 “ sion member, the brake-heads and the brake beams,
 “ and preventing these elements from rotating upon
 “ each other, would perform the same function in the
 “ combination of the patentee as those which he pointed
 “ out. The specification, the drawing, and the claim
 “ show that the patentee was not ignorant of this fact,
 “ nor of the law by which this patent must be interpre-
 “ ted. He never claimed the form of his caps as a part
 “ of his invention. He never described in his specifi-
 “ cation or drawing as an essential part of his inven-
 “ tion or of the caps themselves, those peculiarities in
 “ the caps by the omission of which the appellee seeks
 “ to escape infringement.

“ The description is a specification or drawing of de-
 “ tails which are not, and are not claimed as essential
 “ elements of a combination, is the mere pointing out
 “ of the better method of using the invention. (*City*
 “ *of Boston vs. Allen*, 91 Fed., 248, 249, 33 C. C. A.,
 “ 485, 486.) A reference in a claim to a letter or figure
 “ used in the drawing and in the specification to de-
 “ scribe a device or an element of a combination does
 “ not limit the claim to the specific form of that element
 “ there shown, unless that particular form was essential
 “ to, or embodied the principle of, the improvement
 “ claimed. (*Sprinkler Co. vs. Koehler*, 82 Fed., 428,
 “ 431, 27 C. C. A., 200, 203, 54 U. S. App., 267, 272;
 “ *McCormick Harvesting Machine Co. vs. Aultman*,
 “ *Miller & Co.*, 69 Fed., 371, 393, 16 C. C. A., 256, 281,
 “ 37 U. S. App., 299, 343; *Muller vs. Tool Co.*, 77
 “ Fed., 621, 23 C. C. A., 357, 47 U. S. App., 189; *Dele-*
 “ *mater vs. Heath*, 58 Fed., 414, 424, 7 C. C. A., 279,

“ 284, 20 U. S. App., 14, 30; *Reed vs. Chase* (C. C.),
 “ 25 Fed., 94, 100; *Walk. Pat.* (3d ed.), Sec. 117a.)
 “ That interpretation which sustains and vitalizes the
 “ grant should be preferred to that which strikes down
 “ and paralyzes it. (*Reece Button Hole Mach. Co. vs.*
 “ *Globe Button Hole Mach. Co.*, 61 Fed., 958, 962, 10
 “ C. C. A., 194, 198, 21 U. S. App., 244, 363; *Consoli-*
 “ *dated Fastener Co. vs. Columbian Fastener Co.* (C.
 “ C.), 79 Fed., 795, 798; *American Street-Car Adver-*
 “ *tising Co. vs. Newton St. Ry. Co.* (C. C.), 82 Fed.,
 “ 732, 736; *McSherry Mfg. Co. vs. Dowagiac Mfg.*
 “ *Co.*, 41 C. C. A., 627, 101 Fed., 716, 722.) One who
 “ appropriates a new and valuable patented combina-
 “ tion cannot escape infringement by uniting or operat-
 “ ing its elements by means of common mechanical de-
 “ vices which differ from those which are pointed out
 “ for that purpose, but which are not claimed in the
 “ patent. (*Deering vs. Harvester Works*, 155 U. S.,
 “ 286, 302; *City of Boston vs. Allen*, 91 Fed., 248, 249,
 “ 33 C. C. A., 485, 486; *Schroeder vs. Brammer* (C.
 “ C.), 98 Fed., 880.)”

And the syllabus of the case on this point is as fol-
 lows:

“A reference in a claim of a patent to a letter or fig-
 “ ure used in the drawing and in the specification to
 “ describe a device or an element of a combination does
 “ not limit the claim to the specific form of that device
 “ or element there shown, unless the particular form
 “ was essential to, or embodied the principle of, the im-
 “ provement claimed.”

Other cases deciding this point are:

Sprinkler Co. vs. Koehler, 82 Fed. R., 428.

Muller vs. Tool Co., 77 Id., 621

Delemater vs. Heath, 58 Id., 414.

Reed vs. Chase, 25 Id., 94.

In view of the rule of law announced in the cases cited, it follows that the stop called for by Jensen's claim 1 is not necessarily limited to "the stop E"—that is to say, to a stop consisting of a stationary bar, but includes and covers any and all forms of stop which perform the same function in the same manner.

The Jensen claim 1 must be construed as though it read as follows:

"An endless traveling carrying-belt, *a device* extending across it to change the direction of the cans, and arms swinging over the belt, whereby the delivery of the cans from the belt to the feeder is rendered exact, substantially as herein described."

Such is the real scope of the invention covered by the claim, and if it had been so worded, even the technical counsel for our adversaries could have urged nothing against it.

That this claim is entitled to be construed as though the word "device" were substituted for the words "a stop E" is settled by the cases cited above, and we con-

tend that the claim must be construed to cover a combination of the belt and swinging arms with any and all forms of devices which operate to stop the forward, or longitudinal, movement of the cans and to change their direction of movement so that they can be conveyed to the capping mechanism.

The learned judge of the lower court construed this claim as calling for "a rigidly fixed stop bar." In other words, he held that the element specified in the claim as "a stop E," is limited to the precise form of stop device shown in the Jensen patent, thereby making the claim cover a *narrow*, instead of a *broad*, invention, a *specific*, instead of a *generic* one. In the opinion rendered he did not elaborate the point nor give the reasons which formed the basis for this conclusion; but merely stated in a general way that one of the elements of the claim was "a rigidly fixed stop bar."

In this conclusion we respectfully submit that there is error. In construing the claim the initial inquiry should be to ascertain the scope of the *actual invention* made, and that fact is determined by the state of the art. If the actual invention is a generic one, the claim will receive a broad construction; if only a specific one, then it will receive a narrow construction. The mere fact that this disputed element is designated by a letter

does not necessarily compel a narrow construction. The authorities which we have cited on this point are too conclusive to admit of question, and the statute prescribing the form of claim is too definite to be disputed. That statute requires that the patentee "shall *particularly* point out and *distinctly* claim the part, improvement, or combination on which he claims as his invention or discovery." Jensen followed this statute and did *particularly* point out and *distinctly* claim the part of the machine which was his invention, so far as this particular claim is concerned. Having done all that the law requires in this regard and claimed the invention in the form shown, he is entitled to a broad construction of this claim and is not limited to the specific form shown, provided his invention be of a generic character.

The supreme court said in *Winans vs. Denmead*, heretofore referred to:

"It is generally true, when a patentee describes a machine and then claims it *as described*, that he is understood to intend to claim and does by law actually cover not only the precise form he has described, *but all other forms which embody his invention.*"

In that case the patentee had described his invention as being "in the form of the frustum of a cone," and he had claimed it in that specific language.

Yet the supreme court held that the claim must be considered as covering not only that precise form, but any and all other forms embodying the same idea, and accordingly held that the claim was infringed by a device made in the form of the frustum of a pyramid.

And in *Murphy vs. Eastman*, heretofore cited, Judge Shepley says:

“The patentee does not claim in terms the thing patented however its form and portion may be varied, but the law so interprets the claim without the addition of these words. In contemplation of law, after he has fully described and claimed it in a form which perfectly embodies it, unless he disclaims other forms, he is deemed to claim *every form* in which his invention may be copied.”

And we again beg leave to remind the court that the statute Sec. 4888 of the revised statutes, not only provides that the patentee shall particularly point out and distinctly claim the thing invented, but it further provides that he must show his invention in *one form only*, which must be the form he considers to be the best. In other words, he is not allowed to show and describe a multiplicity of forms in which his invention may be embodied, *but only one form*, and after he has done that and claimed it *in that form*, the law considers his patent

as covering other forms, if the invention be of a pioneer character.

We respectfully submit that Jensen's claim 1 is drawn directly in accordance with this law as laid down in the revised statutes and interpreted by the cases cited.

Take, for instance the case of *Sessions vs. Romadka*, 145 U. S., 29, where the claim was for a combination in which one of the elements was specified as "the spring "catches I" and another as "the tongues or hasps, J." The invention there was of a pioneer character, and the court held that the claim was entitled to a broad construction, notwithstanding the specific form of language used in the claim and the designation of some of the elements by letters.

The same ruling was made by the circuit court of appeals for the sixth circuit, through Judge Taft in the case of *McCormack vs. Aultman*, 69 Fed. Rep., 371, and in the case of *National Hollow Brake-Beam Co. vs. Interchangeable Brake-Beam Co.*, 106 Fed. Rep., 714, already quoted herein at length.

In a word, there can be no doubt as to the law on this subject, which is simply this: *Where elements of a claim are specified by letters or numbers, the claim is not necessarily limited to that specific form, and will not be so limited, unless the actual invention made is a*

narrow one. If in such case the actual invention is generic, then the claim will receive a broad construction, notwithstanding the specific language used.

Permit us now to inquire briefly as to the scope of the invention made, so far as claim 1 is concerned. In referring to the stop E, the specification of the patent says:

“Stops or bars E extend across the tables at right angles with the belt A, and their ends extend above the belt, so that when the cans reach these bars, they are prevented from moving any farther with the belt. They are then taken by the feeder or carrier F, and transferred by successive stages across the table, the first stage delivering them upon the rising and falling plunger, etc.”

Thus it will be seen that the function of the stop E is quite plain. The cans are being carried along longitudinally with the moving belt; when they reach the place where the stop E is located, it is necessary to prevent any further forward motion and to remove them from the belt transversely and carry them to the capping mechanism. Or, to put it in the words of the claim, “to change the direction of the cans.” Their initial direction is longitudinal; their successive direction is ~~transverse~~ to the belt. Now, it is apparent that any device which stops the forward motion and pro-

duces the transverse, thereby changing the direction of the cans, is the thing attempted to be covered by that claim. In the eyes of the law, it is immaterial whether that thing be a rigidly fixed stop bar or a rotating wheel. The name by which it is called is immaterial. It is the function of the thing itself about which we are concerned. Jensen wanted some device, or thing, or mechanism, whatever might be its form or whatever might be its name, which would change the direction of those moving cans, and that is the scope of his invention, so far as this element is concerned, thus placing the case on all fours with *Winans vs. Denmead*.

Again, the specification says: "Stops or bars E extend across the table," etc. Nothing is said about these stops being *rigidly fixed*, nor is there any statement in the specification anywhere that they shall be *rigidly fixed*, and we respectfully submit that the learned judge of the lower court was in error when he said in his decision that this device must be "a rigidly fixed stop bar." His conclusion does not follow from the language of the specification, and we have seen, as matter of fact, that it is not necessary for the device to be rigidly fixed in order to accomplish the end sought.

Again, in referring to this element, Jensen's specification says that these stops or bars must be arranged

“so that when the cans reach these bars they are prevented from moving any farther with the belt.” There is the gist of the whole matter. That sentence describes the function of these stops, and it is utterly immaterial whether it be performed by a device which is rigid or one which is movable.

The language used by the supreme court in *Machine Co. vs. Murphy*, 97 U. S., 120, covers this case as with a blanket. It was there said:

“Nor is it safe to give much heed to the fact that the corresponding device in the two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation, or the way the device works, and at the result, as well as the means for which the result is obtained. Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself, so that if the two devices do the same work in substantially the same way and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.”

And, at another place in the same case, it is said by the court:

“In determining the question of infringement the court or jury, as the case may be, are not to judge about similarities or differences by the names of

“ things, but are to look at the machines or their several
“ devices or elements in the light of what they do or
“ what office or function is performed and how they
“ perform it, and to find that one thing is substantially
“ the same as another, if it performs substantially the
“ same function in substantially the same way to obtain
“ the same result.”

We respectfully submit, therefore, in view of the authorities cited, that Jensen's claim 1 is not limited to a combination in which a rigid fixed bar or stop is one of the elements, as found by the lower court, but must be construed as broadly covering any and all devices which will stop the further forward movement of the cans and change their direction. To repeat what we have already said before, Jensen's claim 1 must be construed as though it read as follows:

“An endless traveling belt, *a device* extending across
“ it to change the direction of the cans, and arms swing-
“ ing over the belt whereby the delivery of the cans
“ from the belt to the feeder is rendered exact, substan-
“ tially as herein described.”

If we are correct in this argument, then the lower court erred in regard to claim 1, and all that portion of the decree which denies us relief as to claim 1 must be reversed.

CONSTRUCTION OF CLAIM THREE.

3. *In combination with a transverse belt, the feeder having projecting arms, between which the cans are received from the belt, and the actuating devices by which the motions of the feeder are produced, substantially as herein described.*

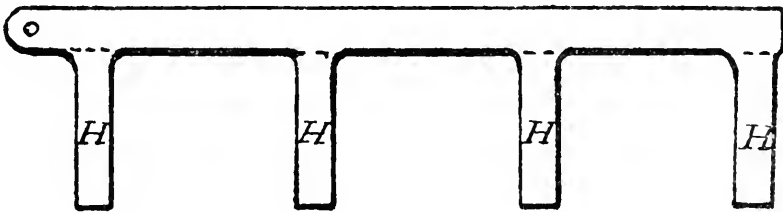
This claim is a sub-combination and covers a broad generic invention. It is intended to cover the operation of supplying unfilled cans and "feeding" or "carrying" them to the capping mechanism. The elements of the combination are (1) belt, (2) feeder, and (3) actuating mechanism. The first element delivers the cans; the second feeds them to the capper, and the third actuates or drives the feeder. The only limitation on any of these elements is the statement that the feeder has "projecting arms between which the cans are received from the belt." It will be noted, however, that no particular form or kind of arms is specified, and, consequently, a feeder which has any kind of devices that grasp the can is within the claim. There is nothing shown in the prior art similar to this mechanism, and the claim, both by its language and by the state of the art, is entitled to a broad construction.

This is one of the claims which was adjudged to be not infringed. In order to reach that result, the

learned judge of the lower court held that the "feeder," specified therein as one of the elements, was limited to the exact form of feeder shown in the patent. In this, we claim error.

The feeder shown in the patent is lettered F. It is in form a rake, having a straight back and four arms projecting at right angles so as to form three stalls or pockets, as shown in the following cut.

Jensen Feeder.



The actuating mechanism is so arranged as to produce a circular sweeping motion of this feeder. When the incoming can reaches the stop, it is caught between the first two arms of the feeder, and by a circular sweeping motion swept from the belt at right angles thereto. The feeder then recedes and leaves the can stationary upon the table until the next sweep of the feeder, when it is received between the second two arms and delivered to the capping mechanism. By the final sweep of the feeder, the can is grasped by the last two arms and conveyed away with the cap on.

The function of this feeder is merely that of a carrier or conveyor of the cans, a means for removing them from the belt. Any other device which would accomplish that result is within the claim. The only limitation is that it must have "projecting arms between " which the cans are received from the belt." It is not intimated in the claim that the feeder is to do anything else than to have arms "between which the cans are " received from the belt," and it is our contention that any kind of feeder having arms *which remove the cans from the belt* is within the claim. In other words, the sole and only function of the feeder called for by this claim is *to remove the cans from the belt*.

It is true that our feeder does something more; because it not only removes the cans from the belt, but it also removes them from the capping mechanism after they are capped. But this latter function is not mentioned in the claim. That feature is not intended to be covered by the claim. The only kind of a feeder intended to be covered by the claim is one which removes the cans from the belt. Consequently, any form of feeder which does that is within the claim.

The learned judge of the lower court was of the opinion that there must be read into the claim the peculiarities of construction and entire mode of operation

shown by the specification and drawings to inhere in the feeder F. This construction, of course, brought into the claim not only the function of removing the cans from the belt, but all the other functions subsequently performed by the feeder, consisting in its step-by-step mode of progression and the ultimate removal of the capped can from the capping mechanism. We insist vigorously that this was error, because the language of the claim does not call for a feeder having such peculiarities, but only for a feeder which has the function of removing the uncapped cans from the belt. That, and that alone, is intended to be covered by this claim. The language supports the contention and the State of the art confirms it. Under these circumstances, are we not entitled to the usual presumptions which obtain in such cases? Certainly, no reason to the contrary was advanced by the trial judge, and we are at a loss to understand how he fell into such an error.

CONSTRUCTION OF CLAIM FIVE.

5. *The inclined chute into which the caps are placed and a stop extending across said chute, so as to prevent the caps from moving downward, in combination with a trigger extending across the path of the cans, as they are moved toward the capping table, said*

trigger being connected with the stop, so that as it is moved backward by the passage of the can, it withdraws the stop to allow a cap to move down the chute, substantially as herein described.

This is a broad and comprehensive claim, covering a pioneer invention of remarkable ingenuity and undoubted merit. The essence of the claim consists in the releasing of the caps by the can itself, so that each can automatically supplies its own cap. Prior to Jensen, this had never been done, but the caps had always been supplied by hand. This claim is the first in the history of the art where the can, by its own motion, automatically releases, from a collection of caps, its own particular cap, ready for the capping operation.

The elements of the claim are: (1) a cap-carrying chute; (2) a stop extending across the chute to regulate the movement of the caps; (3) a trigger in the path of the cans; (4) connecting mechanism between the trigger and the stop, all so combined and arranged that the can pulls the trigger, and thereby the stop is released and a cap moves down the chute towards the capping mechanism, to be applied to the particular can which has released it. When the released cap reaches the bottom of the chute, a forked arm or finger, designated in the patent by the letter "V," and operated by an ingen-

ious mechanism of levers, cams, toggle-joints, etc., not necessary to be described here, reaches forward and rakes the cap into the capping mechanism, and there places it in its proper position immediately above the can to be headed. The operation of this forked arm "V" resembles very much the operation of a human hand, and, indeed the operation of the combination of claim 5, whereby each can releases its own cap, seems almost to partake of human intelligence. It is certainly is one of the most ingenious pieces of mechanism we have ever been called upon to examine, and illustrates and embodies an idea entirely original with Jensen. Nor can there be any question as to its utility. It acts with the precision of clock-work, and as long as the machinery is in good order it is impossible for it to make a mistake. This claim is, beyond all peradventure of a doubt a claim for the broadest and most pioneer of inventions. There is nothing in the prior art resembling it in the remotest degree. It performs a function which in every respect is entirely new, and was original with Jensen. This is admitted by defendants.

Under these circumstances, the claim is entitled to the broadest and most liberal construction ever given to any claim. It is not confined to the form of the particular elements which go to make up the combination, but

covers all other devices which would be mechanical equivalents thereof in the broadest sense of the term.

The lower court construed this claim as we have above indicated it ought to be construed, and decreed infringement thereof. It is our contention that this ruling was correct. Indeed, we do not understand that the appellants seriously contest the matter. Hence, we shall not dwell on it further.

CONSTRUCTION OF CLAIM NINE.

9. *The vertically moving plunger upon which the cans are delivered to the feeder, in combination with the conical guide situated above the cans, and the transversely moving slides upon which the caps are received and held, with a mechanism by which the slides are withdrawn as the can enters the cap, substantially as herein described.*

It is our contention that this claim covers a broad and pioneer invention in the art of heading filled cans, and the lower court upheld us in such contention.

The state of the art in this case is represented by the prior patents of Marsh and Jordan, since they were the only ones put in evidence by the defendants. Neither of those patents shows the combination of Claim 9. And furthermore, as we have already shown, the

Marsh machine was not an automatic one at all, but merely a hand-operated device, while the Jordan machine, as found by this court in the original Jensen case, was and is an impracticable contrivance. In view of this scanty and insufficient showing by the defendants, we are certainly entitled to the usual presumptions which obtain in such cases.

CONSTRUCTION OF CLAIM TEN.

10. *The vertically moving plunger by which the can is raised to receive the cap, and the guides into which the upper end of the can enters, the trasversely moving cap-holding slides, in combination with the second plunger moving vertically above the cap and following it down by gravitation or otherwise, so as to steady the can in its descent after the cap has been applied, substantially as herein described.*

This claim is the same as claim 9, with the addition of the second plunger overhead, whose function is clearly stated in the claim. If claim 9 is entitled to the construction we contend for, it follows that claim 10 is entitled to a similar construction, and it will not be necessary for us to dwell on the subject. The lower court found according to our view, and decreed the infringement of this claim.

CONSTRUCTION OF CLAIM ELEVEN.

11. *The vertically moving plunger upon which the can is received, a carrier for placing the can upon the plunger, and a mechanism by which this plunger is reciprocated vertically in combination with a second plunger which rests upon the top of the cap and steadies it while descending, and a mechanism for raising the second plunger before the arrival of the next cap, substantially as herein described.*

If we are correct in our preceding argument, it follows therefrom that this claim must receive the same broad construction as claims 9 and 10. The elements of the claim are: (1) the vertically moving plunger; (2) a carrier for placing the can on the plunger (3) a mechanism by which the plunger is reciprocated vertically; (4) the second plunger overhead; (5) a mechanism for raising the second plunger before the arrival of the next cap.

The state of the art fails utterly to show any such combination, or anything like it. Beyond all question, it is a novel combination in the art of heading filled cans, or, for that matter, any kind of cans; but certainly, as to the art of heading filled cans, it is novel, because prior thereto there was no automatic machine in existence which would successfully head filled cans. The

Marsh machine was a hand-operated device. The Jordan machine was an impracticable one. Neither of these prior devices shows this combination.

The lower court found that this claim was limited, and, consequently, not infringed; but in view of the fact that the court had already found that claims 9 and 10 were pioneer in character, it is impossible for us to understand the reason for the ruling as to this claim 11. It seems to us that if the ruling of the lower court is correct as to claims 9 and 10, it follows as an irresistible conclusion that the same ruling must be made as to claim 11. The ground on which the lower court found that claim 11 was limited in character is the contention that the element specified therein as "a carrier for placing the cans upon the plunger" is limited to the specific form of carrier shown in the Jensen patent and does not include any other form of carrier. Very little was said in the opinion on this subject, and we quote the same in whole:

"It is unnecessary to discuss the eleventh claim any further than to say that among the devices making the combination of that claim there is included a part which I have heretofore referred to as the second feeder F, which is not reproduced in the defendant's machine, as I have heretofore explained, and there-

“fore the eleventh claim is not infringed by the defendant’s machine.”

We respectfully submit that the learned judge was in error in thus reading into claim 11 the specific form of carrier referred to in the Jensen patent by the letter F. It is true, as we have heretofore shown, that said carrier F, as delineated in the drawings and described in the specification of the Jensen patent, consists of a straight back, with four arms at right angles thereto, forming stalls or pockets, and driven by a mechanism which gives it a circular sweeping movement. But by what right can any one assert that this claim 11 is limited to a carrier of that specific form or character? Certainly, the language of the claim does not support such a contention, for it specifies “a carrier for placing the cans upon the plunger.” That is to say, it calls for *any kind* of carrier, whatever may be its form, whether round, square, or oblong, whether intermittent or continuous, so long as it performs the single function of “placing the can upon the plunger.”

Nor does the state of the prior art support the ruling of the lower court. Prior to Jensen, in the art of heading filled cans by automatic machinery, not only had no device of this kind been ever used, but no device of any kind at all. If this be true, then this claim cannot

be limited to any particular form of carrier. We know of only two lights to be guided by in construing a claim, viz: the language of the claim and the scope of the invention as shown by the prior art. Here, the language does not call for any particular form of carrier. On the contrary, it is broad and unlimited, calling for "a carrier," which certainly means *any* carrier. The prior art likewise shows that the claim must be construed broadly, for it fails to show any analogous device, and does show that Jensen was the first in the art. We feel the utmost confidence in the correctness of our position regarding this claim, and we do not think it necessary to do further than to point out the broad character of the language used in the claim and the absence of any such analogous device in the prior art. We so treated the matter in the lower court and refrained from indulging in any extended argument on the point. Probably we were wrong in this course, and should have taken nothing for granted, remembering the old maxim to "beware of a plain case." We submit that this part of the decree was erroneous and should be reversed.

Having disposed of the construction which we think ought to be given to the claims in controversy, we advance now to the next point in the argument, which will be a construction of the mechanism of the defendant's machine.

DESCRIPTION OF THE DEFENDANTS' MACHINE.

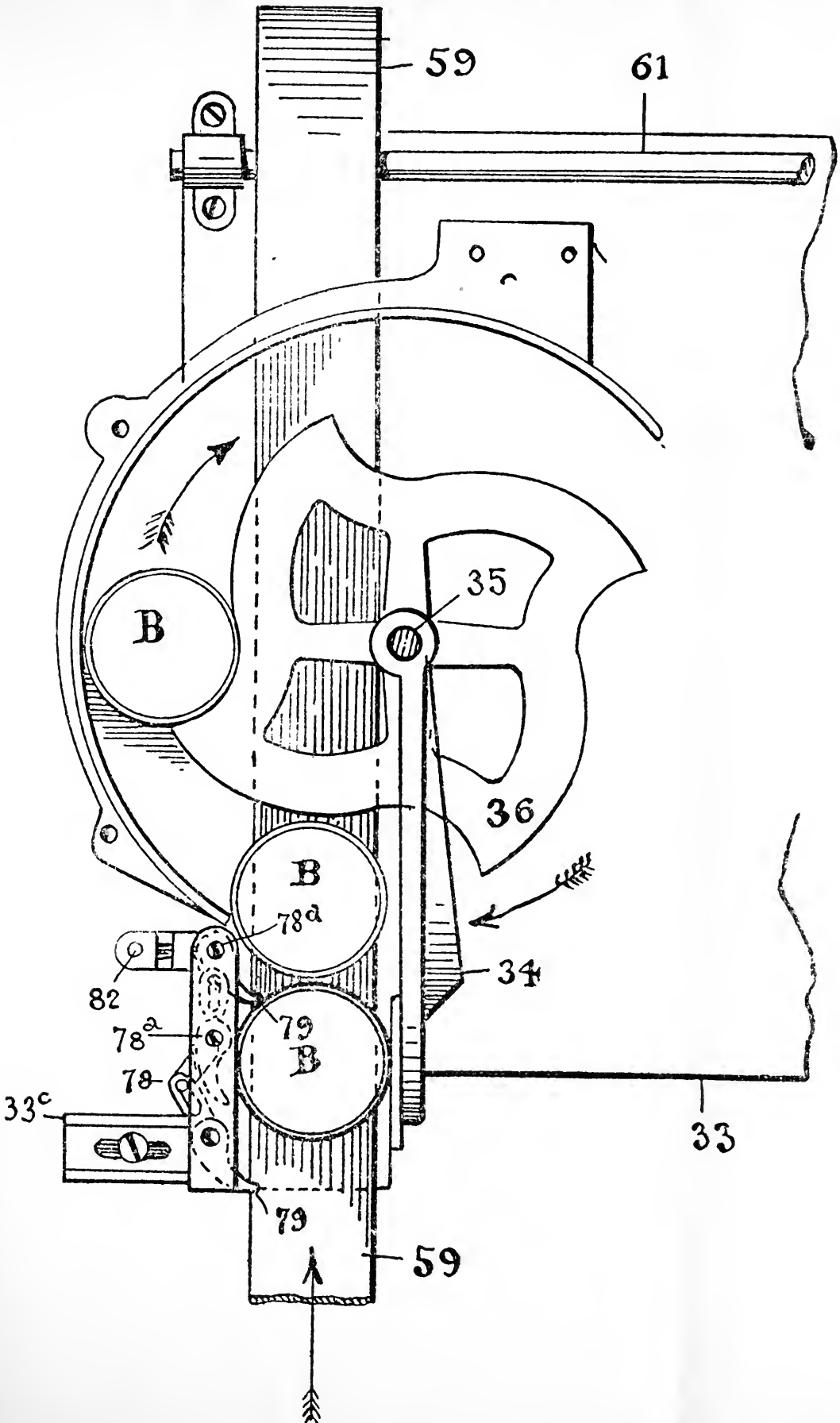
This machine is built under letters patent of the United States, No. 629,574, issued on July 25, 1890, to the defendants in this case, and illustrates the ingenuity of an infringer in his efforts to evade the patent. The defendants contend that their machine is a better one than the Jensen, and that it will cap more cans in a given time. On this point, it may be remarked that it would be strange if, after the eleven years' experience of the Jensen machine, which was the first of its kind in the art, skilled mechanics could not improve upon it in details of construction. It may also be remarked that it is immaterial whether the defendants' machine is or is not better than that of the complainant. The question is whether the defendants have in their machine appropriated the substance and essence of the Jensen invention, as covered by the Jensen patent.

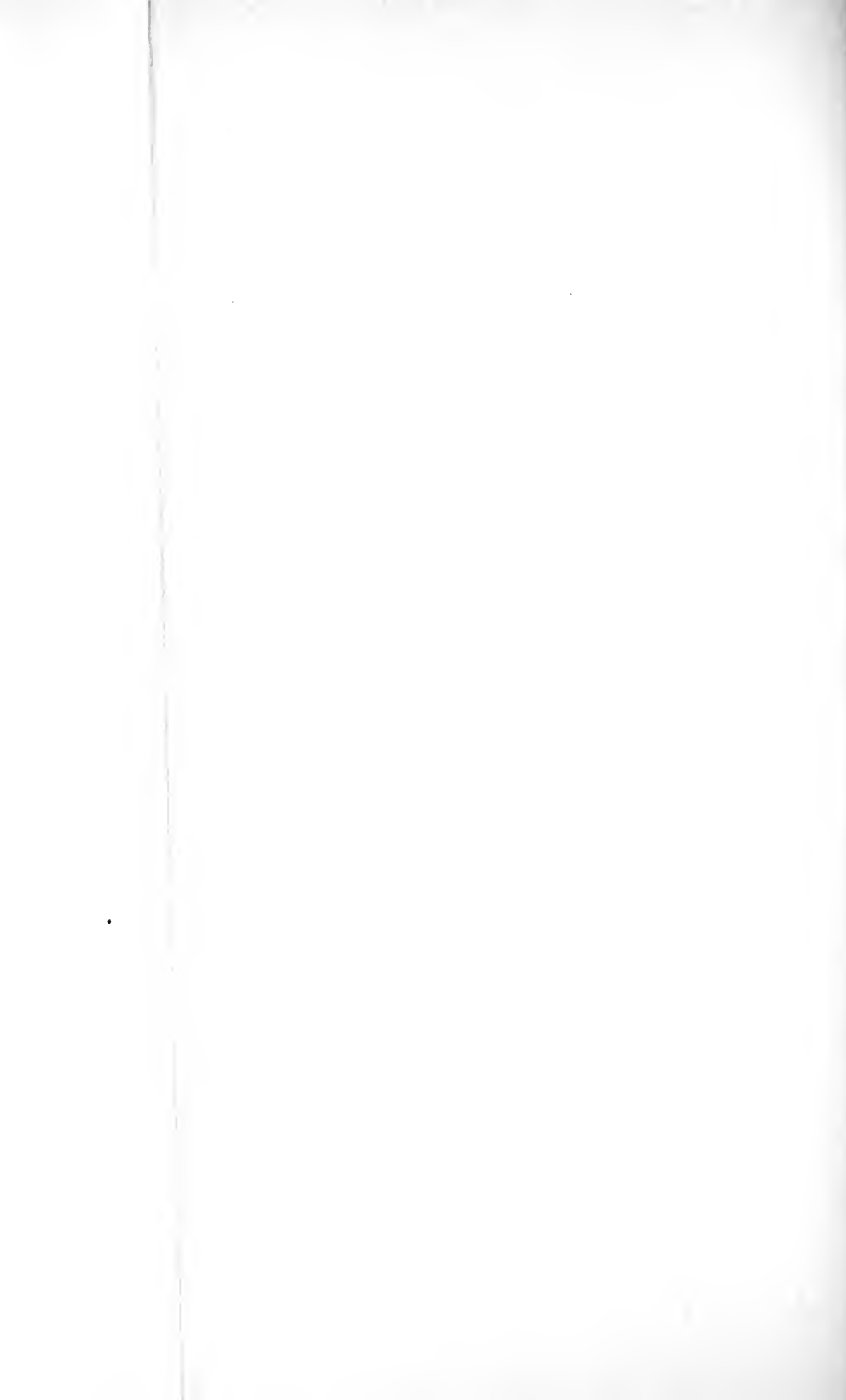
Like the Jensen, the defendants' machine consists of the same fundamental elements, differing only in matters of form.

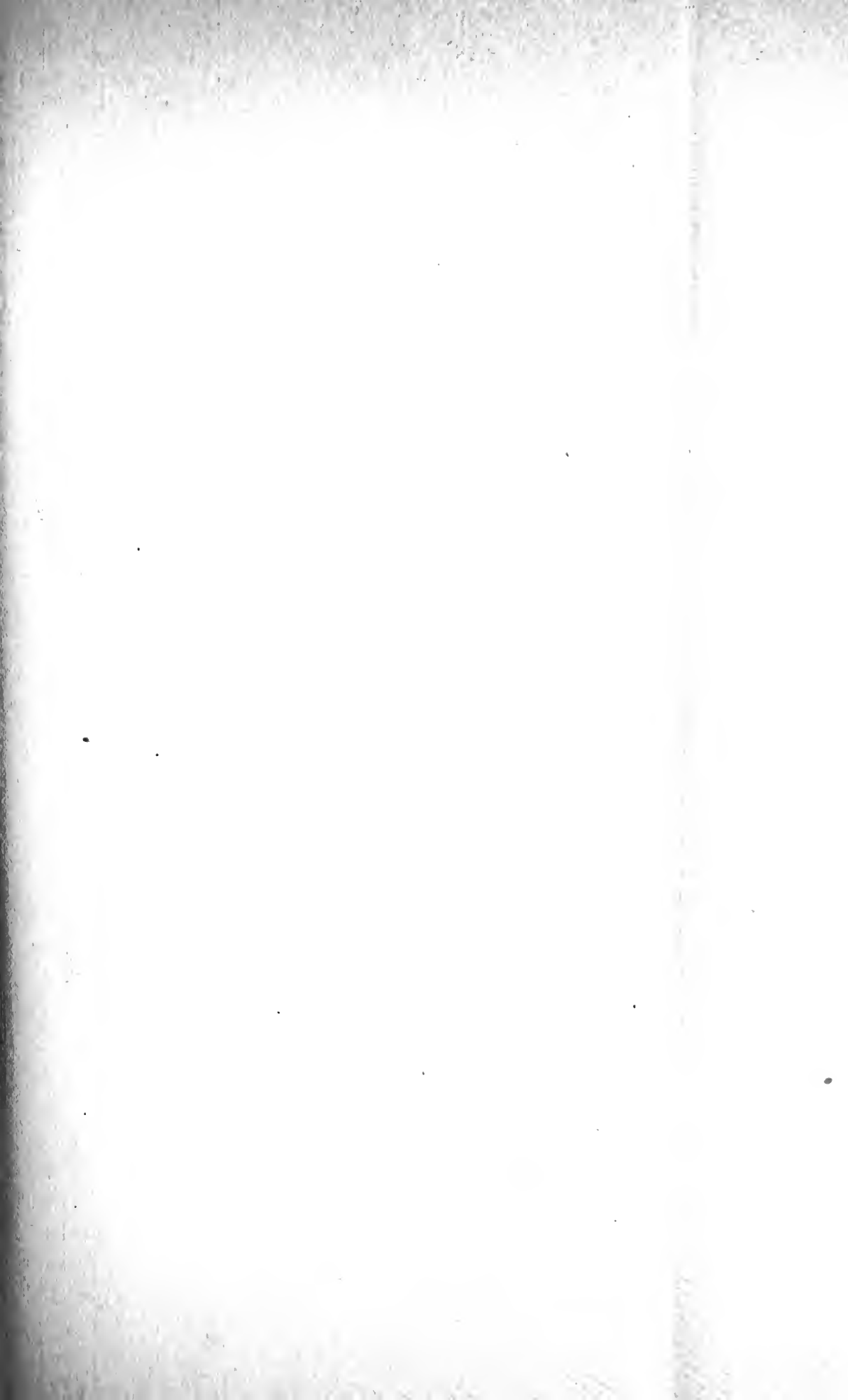
On the adjoining page is a cut marked "Cut V, Letson & Burpee's Can-Feeding Mechanism," representing that portion of the defendants' machine whereby the cans are delivered to the feeder. In the drawing, 59 is the endless traveling belt, and BB are the cans resting thereon. The devices marked 79, 79, are the

CUT V.

Letson & Burpee's Can-feeding Mechanism.

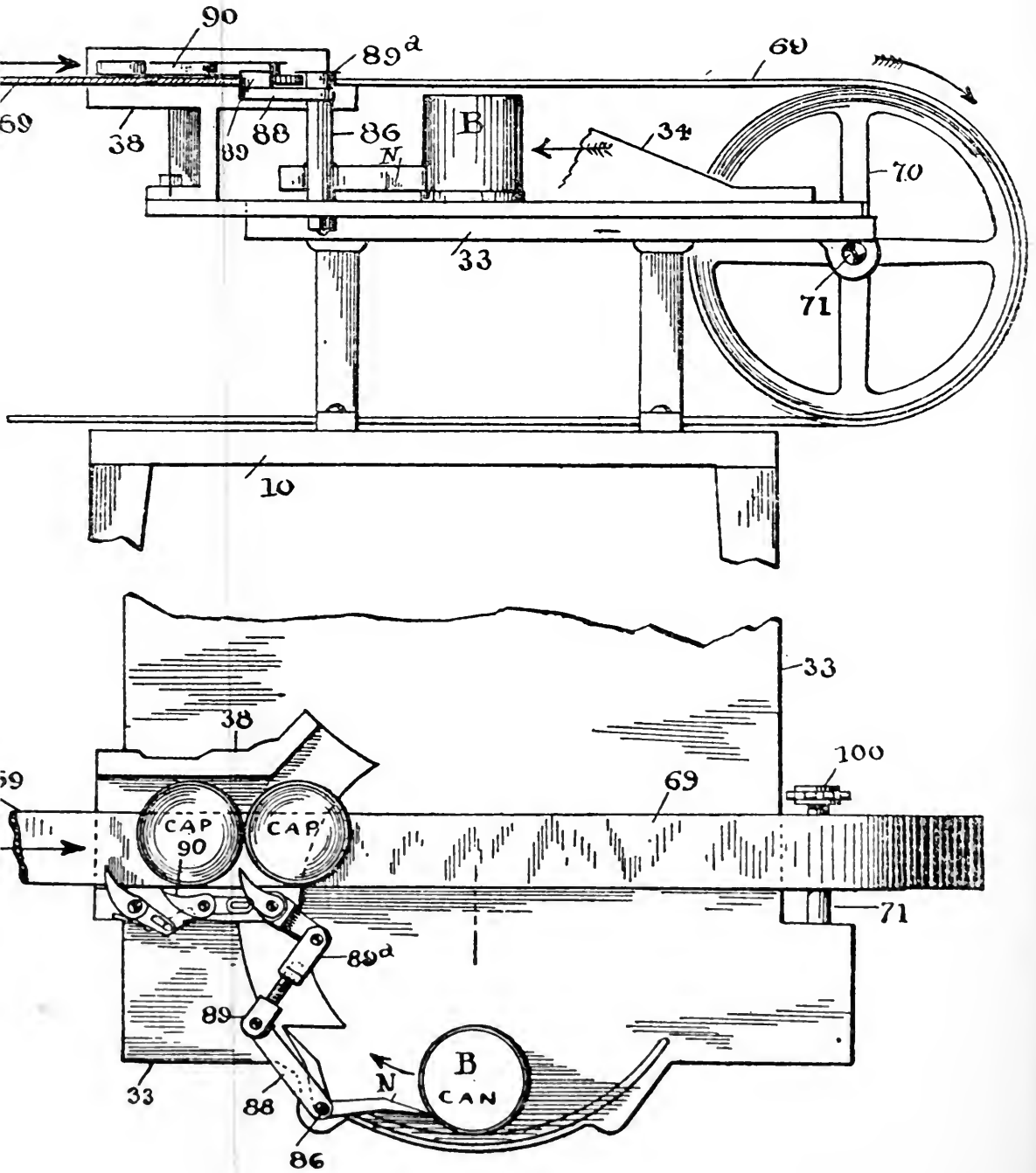






CUT VI.

Letson & Burpee's Cap-feeding Mechanism.

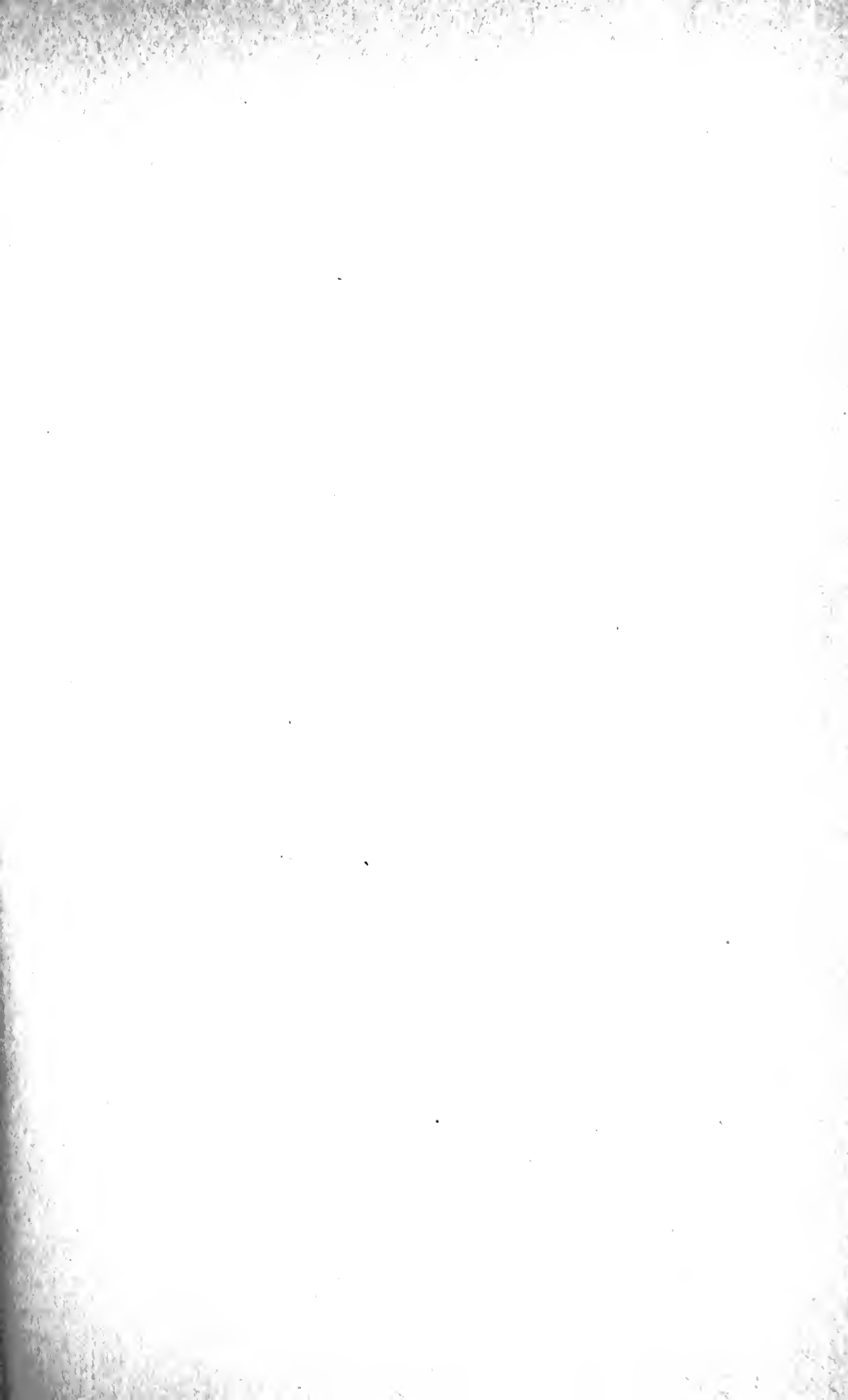


“ arms swinging over the belt, whereby the delivery of
“ the cans from the belt to the feeder is rendered exact.”
They are spacing devices separating the cans and regulating their delivery, performing exactly the same function and in substantially the same way as the corresponding arms in the Jensen device. The device in the drawing, marked 36, is a toothed wheel rotating on a spindle, 35, across the surface of the belt. As shown in the drawing, when the can reaches this wheel it will strike against the same, as shown, and thereby the forward motion of the can will be retarded or practically arrested. In other words, that portion of the wheel rim acts as a transverse stop, extending across the belt to arrest further progress of the cans. It does not effect a dead stop, but slows up the motion so as to allow the recess in the wheel to come around. Immediately thereafter, as the wheel rotates, the can is caught in the recess of the wheel and removed from the belt into the circular guideway shown. The forward can in the drawing is shown as resting in the recess of the wheel and moving along the circular guide-way in the direction of the arrow.

The next drawing, shown on opposite page and marked “Cut VI, Letson & Burpee’s Cap-Feeding Mechanism,” shows the defendants’ mechanism for releasing the caps. These caps are fed to the machine by

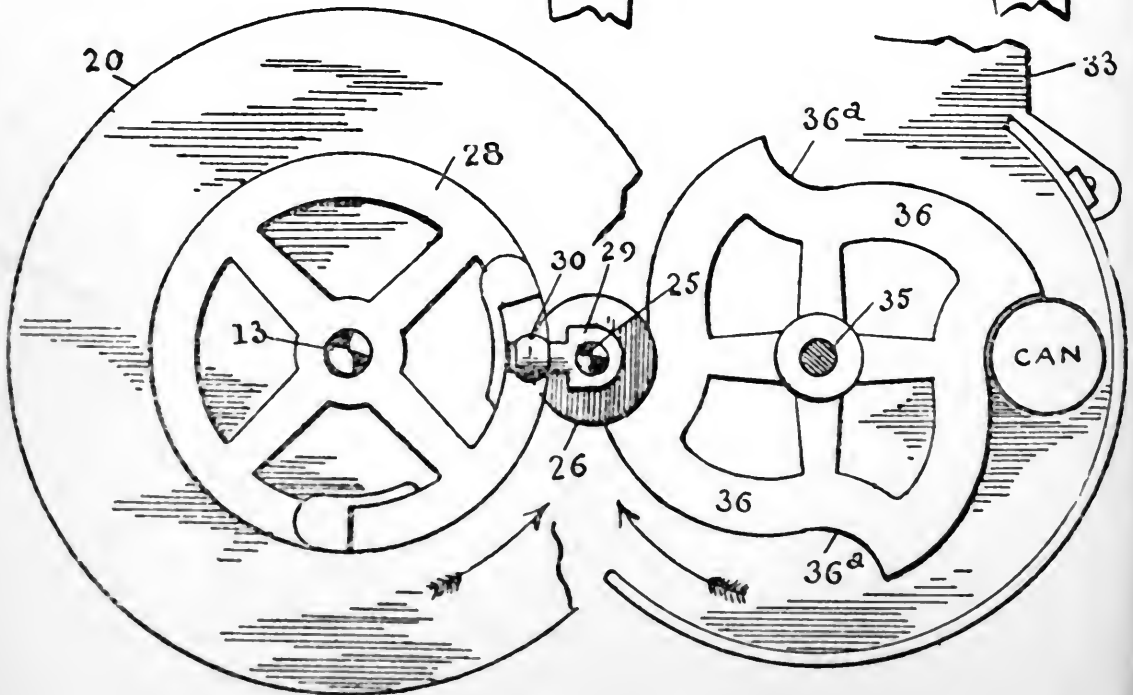
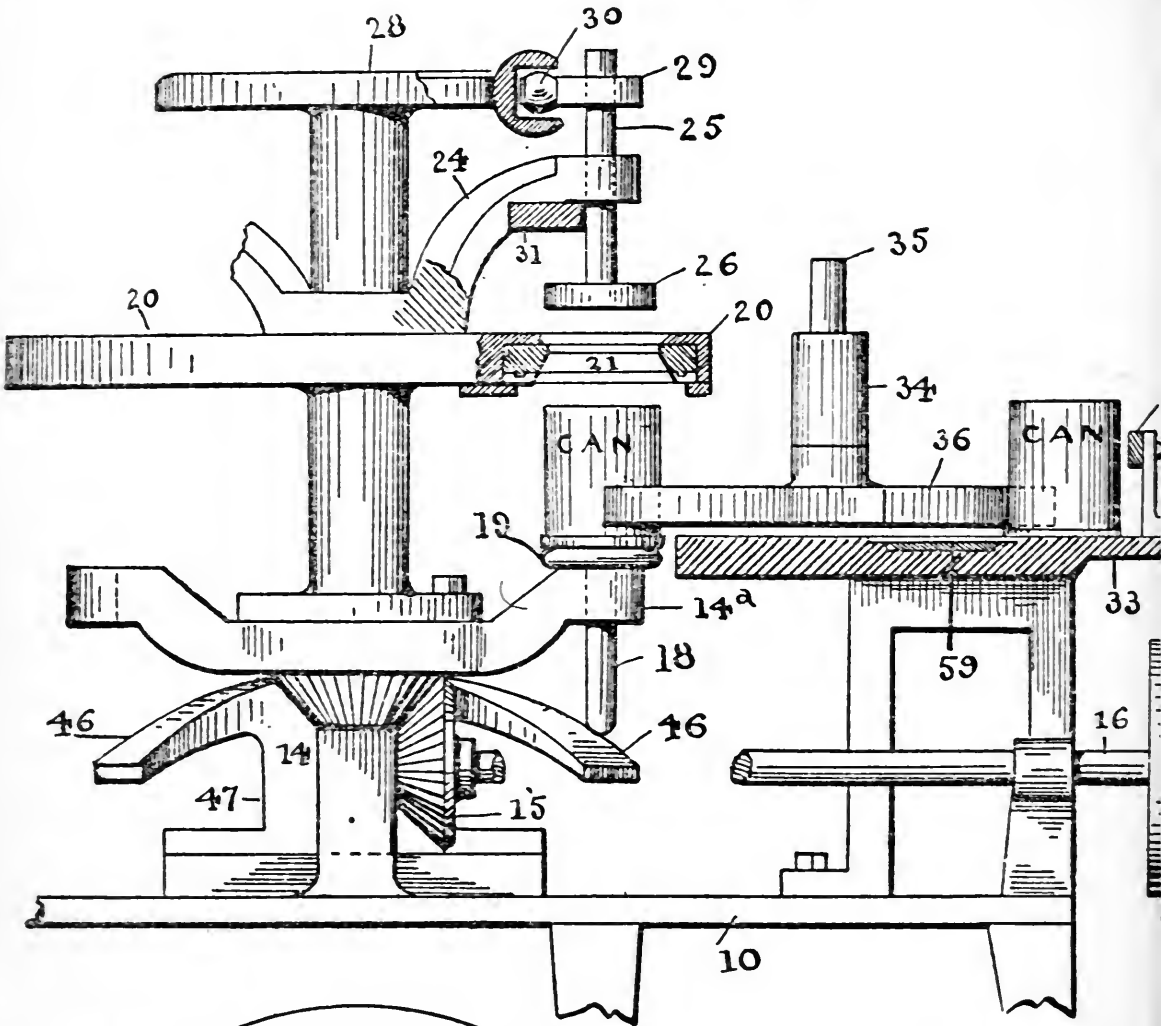
an endless belt, instead of by an inclined chute, and they are held in place on the belt, separated from one another by the stops, as clearly shown in the drawing. The letter N designates the trigger immediately in the path of the moving cans, and this trigger is shown to be connected with the stop, which restrains the caps. When the can strikes against the trigger N, the stop releases the cap, and this cap is delivered by the belt to a device which carries it to the capping mechanism (not shown in this drawing), where it is placed on the can. *Each can automatically releases its own cap.* The only difference between this mechanism and that of Jensen is the substitution of a belt for the inclined chute as the device for feeding the caps. But Mr. Jensen claims no invention in a cap-carrying chute, in and by itself, and consequently a cap-carrying belt is an equivalent of the cap-carrying chute. This we will discuss later.

Another remark at this point is pertinent. When a cap is released by the stop on the defendants' belt, it is not delivered directly to the capping mechanism, but to an intermediate device, which in turn delivers it to the capping mechanism. This intermediate device consists of a skeleton wheel similar to the carrier wheel for the cans. The caps are fed into the circular recesses of this wheel, and in that way carried to the capping



CUT VII.

Letson & Burpee's Can-capping Mechanism.



mechanism. The Jensen machine likewise has an intermediate delivery device for the caps, differing, however, in form, from that of defendants. It consists of a forked arm, which, by an ingenious motion, rakes the caps toward the capping mechanism almost precisely as a human finger would do. This intermediate mechanism is no part of the claims in suit, being covered by others not sued on, and hence is not material to the present inquiry.

The next drawing, reproduced on opposite page and marked "Cut VII, Letson & Burpee Can-Capping Mechanism," shows, in general outline, the capping device. The feeder, 36, is shown as having already delivered one can to the plunger, which plunger is represented by the figures 19. The plunger consists of a seat, 19, on which the can rests, and a spindle, 18, passing loosely through a vertical bore in the rotating arm, 14a. The bottom of this spindle, 18, moves on the stationary cam-face, 46, which is an inclined plane. As the spindle moves on this cam, it is pushed upward through the vertical hole in the arm, 14a, and thereby the plunger, 19, carries the can upward through the conical guide shown, the opening in which is marked 21. Immediately above this conical guide are three transversely moving slides for holding the caps over the can-body,

which will be illustrated more in detail by a subsequent drawing. Above these slides is a second plunger, 26, called in the Letson & Burpee patent a "cap-presser," whose function is to act as a back-plate in the capping operation, and also, as we claim, to follow the capped can down and steady it. It is operated by the mechanism marked 28, 29, and 30, which differs in details from the corresponding mechanism in the Jensen patent. That fact, however, is immaterial, inasmuch as no claim is made by Jensen for any particular form of mechanism for operating his upper plunger. His claims in that regard call merely for a "mechanism."

The drawing on the adjoining page, marked "Cut VIII, Letson & Burpee's Slides," will more clearly illustrate the details of the slides above referred to. These slides, 51, are three in number, and, when brought together form a complete circle. They have the annular ledge or rim, 51b, which acts as a seat for the cap, precisely as in the Jensen device. Immediately under these slides is shown the conical guide, 52, which acts in exactly the same manner as the Jensen device. The upper plunger is designated as 26, and its stem as 25. The lower plunger is designated by the figure 19, and its stem by the figure 18, as in the other drawing. The operation of the device is quite clear from this drawing, and needs no further description.

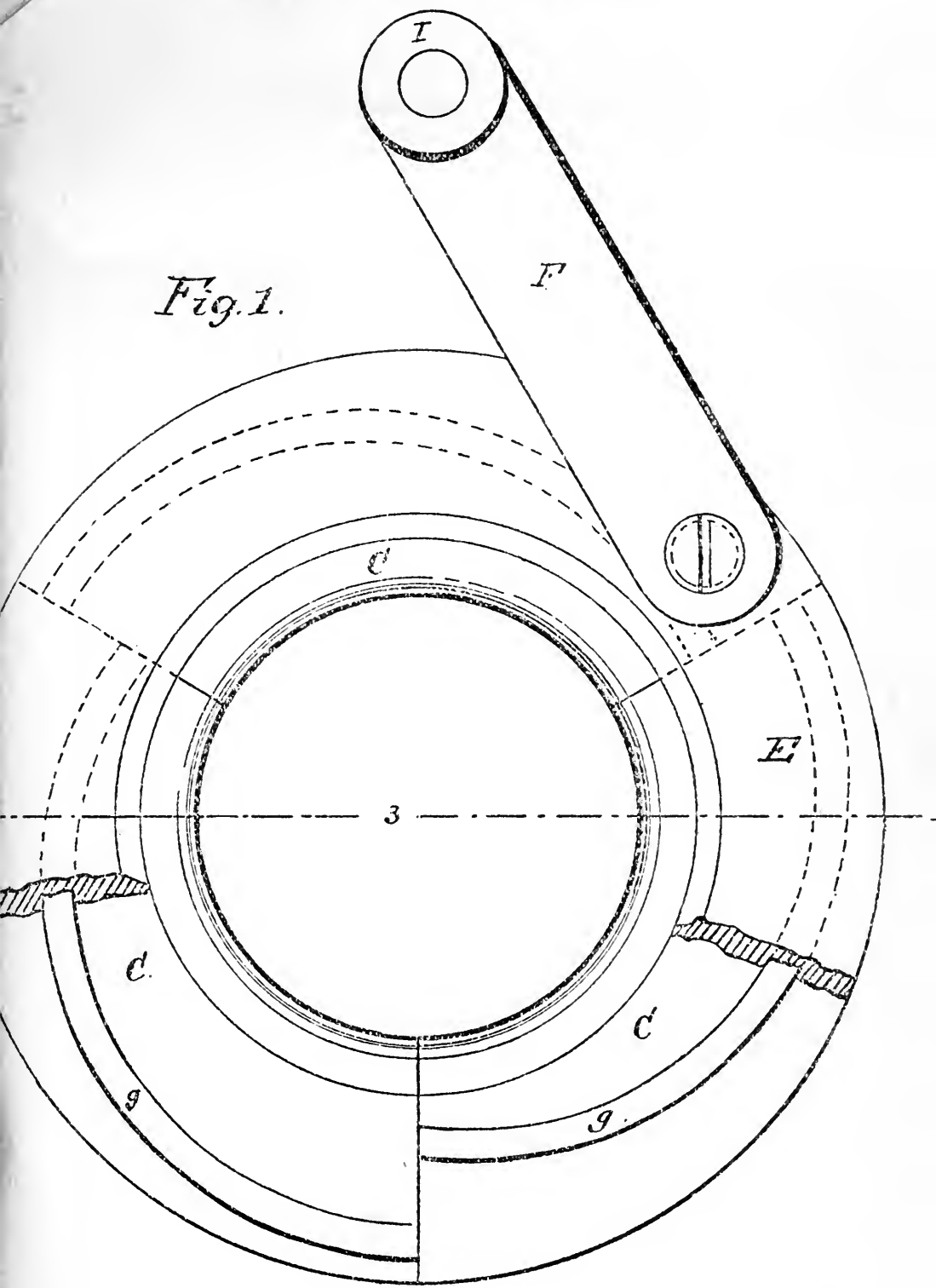


Fig. 1.

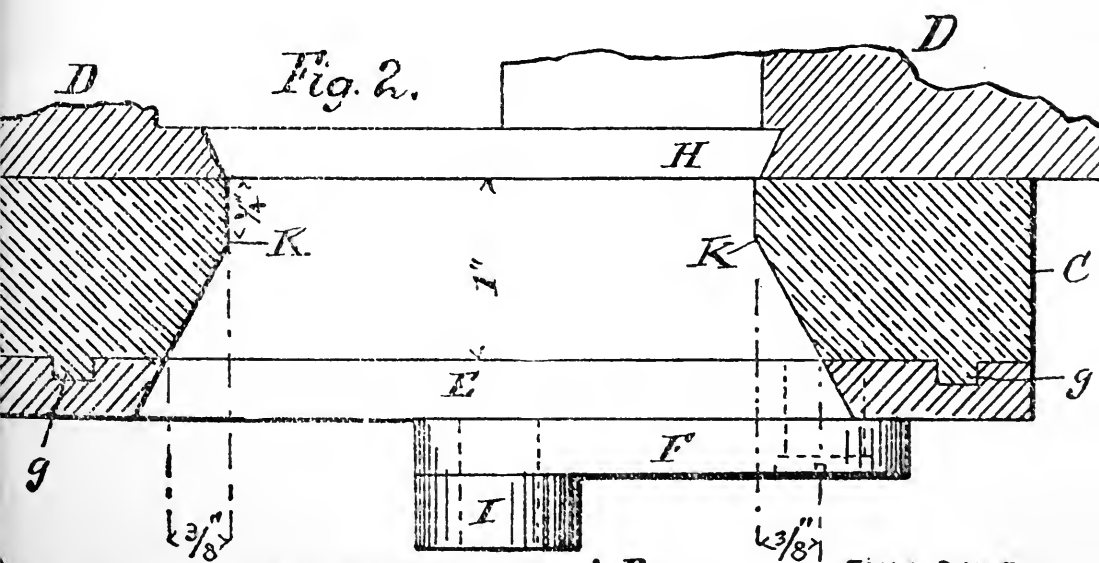
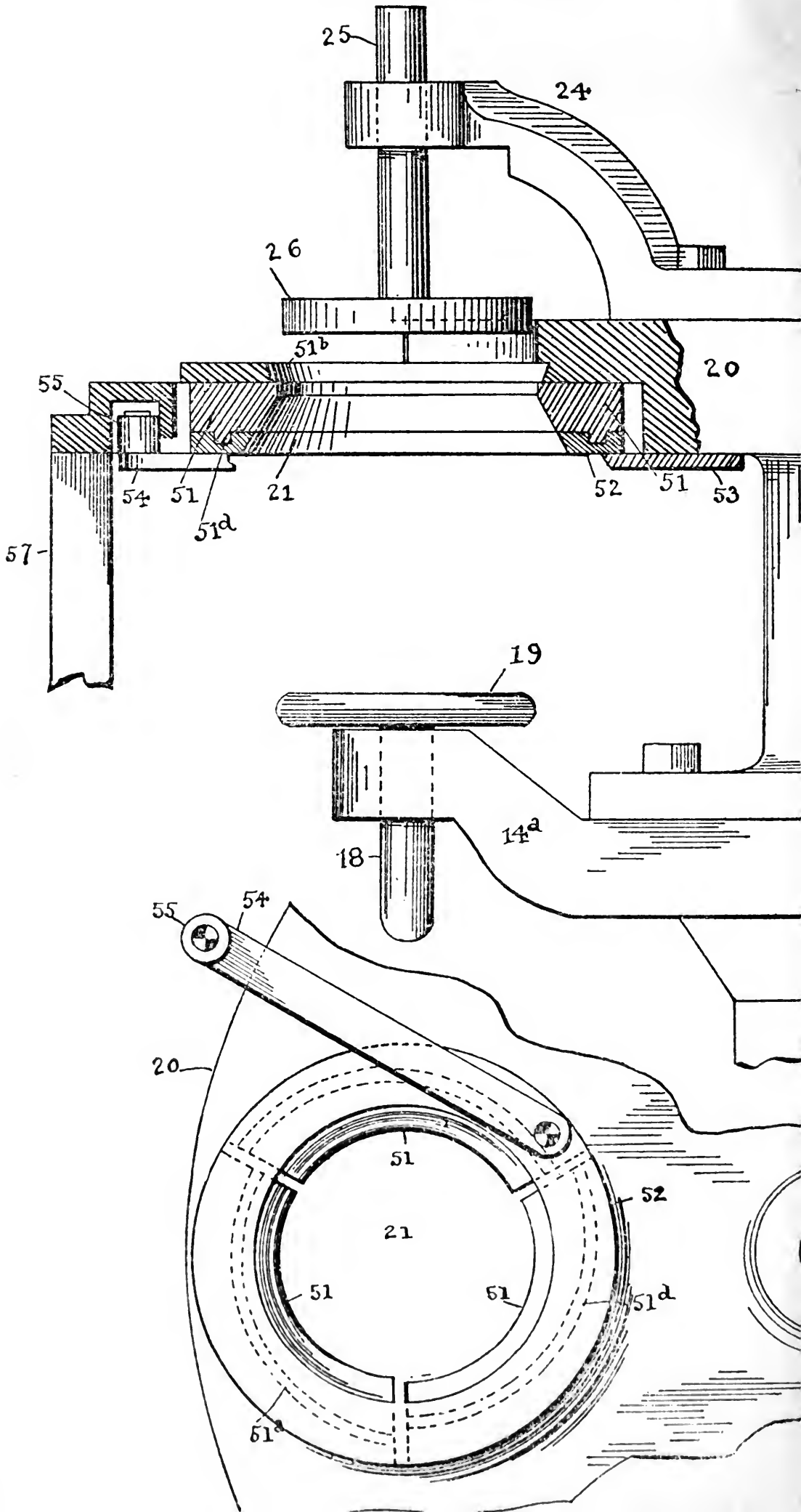


Fig. 2.

SECTION ON LINE A.B. FULL SIZE.



Letson & Burpee's Slides.



A modified form used by defendants in some of their machines, as proved by the testimony of Mr. Burpee first taken, is illustrated in the drawing reproduced on opposite page and marked "Cut IX, Letson & Burpee Slides—Modified Form."

In that cut, DD represents portions of the main face-plate. H is a flared hole in said plate. CC are the three transversely moving slides. When these slides move inwardly, an annular ledge or seat is formed, clearly shown in the cut, on which the cap rests. After the can enters the cap, the slides recede and the capped can descends.

It may also be remarked, for further explanation, that the Letson & Burpee machine contains four of these can-capping mechanisms. Each one is mounted on an arm, which revolves around a central vertical shaft, and the cans are capped while these devices are revolving. Four cans are operated on at the same time, and this helps to explain the increased capacity of the machine. In Jensen's machine only one capping mechanism proper is used, and it does not rotate. These differences are not material to the claims in controversy. This matter will be further adverted to later on herein.

It will be seen from the foregoing that the Letson &

Burpee machine contains all the fundamental and essential elements of the Jensen, viz :

1. *An endless can-feeding belt for supplying the cans to the machine.*

2. *Arms swinging over this belt to render the delivery of the cans from the belt to the feeder exact.*

3. *A device, i. e., a stop, extending transversely across the belt to arrest further forward motion and change the direction of the cans.*

4. *A feeder, which, by a circular sweeping motion, transfers the cans from the belt to the capping mechanism.*

5. *A cap-feeding device for supplying the caps to the machine.*

6. *A mechanism whereby each can releases its own cap, consisting of a stop in the path of the caps, a trigger in the path of the cans, and a connecting mechanism between the stop and the trigger.*

7. *A capping mechanism, consisting of two oppositely placed plungers, a conical guide, and transversely moving cap-holding slides.*

There can be no question that these are the fundamental elements of the Jensen machine. Nor can there

be any doubt that the Letson & Burpee machine contains all of the aforesaid fundamental elements. It is true that some of these elements, as shown in the Letson & Burpee machine, are of different form and details of construction from the corresponding elements shown in the drawings of the Jensen patent, but that fact is immaterial when we consider the pioneer character of the Jensen invention. This brings us directly within the ruling of Judge McKenna in the case of *Bowers vs. Von Schmidt*, 63 Fed. Rep., 580. Referring to the question of an excavator, the learned judge there said:

“It is sufficient to state my conclusion from the evidence, which is that plaintiff’s excavator is broadly new and entitled to a liberal rule of equivalents, and, applying such, the defendant’s excavator is an infringement of it. There is a difference in the mounting of the two excavators—a difference in the shapes of their cutting blades—but they are essentially the same, and operate substantially the same way, producing the same result. It may be, as is claimed, that defendant’s excavator is the better. It may be, as appears to be conceded by plaintiff, that it is an invention, but this does not prevent it from being an infringement, under the decision of *Morley Sewing Machine Co. vs. Lancaster*, 129 U. S., 263, and the cases there cited. *Norton vs. Jensen*, 49 Fed., 859; *Miller vs. Manufacturing Co.*, 151 U. S., 207; *Reece Button Hole Machine Co. vs. Globe Button Hole*

“*Machine Co.* (decided by the court of appeals for the first circuit, April 20, 1894), 61 Fed., 958.”

This Von Schmidt decision was affirmed by this court in 80 Fed. Rep., 121, where the law is stated that in the case of a pioneer invention the claim therefor is entitled to a broad and liberal construction, and a subsequent device, which performs the same function in substantially the same way, is an infringement, although such subsequent device may differ from the patented device in details of construction, and may even amount to a patentable invention.

Referring again to the case of *Norton vs. Jensen*, 49 Fed., 862, we find the same rule of law. It is there said:

“Norton’s invention must, therefore, be considered as being of a primary character, standing at the head of the art as the first machine ever invented for applying tight exterior-fitting can-heads to can-bodies automatically, and appellees are entitled to a broad and liberal construction of the claims of their patent. * * * The fact that the Jensen machine, as constructed, is an improvement in some respects upon appellee’s machine must be admitted; but this does not relieve it from the character of an infringing machine. Norton, being the original inventor, he and those claiming under him would have the right to treat as infringers all persons who make devices for machines operating on the same principle and per-

“forming the same functions by analogous means or
“equivalent combinations, even though the infringing
“machine may be an improvement on the original and
“patentable as such.”

It may be remarked here that in the subsequent case of *Norton vs. Wheaton*, 70 Fed. Rep., 833, the court of appeals, upon a fuller showing of the state of the art, which had not been made in the original Jensen case, held that the Norton patent was not of a pioneer character; but that does not change the rule of law announced in the original Jensen case. In fact, it serves to strengthen our position in the case at bar; for it is apparent that if in the original Jensen case that full showing of the state of the art had been made which was subsequently made in the Norton-Wheaton case, beyond all doubt it would have been held that the Jensen machine was not an infringement upon the Norton patent.

But, however that may be, the original Norton-Jensen decision does not militate against the pioneer character of the Jensen machine, because the Norton machine was not a machine for placing heads on *filled* cans, whereas the Jensen machine is designed especially and particularly for the purpose of putting the caps on *filled* cans, and in that particular regard is the first machine of the kind in the art. It is in that feature that

we claim pioneership for Jensen. We do not claim that Jensen machine is a pioneer machine broadly for capping cans, but what we do claim is that it is a *pioneer machine for automatically capping filled cans*, and as such it met a long-felt want in the art and has proven to be an inestimable boon to the salmon-canning industry of the world.

DIFFERENCES BETWEEN THE MACHINES.

We now call the court's attention to some differences of construction between the Jensen and the Letson & Burpee machines. The main difference, and the one which the learned counsel for defendants principally rely on, is that the Jensen machine is an "intermittent" or "stop-motion machine," as he calls it, whereas the Letson & Burpee machine is a "continuously operating one." In the Jensen machine, when a can is removed from the feed-belt it is transferred by the feeder to a certain point on the table, and there left standing temporarily while the feeder retraces its steps and grasps another can. When it returns, the first can that has been left temporarily standing is again grasped by the feeder and delivered to the capping mechanism. In this way the machine may be said to be an "intermittent" machine, or, as the learned counsel denominates it, a "stop-motion" machine. On on the other hand,

the Letson & Burpee machine is a continuously operating one. There is no stop-motion. The can travels continuously through the machine, and does not stop at any time.

This difference between the two machines, however, is not material to the controversy in question, in view of the pioneer character of the Jensen invention. Jensen has not claimed his invention as an intermittent or stop-motion machine. He merely illustrates that kind of a machine as one of the forms in which his invention can be embodied. The ultimate object he was seeking to obtain was the production of a machine which would automatically place the caps on filled cans, a thing which had never been done before. He illustrated in his drawings, as one form of machine for doing that thing, an intermittent machine, but when he came to frame his claims he did not limit them to an intermittent machine. The law requires an inventor to illustrate only one form of his invention, which must be the form which he conceives to be the best. After he has done that, he is entitled to make a claim which will cover all forms, if his invention be of a pioneer character. If his invention is not a pioneer invention, but merely an improvement over prior inventions, then the rule is entirely different, and he is limited to the par-

ticular form described and claimed and merely colorable evasions thereof.

The law on this subject is too clear to admit of doubt, and the leading case of *Morley Machine vs. Lancaster*, 129 U. S., 263, is conclusive of the point. Morley was the first in the art to produce an automatic machine for sewing shank buttons upon fabrics, a thing which had never been done before, except by hand. He showed only one form of construction in his patent, and then made a claim in the following language:

“The combination in a machine for sewing shank buttons to fabrics, a button-feeding mechanism, appliances for passing the thread through the eye of the button and locking the loop to the fabric, and feeding mechanism, substantially as set forth.”

This was a claim for the combination of (1) a button-feeding mechanism, (2) a stitching mechanism, (3) a fabric-feeding mechanism. *Only one particular form of each of those elements was shown in his patent*, but he was the first to combine those elements in any form, and by it he produced a new result—a machine for automatically sewing shank buttons on fabrics. He was a pioneer, and his claim received a broad construction. The defendant’s machine was entirely different in the form and details of those particular ele-

ments, though when combined they accomplished the same purpose. In deciding the case, the Supreme Court, through Mr. Justice Blatchford, said:

“Morley having been the first person who succeeded in producing an automatic machine for sewing buttons of the kind in question upon fabrics, is entitled to a liberal construction of the claims of his patent. He was not a mere improver upon a prior machine which was capable of accomplishing the same general result, in which case his claim would properly receive a narrower interpretation. This principle is well settled in the patent law both in this country and in England. Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in separate mechanisms which go to make up the machine.”

After discussion of various American and English cases, the court proceeded as follows:

“Applying these views to the case in hand, Morley having been the first inventor of an automatic button-sewing machine by uniting in one organization mechanism for feeding buttons from a mass and delivering them one by one to sewing mechanism and to the fabric in which they are to be secured, and sewing mechanism for moving the fabric the required dis-

“ tance, another machine is an infringement in which
 “ such three sets of mechanism are combined, provided
 “ each mechanism, individually considered, is a proper
 “ equivalent for the corresponding mechanism in the
 “ Morley patent; and it makes no difference that in the
 “ infringing machine the button-feeding mechanism is
 “ more simple, and the sewing mechanism and the
 “ mechanism for feeding the fabric are different in me-
 “ chanical construction, so long as they perform each
 “ the same function as the corresponding mechanism
 “ in the Morley machine in substantially the same way,
 “ and are combined to produce the same result. The
 “ view taken on the part of the defendants, in regard to
 “ the question of infringement, is that inasmuch as the
 “ Lancaster machine uses different devices in its
 “ mechanism which correspond to those referred to in
 “ the first, second, eighth, and thirteenth claims of the
 “ patent, those claims are to be limited to the special
 “ devices described in the patent which make up such
 “ combination, although both machines contain the
 “ same group of instrumentalities which when com-
 “ bined make up the machine. But in a pioneer patent,
 “ such as that of Morley, with the four claims in ques-
 “ tion such as they are, the special devices set forth by
 “ Morley are not necessary constituents of the claim.
 “ The main operative features of both machines are the
 “ same.”

This case is decisive of the question in hand. The
 parallel between the two is, in our opinion, exact.

The doctrine of this case was affirmed by the Su-
 preme Court in *Miller vs. Eagle Mfg. Co.*, 151 U. S.,

207; *Royer vs. Schultz Belting Co.*, 135 U. S., 325, and many others.

Other decisions of the Supreme Court in the same line are, *Consolidated Valve Co. vs. Crosby Valve Co.*, 113 U. S., 157; *Machine Co. vs. Murphy*, 97 U. S., 120; *Sessions vs. Romadka*, 145 U. S., 29; *Clough vs. Barker*, 106 U. S., 160; *Winans vs. Denmead*, 15 How., 330; *McCormack vs. Talcott*, 20 How., 402; *Railway Co. vs. Sayles*, 97 U. S., 554.

In *Harmon vs. Struthers*, 67 Fed., 637, the circuit court of appeals for the third circuit says:

“Now, where the invention, as here, is one of a primary character, and the mechanical functions performed by the device are as a whole entirely new, the established rule is that all subsequent machines which employ substantially the same means to accomplish the same result are infringements.”

In the case of *Worswick Mfg. Co. vs. City of Buffalo*, 20 Fed. Rep., 126; it appears that the patentee, Sullivan, was the first to use a device for suspending the harness above the place occupied by the horse in an engine house, so that at a given signal the harness could be automatically dropped onto the horse, thereby saving the necessity of placing the harness on by hand. Prior thereto, the harness had been placed on by hand in the usual way, necessitating the loss of much valuable time

in the case of a fire alarm. Judge Coxe said of this invention:

“So far as the records of the patent office show, Sullivan was the first to enter this field of invention. No other patent, American or foreign, is introduced to anticipate or limit the claim referred to. It should, therefore, be construed broadly to cover any similar apparatus which suspends the harness in substantially the same manner. The details of construction, both in the harness and suspending apparatus, are non-essential inferior and subordinate to the principle embodied in the patent, which is the paramount and superior consideration. The man who first conceives the idea of suspending the harness and putting into successful practical operation is the one who confers the benefit and is entitled to the reward. It would be exceedingly illiberal and narrow construction to hold that he should be deprived of the fruits of his ingenuity by one who simply changed the form of the harness or of the device by which it is suspended.”

In *McCormick vs. Talcott*, 20 How., 402, it is said:

“The original inventor of a device or machine will have a right to treat as infringers all who make machines operating on the same principle and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original and patentable as such.”

And in *Railway Co. vs. Sayles*, 97 U. S., 554, it is said:

“When an inventor precedes all others in a particular department and invents a new machine never used before, and procures a patent for the same, he acquires a monopoly as against all merely formal variations thereof.”

And further on in the same case (p. 556) it is said of pioneer inventors:

“In such cases, if one inventor precedes all the rest and strikes out something which includes and underlies all that they produce, he acquires a monopoly and subjects them to tribute.”

The law of England on the subject is the same as that of the United States, as was clearly pointed out by Chief Justice Taney in *O'Reilly vs. Morse*, 15 How., 62.

Thus, in the case of *Curtis vs. Platt*, reported in a note to *Adie vs. Clark*, 3 Ch. Div., 134, Vice Chancellor Wood said:

“When the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts; and one looks very narrowly and very jealously upon another machine for effecting the same object to see whether or not they

“are merely colorable contrivances for evading that which has been done before. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect.”

These views were affirmed on appeal in an opinion delivered by Lord Chancellor Westbury.

Similar views were announced in the case of *Badische Anilin und Soda Fabrick vs. Levinstein*, 24 Ch. Div., 156, in an opinion rendered by Mr. Justice Pearson. On appeal to the court of appeal (29 Ch. Div. 366) the decree was reversed; but on appeal to the House of Lords (12 App. Cas., 710) the decision of the court of appeals was reversed, and the decision of Mr. Justice Pearson affirmed.

In the case of *Proctor vs. Bennis*, 36 Ch. Div., 740, decided by the English court of appeal, it was said by Lord Justice Bowen:

“I think it goes to the root of this case to remember that this is really a pioneer invention; and it is in the light of that, as it seems to me, that we ought to consider whether there has been variations or omissions and additions which prevent the machine, which is complained of, from being an infringement of the plaintiff’s. With regard to the additions and

“ommissions it is obvious that additions may be an improvement and that omissions may be an improvement; but the mere fact that there is an addition, or the mere fact that there is an omission, does not enable you to take the substance of the plaintiff’s patent. The question is not whether the addition is material or whether the omission is material, but whether what has been taken is the *substance and essence of the invention.*”

The precise point of the decision is that a patent for a combination of known mechanical contrivances, producing a new result never produced before (as for instance, we say, automatically capping filled cans) is infringed by a machine which produces the same result, by a combination of mechanical equivalents, with such alterations and omissions as do not prevent the new machine from being one which takes the substance and essence of the patented invention. This rule seems to fit precisely the case at bar. It is admitted that Jensen was the first in the art to produce a machine for automatically capping filled cans, and the machine which he illustrated in his patent for that purpose shows certain details of mechanical construction. The defendants have made certain alterations, modifications and additions to those elements, and produced a machine for accomplishing the same purpose in a better and more efficient way, as they claim, but in doing that

they have utilized the substance and essence of the Jensen invention. Their machine contains all the fundamental elements of the Jensen, but in a modified and altered form as to the mere details of construction. The outward appearance is different, but the internal and basic principle is the same. It is merely the case of the same soldier in a different uniform.

In view of the law as announced by the foregoing cases it is idle to contend that Jensen's patent is limited to an intermittent machine, taken as a whole, and that a continuously operating machine cannot infringe it.

That the continuously operating machine of Letson & Burpee is faster than a Jensen intermittent machine, that is to say, will cap more cans in a given time, we are not disposed to deny. Such contention is put forward by the learned counsel for defendant, and it may possibly be true. We care not if it is. The fact is immaterial. It is too well settled to admit of discussion that this would not alone and of itself avoid infringement. Infringing machines are generally improvements on a patented machine, because the infringer has the benefit of all the experience given to the world by the patentee, and it would be remarkable if skilled and expert mechanics could not improve a known machine

so as to make it work faster. The original machine is seldom or never the best form in which the invention may be embodied, and we have Lord Coke as authority for the maxim, *Nihil simul inventum est et perfectum* (Co. Lit. 230a). The credit due to Mr. Jensen is not that he made a machine which would cap *more* filled cans than any other machine, but that he was the first in the art to build a machine that would cap *any* filled cans *at all*. He demonstrated that as early as January, 1887, and the machine he produced has proven to be a remarkable success and has conferred an inestimable boon upon the great salmon canning industry of the Pacific Coast, helping to build it up to its present magnificent proportions and thereby benefit the entire world where such products are sold. Eleven years afterwards, when the salmon canning industry had attained its zenith, Letson & Burpee came from the British Colonies into the State of Washington, and taking advantage of the knowledge that had been given to the world by Jensen in this line, made an improvement upon his machine, which is capable of capping twenty-five per cent. more cans in a given time. That they may be entitled to some credit for making a faster machine we are not disposed to deny, but we do deny most emphatically that they are entitled to use Mr. Jen-

sen's fundamental ideas in producing this improvement, or, to use the words of Mr. Justice Bowen above quoted, to appropriate "the substance and essence of the invention" made by Jensen. We believe that this court will follow the rulings made by the Supreme Court of the United States and the House of Lords of England in that regard.

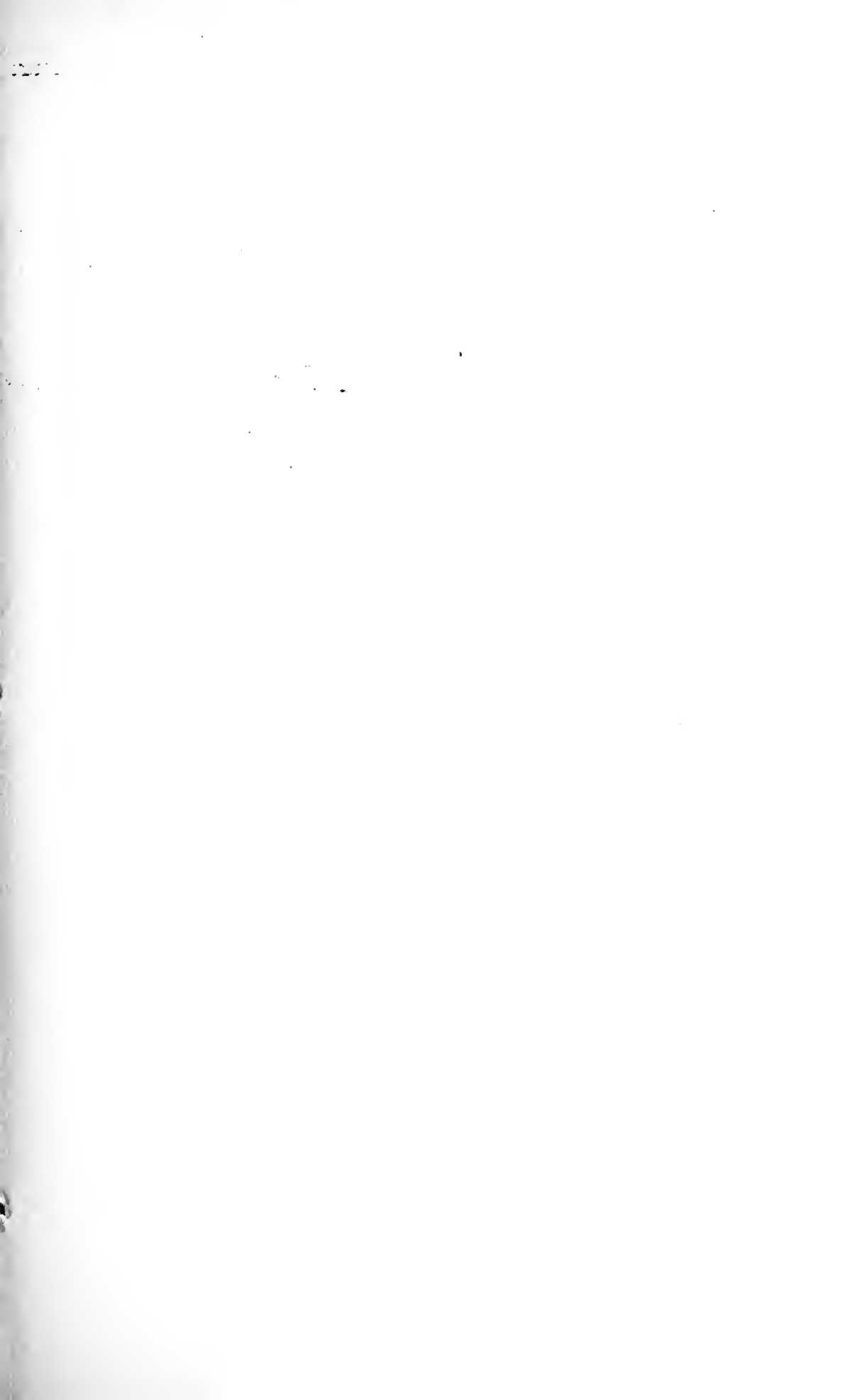
QUESTION OF INFRINGEMENT.

This is the last question to be considered in the case, and in handling it we take up the infringed claims *seriatim*.

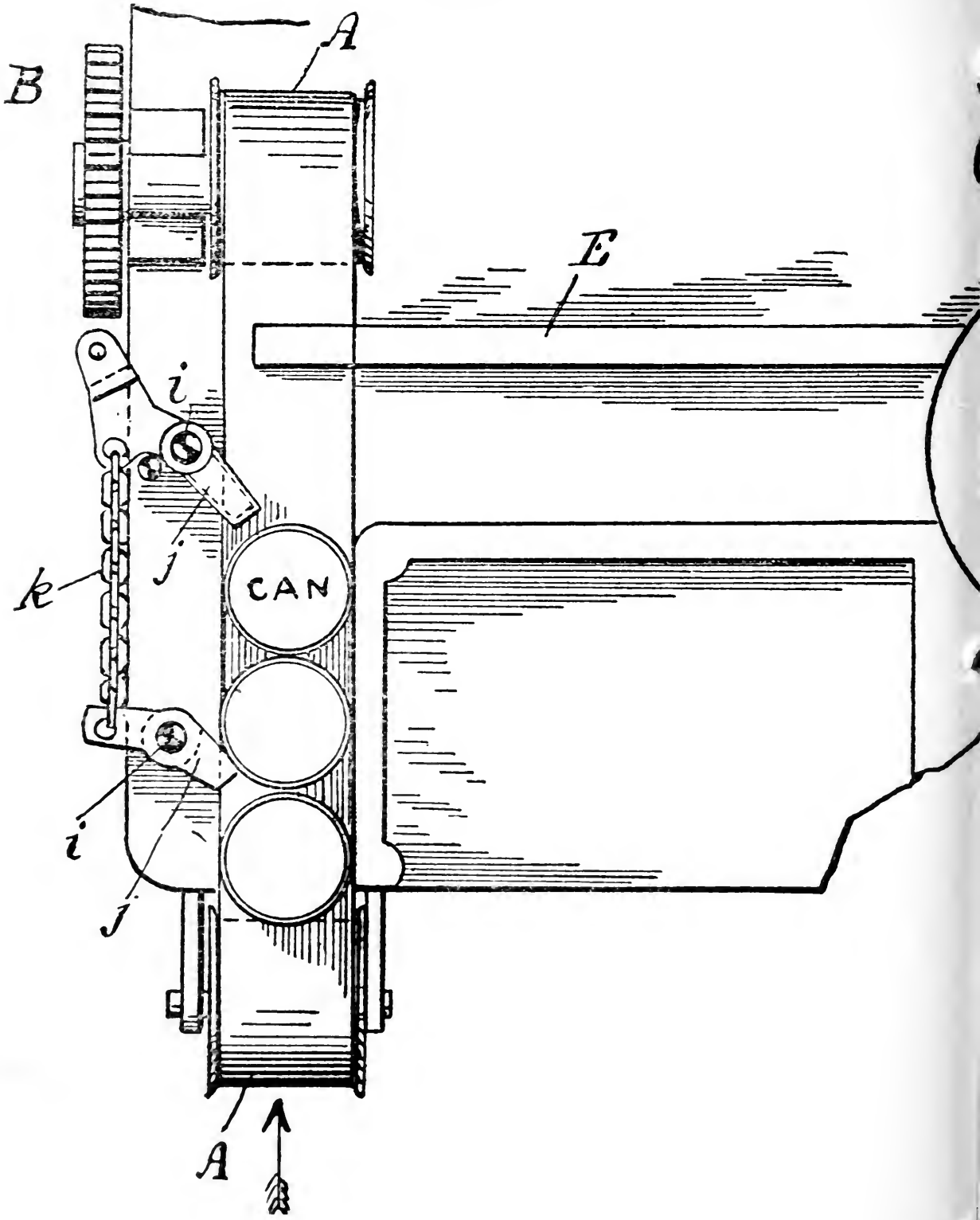
INFRINGEMENT OF CLAIM 1.

1. An endless travelling carrying belt, a stop E, extending across it to change the direction of the cans, and arms swinging over the belt whereby the delivery of the cans from the belt to the feeder is rendered exact, substantially as described.

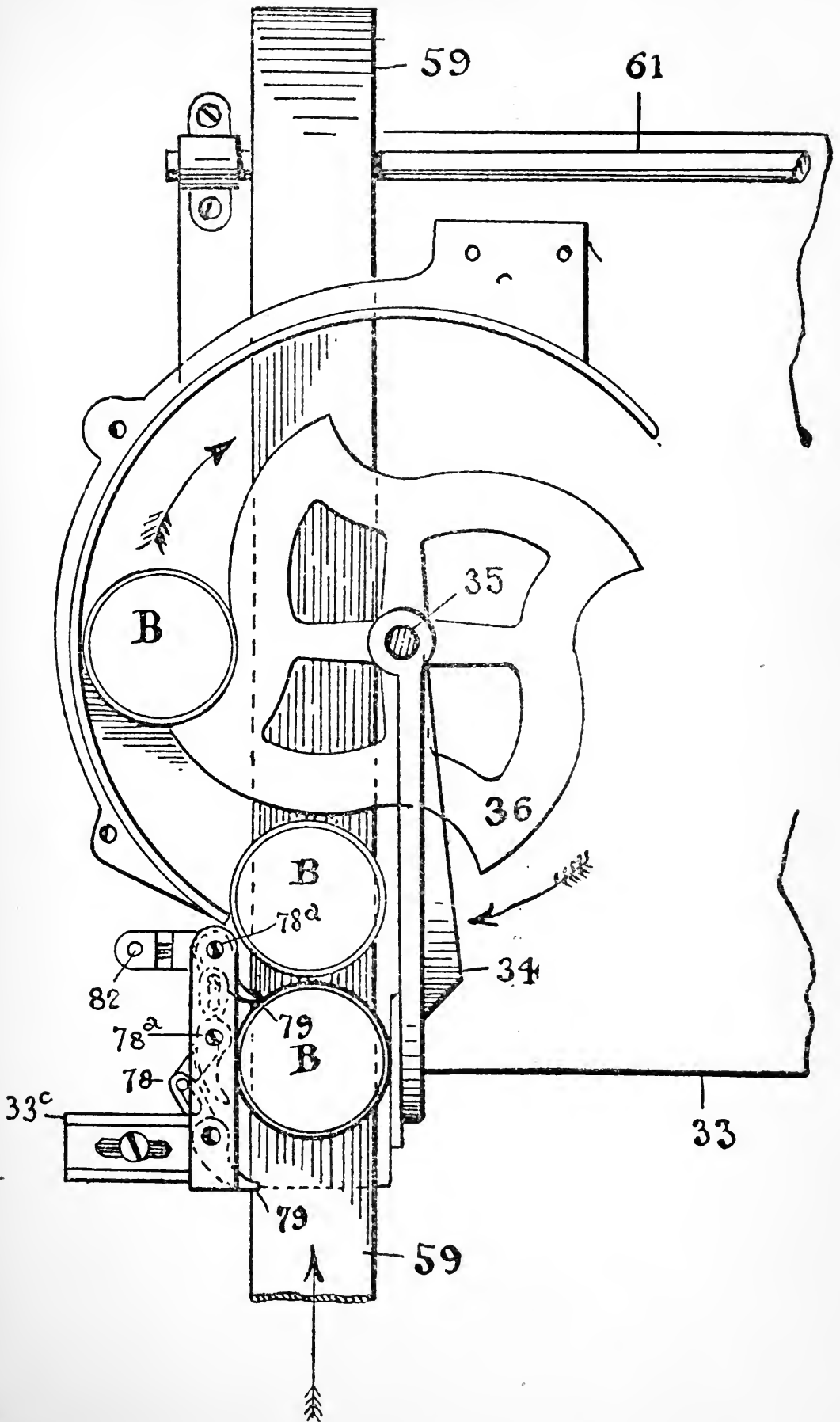
The elements of this claim are the belt, the stop, and the swinging arms. The function of the claim is the supplying of the cans to the feeder, and that is done by the combination of instrumentalities specified. The claim is a sub-combination, *i. e.*, a combination not com-



Jensen.



Letson & Burpee.





prising the whole machine, but only certain elements for the purpose of accomplishing one of the steps in the operation of the machine, viz: the supplying of the cans to the feeder preparatory to the ultimate capping operation. Of course it is apparent at a glance that such a sub-combination can be used either in a stop-motion machine or a continuous one.

Regarding the first element there can be no question. Both machines have endless traveling carrying belts operating in exactly the same way to accomplish exactly the same function.

Nor can there be any question concerning the third element, viz: "Arms swinging over the belt whereby the delivery of the cans from the belt to the feeder is rendered exact." Both machines have such arms operating in the same way and accomplishing the same result. These arms are really spacing devices used for the purpose of preventing the cans from crowding and thereby insuring the delivery of only one can at a time. By being interposed between the cans, they separate the cans and allow only one at a time to be delivered to the feeder, and thereby "the delivery of the cans from the belt to the feeder is rendered exact."

On the adjoining pages will be found two cuts marked "Cut X," one representing the Jensen and the

other the Leston & Burpee device illustrating the first claim. In the Jensen device the swinging arms are marked jj. Being interposed in the path of the moving cans, they separate said cans and prevent them from crowding against the stop E, thereby rendering the delivery of the cans from the belt to the feeder exact. These arms jj, are connected by intervening mechanism to the feeder and to the driving shaft, and the motions of these various parts are so timed that at the precise moment when a can is needed to be carried away by the feeder, *one*, and *only one* such can will be delivered at that particular time, while the rest of the cans on the belt will be held back by the swinging arms. Exactly the same function is performed in the Letson & Burpee device by mechanism operating in substantially the same way. There the swinging arms are designated by the figures 79, and, as can be clearly seen from the drawing, they perform the same function and in the same way as the arms of the Jensen patent.

The third element of claim 1 is specified as "A stop " E, extending across it (the belt) to change the direction of the cans." It is contended by the defendants that they have no such stop in their machine. Whether or not they have in their machine a device technically called "a stop," and that is the extent of the argument,

is not the material point for consideration. The question is whether they have in their machine *a device which performs substantially the same function as the Jensen device, called by him a stop, i. e., a mechanism extending across the belt to change the direction of the cans.* We care not whether such device be called a "stop" or by any other name. In patent law the material inquiry is as to the function and mode of operation of a thing, not as to its name. While names may aid us sometimes in determining the nature of a thing, it is not an infallible test, and the function of a thing cannot be changed by changing its name.

Said Mr. Justice Clifford in the case of *Machine Co. vs. Murphy*, 97 U. S., 120:

"In determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another if it performs substantially the same function in substantially the same way to obtain the same result, etc., etc."

In the light of this language let us see if the Letson & Burpee stop is not the equivalent of Jensen's.

As stated above, the function of Jensen's stop E is to change the direction of the cans. The form shown in his drawing is a plain transverse bar extending across the belt. When the can body impinges against this bar, further forward motion of the can-body is stopped or arrested, and at the same instant the feeder grasps it and changes its direction of motion by sweeping it transversely from the belt.

In the Letson & Burpee machine there is a corresponding device which accomplishes the same purpose in substantially the same way. That device consists of the rim of the wheel indicated in the drawing by the figure 36. This wheel rotates in the line of the arrows on the shaft 35. It is a skeleton wheel having semi-circular recesses or pockets formed in its periphery, into which the can-bodies are fed and there held. The wheel extends transversely across the belt and in the position shown in the cut, which is the position illustrated in the Letson & Burpee patent drawing, it will be seen that a portion of the rim of the wheel extends transversely across the belt immediately in front of the can in substantially the same way as the transverse bar, except that it is not stationary. The moving can-bodies strike against this obstruction, and the inevitable result is to arrest or retard the forward

motion of the can. It is true that the can does not come to a dead stop, as in the Jensen device, because of the curvature in the rim of the wheel 36, which is constantly moving. The actual result, however, is that the motion of the can-body is retarded and arrested until the recess in the wheel comes around and grasps the can-body and transversely sweeps it from the surface of the belt. It practically "stops" further forward motion of the can, by retarding the same until the recess reaches the can and sweeps it from the belt. We submit, therefore, that the functions of the two devices are the same. It may be true that in the Leston & Burpee machine there is not a technical "stop," inasmuch as the device does not effectuate an absolute dead stop of the can-body, but nevertheless the fact remains that it does to the can-body exactly the same thing that is done to the can-body by the Jensen stop, viz: it arrests the forward motion of the can-body and changes its direction by causing it to be swept off of the belt transversely. When two devices do substantially the same thing in substantially the same way, they are mechanical equivalents, although they may be called by different names or may be of different form and details of construction. The fact that Letson & Burpee's wheel is rotary, while Jensen's stop is stationary, is immate-

rial, because the claim does not necessarily call for a stationary stop. It merely calls for "a stop E," and such a stop may be either stationary or moving.

Nor is it a material fact that the Letson & Burpee wheel acts as a feeder as well as a stop. So long as it has the function of a stop, it matters not how many additional functions it has.

In regard to this claim we call the court's attention to the fact that it is one for a pioneer invention. Mr. Jensen was the first in the art to use such a combination. Prior to his invention no device, of any kind, shape or form, was known or used for feeding filled cans to an automatic capping machine. Prior to him filled cans had not been automatically capped by any kind of a machine, but only by hand. Consequently, this claim is entitled to a broad and liberal construction under the doctrine of *Morley Machine Co. vs. Lancaster*, 129 U. S.

It may possibly be contended that because the claim refers to the stop by letter, calling it a "stop E," therefore the claim is limited to such specific form of stop. The argument is unsound. There have been cases, it is admitted, where the courts have held that an element of a claim must be limited to the specific form shown, when said element is designated by a specific letter or

figure; but this only applies when the invention is a narrow one and a mere improvement over prior devices. It does not apply where the claim is for a pioneer invention. If an inventor makes a pioneer invention, which he illustrates in his drawing by letter, he may claim it by such letter in his claim, and yet his claim will be just as broad in contemplation of law as though he had framed the claimed in broad generic language. Indeed, the reading of the law would imply that it is the duty of a patentee to claim his invention in the precise form shown in his drawing, whether his invention be broad or narrow, pioneer or improvement. The law is embodied in section 4888 of the revised statutes, which reads as follows:

“ Before any inventor or discoverer shall receive a
 “ patent for his invention or discovery, he shall make
 “ application therefor in writing to the commissioner
 “ of patents, and shall file in the patent office a written
 “ description of the same and of the manner and pro-
 “ cess of making, constructing, compounding and using
 “ the same in such full, clear, concise and exact terms
 “ as to enable any person skilled in the art or science
 “ to which it appertains or with which it is most nearly
 “ connected, to make, construct, compound, and use
 “ the same; *and in case of a machine he shall explain*
 “ *the principle thereof and the best mode in which he*
 “ *has contemplated applying that principle so as to dis-*
 “ *tinguish it from other inventions; and he shall par-*

“particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery.”

According to the italicized portion of the above section, it would appear that the inventor must claim his invention in the form shown and illustrated. If the particular part he claims is designated by a letter, then he can claim it by such letter. In that way he would “particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery.” He might likewise claim it by the particular name or designation which he has applied to it in his specification. But in both cases, if his invention is a pioneer one, he would be entitled to a broad and liberal doctrine of equivalents.

But however that may be, as an abstract proposition of law, it is too well settled to admit of question that the use of reference letters or figures in a claim for a pioneer invention does not necessarily operate as a limitation, although the rule is different in the case of a claim for a narrow invention.

This point of law was considered by the court of appeals of the sixth circuit in the case of *McCormick Harvesting Mch. Co. vs. Aultman et al.*, 69 Fed. Rep., 393. There the claims in question used reference let-

ters, but that was held to be no limitation, in view of the pioneer character of the invention.

In an elaborate opinion rendered by Judge Taft it was said concerning these claims:

“ It is further pressed upon the court that the mere
“ fact that the claims of the Gorham patent are ex-
“ pressed by reference to the lettered parts of the ma-
“ chine, as shown in the drawings, must lead to a literal
“ and formal construction of the claims, and limit their
“ scope exactly to the form of the device used and sug-
“ gested by Gorham. This was the view of the learned
“ justice who delivered the opinion in the court below,
“ and he cited the cases of *Weir vs. Morden*, 125 U. S.,
“ 106, and *Hendy vs. Iron Works*, 127 U. S., 375, in
“ support of his conclusion. We are unable to concur
“ in this application of those cases. They did not in-
“ volve pioneer or even meritorious patents. They
“ were for devices which were at the best mere im-
“ provements on previous well known devices, and, no
“ matter what the claims had been, they would have
“ been limited to the particular forms therein describ-
“ ed. In the latter case, the court found that there was
“ no invention or patentability in the elements claimed
“ and, as an additional reason for holding the patent
“ invalid, suggested that the element claimed was link-
“ ed in combination with a particular form of cylinder
“ by letter reference to the drawings, and, therefore, in
“ such a case, the combination was limited to the par-
“ ticular character of the cylinder. Certainly neither
“ of these cases established a hard and fast rule that
“ where a patentee claims a combination of certain ele-

“ments shown in his patent, describing them by refer-
 “ence letters in the drawings, he thereby deprives him-
 “self of the benefit of the liberal doctrine of equivalents
 “applicable to pioneer patents, if otherwise he is en-
 “titled to its application. See *Delemater vs. Heath*,
 “20 U. S. App., 14, 7. C. C. A., 279, 58 Fed., 414.
 “Whether he specifically claims in his patent the
 “benefits of equivalents or not the law allows
 “them to him according to the nature of his
 “patent. If it is a mere improvement on a
 “successful machine, a mere tributary invention,
 “or a device the novelty of which is con-
 “fined by the past art to the particular form shown,
 “the range of equivalents is narrowly restricted. If it
 “is a pioneer patent with a new result, the range is very
 “wide, and is not restricted by the failure of the
 “patentee to describe and claim the combinations of
 “equivalents. Nothing will restrict the pioneer paten-
 “tee’s rights in this regard save the use of language in
 “his specifications and claims which permits no other
 “reasonable construction than one attributing to the
 “patentee a positive intention to limit the scope of his
 “invention in some particular to the exact form of the
 “device he shows, and a consequent willingness to
 “abandon to the public any other form, should it be
 “adopted and prove useful. Instances of such a limi-
 “tation may be found in *Keystone Bridge Co. vs. Phoe-*
 “*nix Iron Co.*, 95 U. S., 274, and in *Brown vs. Manu-*
 “*facturing Co.*, 6 U. S. App., 427, 16 U. S. App., 234,
 “6 C. C. A., 528, 57 Fed., 731. But there is no such
 “limitation in the patent under discussion, and the rule
 “applies which was so fully explained in *Winans vs.*
 “*Denmead*, 15 How., 330, where the court said:

“ ‘Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportion may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words.’ ”

The syllabus of the case on this point is as follows:

“ The mere use of reference letters in the claims of a combination patent does not of itself, where the invention is really of a primary and pioneer character, limit the scope of the claims to the exact form shown. On the contrary, nothing will restrict a pioneer patentee’s rights, save the use of language in his specifications and claims which permits of no other reasonable construction than that he positively intended to limit the scope of his invention to the particular form shown, thus indicating a willingness to abandon to the public any other form.”

The question was again examined by the court in the case of *National Hollow Brake Beam Co. vs. Interchangeable Brake Beam Co.*, 106 Fed. Rep., 714, where the claim under discussion uses numerals in designating certain elements.

In the opinion rendered by Judge Sanborn it is there said:

“ Finally it is said that the patent is limited to the precise geometrical form of end caps shown in the specification and drawings, by the fact that the figure

“8’ appears after the words ‘end caps’ in the claim.
 “There are cases wherein the form of a device is the
 “principle of the invention. There are other cases
 “wherein the state of the prior art and the specific
 “terms of the specification and drawings leave no
 “doubt of the intention of the applicant to restrict his
 “claim to the specific form of the device or element he
 “points out. In such cases claims of patents are some-
 “times limited to the specific forms of the devices
 “pointed out by letters or numbers in the claims or
 “specifications. (*Weir vs. Morden*, 125 U. S., 98, 107;
 “*Railroad Co. vs. Kearney*, 158 U. S., 461, 469; *Craw-*
 “*ford vs. Heysinger*, 123 U. S., 589; *McCormick Har-*
 “*vesting Mach. Co. vs. Aultman, Miller & Co.* (C.
 “C.), 58 Fed., 773; *Newton vs. Manufacturing Co.*,
 “119 U. S., 373; *Bragg vs. Fitch*, 121 U. S., 478; *Dry-*
 “*foos vs. Wiese*, 124 U. S., 32; *Hendy vs. Iron Works*,
 “127 U. S., 370, 375). But this is not a case of that
 “character. The form of the caps and the specific me-
 “chanical devices by which they should be locked with
 “the brake-head and brake beam were immaterial to
 “the principle of this invention. Caps of many forms,
 “many obvious mechanical devices for fastening them
 “to the compression member, the brake-heads and the
 “brake beams, and preventing these elements from ro-
 “tating upon each other, would perform the same
 “function in the combination of the patentee as those
 “which he pointed out. The specification, the draw-
 “ing, and the claim show that the patentee was not
 “ignorant of this fact, nor of the law by which this pat-
 “ent must be interpreted. He never claimed the form
 “of his caps as a part of his invention. He never de-
 “scribed in his specification or drawing as an essential

“ part of his invention or of the caps themselves, those
 “ peculiarities in the caps by the omission of which the
 “ appellee seeks to escape infringement.

“ The description in a specification or drawing of
 “ details which are not, and are not claimed as, es-
 “ sential elements of a combination, is the mere point-
 “ ing out of the better method of using the invention.
 “ (*City of Boston vs. Allen*, 91 Fed., 248, 249, 33 C. C.
 “ A., 485, 486). A reference in a claim to a letter or
 “ figure used in the drawing and in the specification
 “ to describe a device or an element of a combination
 “ does not limit the claim to the specific form of that
 “ element there shown, unless that particular form was
 “ essential to, or embodied the principle of, the im-
 “ provement claimed. (*Sprinkler Co. vs. Koehler*, 82
 “ Fed., 428, 431, 27 C. C. A., 200, 203, 54 U. S. App.,
 “ 267, 272; *McCormick Harvesting Machine Co. vs.*
 “ *Aultman, Miller & Co.*, 69 Fed., 371, 393, 16 C. C.
 “ A., 259, 281, 37 U. S. App., 299, 343; *Muller vs. Tool*
 “ *Co.*, 77 Fed., 621, 23 C. C. A., 357, 47 U. S. App.,
 “ 189; *Delemater vs. Heath*, 58 Fed., 414, 424, 7 C. C.
 “ A., 279, 284, 20 U. S. App., 14, 30; *Reed vs. Chase*
 “ (C. C.), 25 Fed., 94, 100; *Walk. Pat.* (3d Ed.), Sec.
 “ 117a). That interpretation which sustains and vitil-
 “ izes the grant should be preferred to that which
 “ strikes down and paralyzes it. (*Reece Button Hole*
 “ *Mach. Co. vs. Globe Button Hole Mach. Co.*, 61
 “ Fed., 958, 962, 10 C. C. A., 194 198, 21 U. S. App.,
 “ 244, 363; *Consolidated Fastener Co. vs. Columbian*
 “ *Fastener Co.* (C. C.), 79 Fed., 795-798; *American*
 “ *Street Car Advertising Co. vs. Newton Street*
 “ *Railway Co.* (C. C.), 82 Fed., 732, 736; *McSherry*
 “ *Mfg. Co. vs. Dowagiac Mfg. Co.*, 41 C. C. A., 627,

“ 101 Fed., 716, 722). One who appropriates a
 “ new and valuable patented combination cannot es-
 “ cape infringement by uniting or operating its ele-
 “ ments by means of common mechanical devices
 “ which differ from those which are pointed out for
 “ that purpose, but which are not claimed in the patent.
 “ (*Deering vs. Harvester Works*, 155 U. S., 286, 302;
 “ *City of Boston vs. Allen*, 91 Fed., 248, 249, 33 C. C.
 “ A., 485, 486; *Schroeder vs. Brammer* (C. C.), 98
 “ Fed., 880).”

And the syllabus of the case on this point is as follows:

“ A reference in a claim of a patent to a letter or figure used on the drawing and in the specification to describe a device or an element of a combination does not limit the claim to the specific form of that device or element there shown, unless the particular form was essential to, or embodied the principle of, the improvement claimed.”

Other cases deciding this point are:

Sprinkler Co. vs. Koehler, 82 Fed. R., 428.

Muller vs. Tool Co., 77 Id., 621.

Delemater vs. Heath, 58 Id., 414.

Reed vs. Chase, 25 Id., 94.

In view of the rule of law announced in the cases cited, it follows that the stop called for by Jensen's claim 1 is not necessarily limited to “the stop E”—that

is to say, to a stop consisting of a stationary bar, but includes and covers any and all forms of stop which perform the same function in the same manner. That function is "to change the direction of the cans," and this function is performed by the Letson & Burpee stop, which consists of a skeleton wheel.

The Jensen claim 1 must be construed as though it read as follows:

"An endless traveling carrying-belt, *a device* extending across it to change the direction of the cans, and arms swinging over the belt, whereby the delivery of the cans from the belt to the feeder is rendered exact, substantially as herein described."

Such is the real scope of the invention covered by the claim, and if it had been so worded, even the technical and learned counsel for defendants could have urged nothing against it.

Of course we recognize the fact that the *particular form* of stop shown in the Jensen drawings is different from that of Letson & Burpee. The first is a bar extending across and above the carrying belt; the second is a skeleton wheel rotating across and above the carrying belt. But both of them perform the same function of stopping or arresting the further forward movement of the cans and changing their direction by

interposing an obstacle in the path of the cans. To that extent they are mechanical equivalents, in view of the primary character of the Jensen invention.

But it may be urged that the Letson & Burpee "wheel 36" does more than to stop the forward motion of the cans, in that it also acts as a feeder to sweep the cans from the belt and convey them to the capper, whereas in the Jensen patent a separate device is used as the feeder. This contention in no way affects the question at issue. It matters not how many other functions the defendants' wheel 36 performs, so long as it performs the function of Jensen's stop E. It may be an improvement over Jensen, may operate as a better device, but still the fact remains that it is a stop, a device to change the direction of the cans.

Mr. Robinson, at Sec. 251 (Vol. I) of his work on patents, says: "Again, equivalence is not affected by "the fact that the new element performs in the invention some function in addition to the old"; and in *Atlantic Giant Powder Co. vs. Goodyear*, 3 B. & A., 161, it is said by Judge Sprague that "the books are full "of such cases."

It is not infrequently the case that an infringing device is an improvement on the patented structure. That is the excuse usually advanced by the infringer as a palliation for his wrong-doing, but a patented in-

vention cannot be appropriated by an infringer merely by adding improvements thereto. Said the supreme court in *Burt vs. Ivory*, 133 U. S., 358:

“ A new idea may be ingrafted upon an old invention, be distinct from the conception which preceded it, and be an improvement. In such case it is patentable. The prior patentee cannot use it without the consent of the improver, and the latter can not use the original invention without the consent of the former.”

A perfect illustration of this doctrine is found in the two cases of *Clough vs. Barker*, 106 U. S., 166, and *Clough vs. Manufacturing Co.*, 106 U. S., 178. Clough's second claim covered the combination of a regulating valve with a perforated bat-wing burner and surrounding tube in a lamp. He was the first in the art to apply a valve arrangement of any kind in such combination. Hence he was a pioneer, and his claim was broadly construed to cover all valve regulations, whatever might be their form of construction, in such a combination.

The defendant had secured a subsequent patent, showing *a specific form* of valve regulation in such a combination, which form was different from that of Clough. Yet it was held to be an infringement, and in

the first of the two cases cited Clough was awarded an injunction.

It appears, however, that the defendant's subsequently invented specific form of valve regulation was better than the form shown in the Clough patent, and Clough began to use the same. Thereupon the defendant in the first case sued Clough and secured an injunction preventing him from using said specific form. Thus we see that Clough enjoined Barker from infringing the Clough patent for the pioneer invention, and Barker enjoined Clough from infringing the Barker patent for the improved form.

And so here, the Jensen device is a *genus* invented by Jensen; the Letson & Burpee device is a particular *species* of that genus invented by Letson & Burpee. Neither one can infringe upon the other. Jensen cannot use the Letson & Burpee device, although such device is an infringement of his patent. Letson & Burpee cannot use their own device, because it is an infringement of the Jensen patent. This is a well recognized principle of patent law and was fully discussed and passed upon in the case of *Bowers vs. Von Schmidt*, hereinabove referred to.

It is applicable to the case in hand. Jensen made a generic invention; Letson & Burpee, eleven years af-

terwards, made an improvement thereon, consisting of a new species, exhibiting the basic principle of Jensen's, but differing in details of mechanism. But this subsequent invention is subordinate and subject to the Jensen.

The lower court found against us on this claim 1 and we submit that such ruling was error.

INFRINGEMENT OF CLAIM 3.

3. *In combination with a transverse belt, the feeder having projecting arms, between which the cans are received from the belt, and the actuating devices by which the motions of the feeder are produced, substantially as herein described.*

This claim contains no reference letters. Its language is broad and generic, and ought to satisfy the most hypercritical. Its elements are: (1) The belt; (2), the feeder; (3), actuating devices, forming a combination covering a primary invention. Like claim 1, it is for a sub-combination, relating only to the disposition of the cans prior to the capping operation; but it is broader than claim 1.

The Letson & Burpee machine contains all the elements of this claim 3, combined together in substantially the same manner and accomplishing the same re-

sult, viz: *the automatic delivery of filled cans to the capping mechanism.*

The first element, a transverse belt, is certainly found in the Letson & Burpee machine.

The second one, the feeder having the projecting arms between which the cans are received from the belt, is likewise found in the Letson & Burpee machine, though in a slightly different form from that shown in the Jensen drawings.

For convenience we herewith reproduce the two feeders and show them on adjoining page.

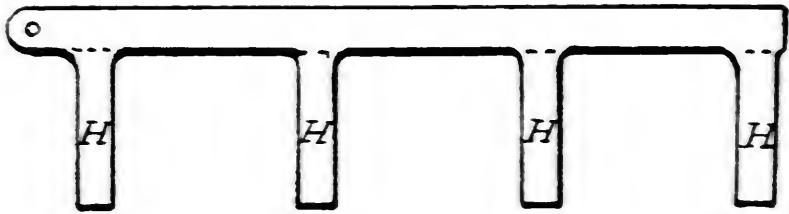
In the Jensen device the can is received between the arms HH, and by them carried away to the capping mechanism.

In the Letson & Burpee device the can is received in the recess C, between the parts lettered HH, and by them carried away to the capping mechanism.

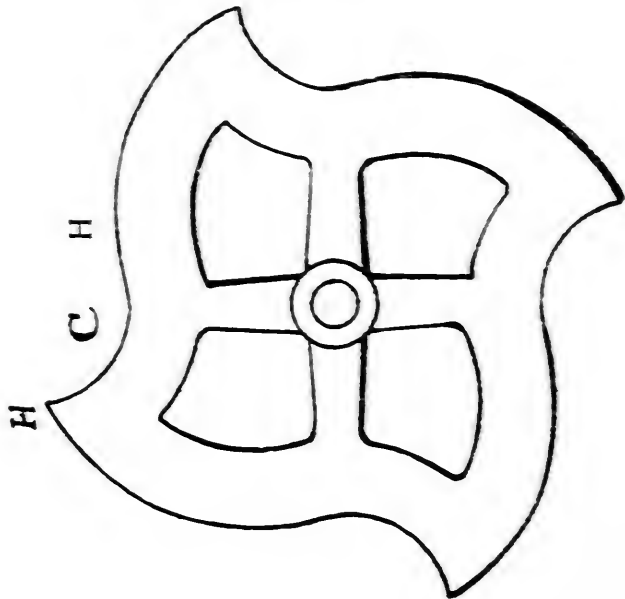
Those parts are essentially "projecting arms between which the cans are received." Plainly, they are mechanical equivalents of Jensen's arms. In both devices the can is caught between these arms and by "a circular sweeping" motion removed from the belt to the capping mechanism.

It is no answer to say that defendant's feeder is circular in form, while Jensen's is rectangular, and that

Jensen Feeder.

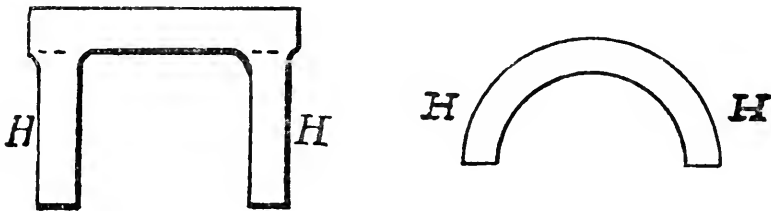


Letson & Burpee Feeder.



the can receptacles in Jensen's are square, while those of Letson & Burpee are round.

For the purposes of still further elucidation, cut out one of the recesses in the Jensen feeder and one of the recesses in the Letson & Burpee feeder, and place them side by side. They will present substantially the following forms:



The sole and only difference between the two devices is one of form. One is square, while the other is semi-circular. This does not effect any change of function. Jensen's might as well have been semi-circular and Letson & Burpee's might as well have been square. No different function would have been effected. Change the recess in Jensen's feeder to a semi-circular form, and it will act precisely as before. Change Letson & Burpee's to a square, and it also will act as before. Form is not of the essence of the device.

Authorities are not wanting on this precise point. Thus, in *Brush vs. Condit*, 132 U. S., 39, it was held

that a square clamp for a carbon rod in an electric lamp was the equivalent of a circular clamp.

In *Electric Co. vs. Julien*, 38 Fed. Rep., 145, it was ruled by Judge Coxe, as follows:

“Neither can there be anything patentable in the mere shape of the holes. A patent for a device containing round holes will preclude a subsequent patent for the same device with square or triangular holes.”

Similar rulings were made in *U. S. Bunging Co. vs. Independent B. & B. Co.*, 31 Fed. Rep., 79. and *Moore vs. Clay*, 65 Fed. Rep., 526.

The formal difference between the Jensen and Letson & Burpee feeder is that one has *square*, while the other has *round* receptacles (holes) for the cans.

Nor is it any defense to contend that the Jensen feeder has an elliptical motion, while the Letson & Burpee feeder has a true circular motion, because the claim does not call for any particular kind of motion, and each of the kind referred to is within the language of the claim.

The remaining element of claim 3 is “the actuating devices by which the motions of the feeder are produced.”

Both feeders have actuating devices which produce “a circular sweeping motion,” and that is all that is

required. We admit a difference in form and details, but the claim calls for no particular form. It includes and covers any and all forms of mechanism, which will impart to the feeder "a circular sweeping motion," and it is utterly immaterial whether that motion be truly circular or elliptical. Indeed the motion of defendants' feeder is strictly within the literal language of Jensen's patent. It is there said: "These cranks have vertical shafts, which are journaled in the frame, and power is applied to move them, so that they produce *a circular sweeping motion* of the feeder or carrier and forked arms. By this motion the cans are moved across the table."

What language could be adopted which would more accurately apply to the motion of Letson & Burpee's feeder?

Concerning this claim, defendants' counsel says at page 71 of his brief:

"To make any pretense that the defendants' machines or any of them infringe the foregoing claim is as monstrous as it is absurd and ridiculous."

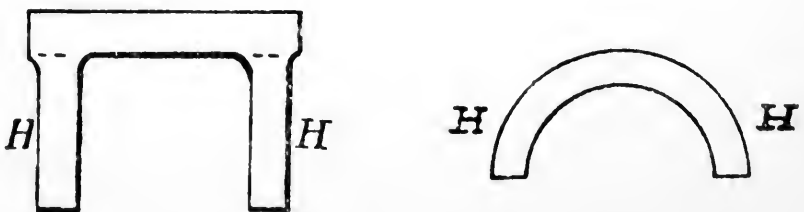
Other language of similar import is found scattered throughout his brief, and the opinions given by our experts are characterized as "so manifestly absurd that no court would give them any serious consideration."

Such language, we venture to remark, is out of keeping with the dignity of the occasion. It may possibly be intended to bolster up a weak defense, but certainly cannot be taken as evidence of a strong one. It is neither courteous to opposing counsel, nor fair to the court.

Immediately following it, on page 71, are given the reasons for asserting that there is no infringement of this claim 3. It is there said:

“There is no feeder having the projecting arms between which the cans are received from the belt in the defendants’ machine, and never has been.”

In answer, we assert that there is in said machines a feeder, consisting of the wheel 36; that this wheel has semi-circular recesses in its periphery, into which the cans are received, and the projecting walls or sides of these recesses are the mechanical equivalents of the projecting arms of the Jensen feeder, because both devices perform the same function, to wit: acting as receptacles for the cans, and in the same way, to wit: by partially enclosing the cans. We again reproduce here cuts of the two receptacles, viz:



Will the counsel assert that these two figures are not mechanical equivalents?

It is next said on page 71 of said brief: "No device " or devices of the defendants' machine performs the " operation that the feeder F performs, or that has its " motions produced by the actuating devices that pro- " duce the motions of feeder F."

In answer to the first clause of the above sentence, we contend that the operation of the feeder F is simply to transfer the cans from the belt to the capping mechanism. It is a *carrier*, nothing else. Indeed, the patent calls it " the feeder or "*carrier F.*" That is the sole object, the sole function of the Feeder F. Now it would indeed be a bold man who would assert that the Letson & Burpee feeder 36 does not perform that identical function. *That is exactly what it does do.* Hence, it is easy to see the fallacy of counsel's assertion that "no " device or devices of the defendants' machine performs " the operation that the feeder F performs."

Concerning the second clause of the counsel's sentence quoted *supra*, viz: "or that has its motions pro- " duced by the actuating devices that produce the mo- " tions of feeder F," we freely admit that the specific form of actuating mechanism of Jensen is different from that of defendants. But that fact is of no mo-

ment. Jensen lays no claim to invention in the form of his actuating mechanism. Such form is no part of his invention. It was old in the art before him. He devised a feeder or carrier for transferring the cans from the belt to the capping mechanism by "a circular sweeping movement." An actuating mechanism was necessary therefor. He found such mechanism old in the art and used it. He might have used other forms, if he had so desired. His claim calls generally for "actuating devices," and any and all forms which will produce "a circular sweeping motion of the feeder," are within its purview.

Will the learned counsel say that the Letson & Burpee feeder wheel 36, has not a circular sweeping motion, or that it has not "actuating devices" for producing such motion? If not, he cannot deny infringement of claim 3. That claim covers broadly the combination with a transverse belt of *any* kind of feeder, which has projecting arms and a circular sweeping motion, and *any* kind of actuating devices which will produce such circular sweeping motion. *The reason for this is that such a combination was absolutely new in the art, and defines accurately the scope of the actual invention made by Jensen.* This brings the case directly within the ruling of *Morley Machine Co. vs. Lancas-*

ter; and in view of so exalted an authority as the highest court in the land, will the learned counsel still insist that our charge of infringement of claim 3, "is as monstrous as it is absurd and ridiculous"?

INFRINGEMENT OF CLAIM 5.

5. *The inclined chute into which the caps are placed and a stop extending across said chute, so as to prevent the caps from moving downward, in combination with a trigger extending across the path of the cans, as they are moved toward the capping table, said trigger being connected with the stop, so that as it is moved backward by the passage of the can, it withdraws the stop to allow a cap to move down the chute, substantially as herein described.*

This is a broad and comprehensive claim covering a pioneer invention of remarkable ingenuity and undoubted merit. The essence of the claim consists in the releasing of the caps by the can itself so that each can automatically supplies its own cap. Prior to Jensen this had never been done, but the caps had been always supplied by hand. This claim is the first in the history of the art where the can, by its own motion, au-

tomatically releases from a collection of caps, its own particular cap, ready for the capping operation.

The elements of the claim are, (1) a cap-carrying chute; (2) a stop extending across the chute to regulate the movement of the caps; (3) a trigger in the path of the cans; (4) connecting mechanism between the trigger and the stop, all so combined and arranged that the can pulls the trigger, and thereby the stop is released and a cap moves down the chute towards the capping mechanism to be applied to the particular can which has released it. When the released cap reaches the bottom of the chute, a forked arm or finger, designated in the patent by the letter "V," and operated by an ingenious mechanism of levers, cams, toggle joints, etc., not necessary to be described here, reaches forward and rakes the can cap into the capping mechanism and there places it in its proper position immediately above the can to be headed. The operation of this forked arm "V" resembles very much the operation of a human hand, and, indeed, the operation of this combination of claim 5, whereby each can releases its own cap, seems almost to partake of human intelligence. It certainly is one of the most ingenious pieces of mechanism we have ever been called on to examine, and illustrates and embodies an idea entirely original with Jensen. Nor can there be any question as to its utility. It acts with

the precision of clock-work, and as long as the machinery is in good order, it is impossible for it to make a mistake. This claim is beyond all peradventure of a doubt a claim for the broadest and most pioneer of inventions. There is nothing in the prior art resembling it in the remotest degree. It performs a function which in every respect is entirely new and was original with Jensen. This is admitted by defendants.

Under these circumstances, the claim is entitled to the broadest and most liberal construction ever given to any claim. It is not confined to the form of the particular elements which go to make up the combination, but covers all other devices which would be mechanical equivalents thereof in the broadest sense of the term.

The defendants' device which is charged to be an infringement of this claim will be clearly seen from the cut opposite page 93 of this brief. It shows a trigger in the path of the cans, stops or fingers in the path of the caps, and a connecting mechanism between the trigger and the stop whereby each can automatically releases its cap. It does not show the "inclined chute in-
" to which the caps are placed," but does show an endless-traveling belt for carrying the caps. In other words, Letson & Burpee have substituted for the chute a carrying belt, and the sole and only question for consideration is, whether or not a cap-carrying belt is

the mechanical equivalent of a cap-carrying chute. If these two devices are mechanical equivalents, then clearly the claim is infringed. Whether or not they are mechanical equivalents depends upon the scope of the claim. If the claim is for a pioneer invention, then the broadest possible doctrine of mechanical equivalents is applicable; and under the decisions heretofore cited, and under that doctrine, there can be no escape from the conclusion that the two devices are mechanical equivalents. That the claim is for a pioneer invention cannot be denied. It has not been denied heretofore by defendants, nor by any one else, so far as we are aware; and even if it were denied, the state of the art shows beyond all question that the claim does cover a pioneer invention.

But let us consider the matter on its merits, without regard to the pioneer character of the invention. The function of Jensen's chute is to operate as a receptacle for a column of caps and allow only one at a time to be released and delivered to another mechanism, which carries it to the capping device. This is the sole and only function of the Letson & Burpee belt. That belt acts as a receptacle for a column of caps and delivers said caps to another mechanism, which carries them to the capping device. If any other function is performed

by the belt, we have failed to discover it. None has been suggested by counsel, and we may, therefore, assume that we are correct.

It is true that in the case of a chute the caps move down its surface by gravity, while in the case of the belt the caps are moved by mechanism; but this is not a material difference in the mode of operation. That stationary chutes and moving belts, as delivering devices, are interchangeable and the equivalents of each other in this and other arts, cannot be denied. The proposition is too apparent for serious doubt and the evidence fully sustains us in this contention.

On this subject the expert witness, Monteverde, testified as follows: "I have seen, if I am not mistaken, " both cans and heads fed by means of chutes and belts. " It is a well-known device. * * * The feeding by " means of a belt is old; it is not new; it is very old in " the art, and it certainly is almost identical with feed- " ing by means of a chute. The object attained is the " same, and in mechanics it would be considered an " equivalent and the one would be used in preference " to the other, mainly in cases where, for convenience, " the preference would be given to one or the other of " them.

" X. Q. 178. What do you mean when you say that " feeding by a belt is old?

“ A. Feeding anything by a moving belt, feeding cans, feeding heads, feeding ores, feeding coal—feeding anything.” (Dep. Monteverde, p. 164.)

The expert witness, Seely, testified that a cap-carrying belt is “a well-known and equivalent means for accomplishing the same result” as an inclined chute. (Rec., p. 199.)

The defendant Burpee testified that in the arts he found both chutes and belts used as conveyors in a great many instances; that in some instances chutes could be used to better advantage, while in others belts were preferable, dependent upon the circumstances, adding, “they were both well-known for carrying purposes.” (Dep. of Burpee, Rec., p. 386.)

The defendants have furnished another piece of evidence, which, we think, conclusive.

While prosecuting their application for their patent in the patent office, they endeavored to obtain claims for a combination in which a carrying belt for delivering the cans after being capped was one of the elements, which combination differed from prior combinations in the art only in the substitution for such a belt of an inclined chute. Their claims for such combination were rejected by the patent office on the ground that carrying belts were well known mechanical equiv-

alents for inclined chutes and that the substitution of the belt for the chute was no invention. They acquiesced in this action of the patent office, and cancelled the claims, or amended them to meet the ruling of the office.

To be exact in this matter, the file-wrapper of the Letson & Burpee patent shows that they originally asked for two claims, designated as 18 and 20, which read as follows:

“ 18. In a machine of the class described, having
 “ a rotatable table with contractible openings therein
 “ and can supports below such openings and cap-seats
 “ within the same, means for simultaneously deposit-
 “ ing a can on one of the seats below the opening and
 “ a cap into its seat above the same, and of pressing the
 “ cap downward while the can is being pushed upward
 “ and for releasing and delivering the same to a belt
 “ 73, as set forth.

“20. In combination with a rotatable table having
 “ contractible openings therein and reciprocating disks
 “ above and below such openings, and reciprocating
 “ plates on each side thereof, means for placing a cap
 “ on said plates over one of the openings while the open-
 “ ing is contracted, and for placing a can on one of
 “ the reciprocating support disks beneath such open-
 “ ing and forthwith drawing the plate from beneath
 “ the cap and for pressing such cap downwards while
 “ the can is being driven upwards into the same, and
 “ means for expanding said opening and delivering the

“can to a delivery belt 73, as and for the purpose set forth.”

It will be seen from the foregoing that Letson & Burpee proposed to use an endless traveling belt for carrying away the cans after they had been capped.

Under date of July 20, 1898, the patent office rejected these two claims in the following language:

“Claims 18 and 20 are rejected on 382530, May 8, 1898, Leavitt, Sheet Metal Ware Making, Vessels, Die Seaming; and 443445, above cited,” (December 23, 1898, Jensen, Sheet Metal Ware Making Vessels, Roller Seaming).

In answer to this rejection, Letson & Burpee, on November 2, 1898, filed in the patent office an argument as follows:

“A reconsideration of claims 18 and 20 is asked for the reason that they set out a specific construction, which is not shown by the references. Should the examiner still consider the references pertinent, he is respectfully requested to apply the same more fully.”

In answer to this argument the examiner again rejected the claims in a communication, dated November 29, 1898, in which he said:

“Claims 18 and 20 are each rejected on the references of record cited against these claims. Leavitt shows a table having contractible openings, a can support above and below such openings, and cap seats within the same and means for pressing the can and the cap together and means for releasing the same. *Jensen* shows the same, with also a rotatable table and chute; there is no invention in substituting a belt for a chute, since belts and chutes were commonly used in the art.”

Letson & Burpee acquiesced in this ruling and amended their proposed claims, so as to meet the views of the examiner.

The result of the above-quoted proceedings is to estop Letson & Burpee from now claiming that an endless carrying belt for delivering cans is not the mechanical equivalent of an inclined chute for delivering cans.

The Jensen patent on which the rejection was based is not the Jensen patent in suit, but is another patent of Mr. Jensen's, covering a can-capping machine, which he subsequently devised as an improvement upon the original invention, and the same is fully described and set forth in the case of *Norton vs. Jensen*, 90 Fed. Rep., 415, where it was held by the court of appeals that the said improved device of Jensen was not an infringement upon the Norton patent. By reference to that patent, as shown in the report of the case, it will be

seen that Letson & Burpee obtained the fundamental idea of a continuous machine from Jensen's improved machine, there shown. It is a continuously operating device, but is subservient to the original patent. Said second Jensen patent also shows a gang of rotary plungers and a stationary cam for operating them substantially as shown in Letson & Burpee's patent. Doubtless it is from that source that Letson & Burpee got their ideas.

It is too late now for Letson & Burpee to contend that a delivery belt is not the mechanical equivalent of a delivery chute. Their action in the patent office conclusively estops them from making such contention. The examiner plainly told them that there was "no invention in substituting the belt for the chute, since delivery belts and chutes are commonly used in the art." In other words, he told them that the two devices were mechanical equivalents. They deliberately acquiesced in this ruling and took their patent with that understanding. The rule of law applicable to such cases is too well settled to require further elaboration, and we content ourselves with merely citing the authorities which sustain it:

Hubbell vs. U. S., 179 U. S., 77.

Morgan vs. Albany, 152 U. S., 425.

Fay vs. Cordesman, 109 U. S., 408.

Sargent vs. Lock Co., 114 U. S., 63.

Sheppard vs. Carrigan, 116 U. S., 593.

Leggett vs. Avery, 101 U. S., 256.

Vulcanite Co. vs. Davis, 102 U. S., 202.

Mahn vs. Harwood, 112 U. S., 354.

Wheaton vs. Norton, 70 Fed. Rep., 833.

Phoenix Castor Co. vs. Spiegel, 130 U. S., 368.

Yale Lock Co. vs. Berkshire Bank, 135 U. S.,
379.

Dobson vs. Lees, 137 U. S., 258.

In the testimony given by the defendant Burpee, concerning this claim, an effort is made to show that it is of little value, and he states that the defendants' machine would work as well without the stops extending across the path of the caps, provided the machine be kept filled all the time with cans and caps, and he states that some of his machines had been operated without the stops. If this is true, then the infringement is without the shadow of an excuse. If the device in question is useless, and the defendants' machine can be used just as well without it, then the use of it by the defendants cannot be condemned in language too severe, and it passes our comprehension to understand the motive which calls forth such testimony.

But in his contention as to the want of utility of this device, the defendant Burpee is contradicted by his own patent. On page 4, beginning at line 111 of the specification in the Letson & Burpee patent, we find the following language:

“And now comes one of the most important features of our machine. As a can is pushed around within the arc 63, it will contact with the fixedly-disposed arms of the bracket 86, pivoted on a stem 87a (see Fig. 5), and by reason of such arms projecting in the path of the cans, each can that passes will cause a rigidly fixed arm 88, on the top of the said bracket, to rock forward and back. A coupling connection 89 causes movement to be imparted to the spacing mechanism 90, which is adjustably fixed to the projecting lug 91, on the cap-table 38. It will thus be seen that each can releases its own cap—as, for instance, when a cap B engages the bracket 86, a cap A will be released, and as the next recess in the wheel 36 contains said can, the released cap will take the seat in the cap-feed wheel 37, directly over such can, and consequently, the can and cap will be transferred to their respective positions beneath and on the table 20.

“The spacing mechanism 90 is a duplicate of the device 75, which reverses to engage the caps coming the opposite way.”

In view of this statement in the defendants' patent, it is rather late in the day for them to contend that the

device in question is of no utility. They thought it was of very great utility when they were seeking to secure their patent. The statement that they then made on the subject is entitled to more credit than the one which they are now making, and we think the court will be justified in concluding that this device is a most valuable one.

The answer which the learned counsel for defendants makes in his brief to our charge of infringement of this claim 5 appears to us weak. At page 74 of his brief he says:

“The fundamental foundation device in this combination is the inclined chute. Without this inclined chute for the can heads the remainder of the mechanism would be entirely useless.”

These statements are unsupported by the evidence. The inclined chute is not “the fundamental foundation device in this combination. Nor is it true that without this chute “the remainder of the mechanism would be entirely useless.” That we are correct in this position is clearly shown by the fact that a belt can be substituted for the chute, and has been so substituted by the defendants. It is possible to conceive also of other cap-delivering devices which might be substituted. A rotating table might be used for the purpose, and was

used by Jensen in his second patent, being the one involved in *Norton vs. Jensen*, 90 Fed. R., 415. A similar device was used in the old Jordan machine. So long as such devices operate as a receptacle for the caps, and allow only one to be delivered at a time, they would be equivalents for the chute and could be substituted therefor. This element of an inclined chute in claim 5 is commensurate with any device which acts as a receptacle for the caps in mass and allows only one to be delivered at a time. There are various devices in the art which could be used for that purpose, and Jensen selected one of them, to wit, the chute, as the one which he considered to be the best for the purpose. He might have selected any other, and his claim is broad enough to include any other.

On page 75 of his brief, the counsel argues that this Jensen chute is very defective in many particulars, and he undertakes to point out one particular where he says it is defective. But this is utterly immaterial to the point under investigation. The chute certainly does perform the function which Jensen had in mind, and if it be true that other devices would perform that function in a little better way, he is not, for that reason, to be denied the broad construction of his claim which the law says he is entitled to.

At another place in his brief, the counsel argues that

a delivery belt could not be substituted in the Jensen machine for the chute, and that a chute could not be substituted for the belt in the Letson & Burpee machine, and from this argument he concludes that the two devices are not mechanical equivalents. But in that contention he is in error. It would be perfectly practicable to substitute a delivery belt for the chute in the Jensen machine, and it would not require the exercise of inventive genius to make the substitution. Nothing more than the skill of the mechanic would be required. In case of such substitution it may be true, though we are not quite sure of that, that it would be necessary to change the Jensen mechanism of the forked arm V, for carrying the released cap into the capping mechanism; but in that behalf it is to be remarked that said forked arm V is no part of the combination of claim 5. It is an independent device, brought into play after the operation of the combination of claim 5 has been performed. Consequently, if it be true that in substituting the belt for the chute it would be necessary to provide other mechanism in place of the forked arm V, that fact is utterly immaterial to the point in hand.

It is equally apparent that in the Letson & Burpee machine an inclined chute might be substituted for the belt. It may be true in that case that a different device

would be required for carrying the released cap into the capping mechanism. That is to say, the cap-feeding wheel might have to be changed to some other device; but that fact is utterly immaterial, just as was the case supposed above of the substitution in the Jensen machine of some other device for the forked arm V.

Even the defendant Burpee himself testified that it would not be impossible to substitute a chute for the belt in his machine. (Deposition of Burpee, Rec., 397-8.) In this he was clearly right, for it requires but small knowledge of mechanics to see that such substitution could be made. Both devices were old in the art, and were interchangeable one for the other. Sometimes a chute was used; sometimes a belt. In the words of Mr. Burpee himself: "They were both well known for carrying purposes," and that whether one is preferable to another depends upon the particular circumstances of the case. (Deposition of Burpee, Rec., p. 386.)

At pages 75 *et seq.* of his brief, the counsel for defendants refers to the fact that after a cap is released from the Jensen chute, there is an additional and very complicated mechanism for carrying the released cap from the bottom of the chute into the capping mechanism, and that the mechanism in the Letson & Burpee

machine for that purpose, consisting of a cap-feed wheel with recesses in its periphery, is entirely different from the corresponding device in the Jensen patent, consisting of forked arm V with its actuating mechanism, and that the one cannot be substituted for the other. But a moment's reflection must convince him that this is utterly immaterial to the point under discussion. That additional mechanism referred to, which carries the released cap from the bottom of the chute to the capping mechanism, is no part of claim 5. It is not an element in claim 5, and has no more to do with it than the plungers of the capping mechanism or the feeder of the can-carrying mechanism. Such additional mechanism is covered by another claim in the patent, not sued on herein, claim 7. Claim 5 covers the combination only of the chute, the stop, the trigger, and mechanism connecting the two whereby the can releases its own cap. After that operation is performed—that is to say, after the cap has been released from the chute—then the function of the claim in question ceases, and another entirely separate and independent device comes into play and carries this released cap to the capping mechanism. Therefore, it is utterly immaterial whether or not this additional mechanism, which is not covered by claim 5, is different from the

mechanism used for the same purpose in the defendants' machine; and it is utterly immaterial that the one cannot be substituted for the other. We forbear to dwell on the point any longer. It seems too plain for further discussion.

INFRINGEMENT OF CLAIM 9.

9. *The vertically moving plunger upon which the cans are delivered by the feeder, in combination with the conical guide situated above the cans, and the transversely-moving slides upon which the caps are received and held, with a mechanism by which the slides are withdrawn as the can enters the cap, substantially as herein described.*

The elements of this claim are: (1) The vertically-moving plunger or can-seat; (2) the conical guide; (3) the transversely-moving slides or cap-seats; (4) mechanism for withdrawing the slides as the can enters the cap.

The cuts opposite page 27 hereof show the Jensen construction, while the cuts opposite pages 95 and 96 show the Letson & Burpee construction.

The only element about which there can be any contention is "The vertically-moving plunger upon which

the cans are delivered by the feeder." It is contended by defendants that their machine has no such plunger.

This contention is without any merit. The machine has a device marked 19, called in the patent "A cap-seat." It is a circular plate or disc, having a depending vertical stem 18, passing through a bored-out vertical hole in the revolving bracket 14a. That this device is "a plunger" cannot be denied, and it would be idle to waste any time on that proposition. It is contended, however, by defendants, that it is not a *vertically-moving* plunger. The bracket 14a carrying this plunger rotates around the central shaft, and in that rotation the foot of the stem 18 of the plunger passes over the inclined face 46 of a stationary cam 47. It is contended by defendants that the result of this is that the plunger, instead of rising in a true vertical line, as in the Jensen machine, rises upward on an inclined line, so that it is not technically a true vertically-moving plunger. It is admitted to be an *upwardly-moving* plunger. The precise contention is that a plunger moving upward on an incline is not the equivalent of one moving upward in a true vertical line.

The two devices are plainly equivalents. They are both plungers. Both ultimately reach the same point, viz: the capping mechanism. Both carry the can to

that mechanism to be capped. Both remove the can therefrom after it is capped. Neither performs any other function. The only difference suggested is that one travels in a straight vertical path, while the other travels in a straight diagonal path.

At the risk of tediousness we will again call the court's attention to the fact that the Jensen invention is of a primary character, and, therefore, the defendants' construction is the mechanical equivalent thereof. When Jensen specified "a vertically-moving plunger," he did not thereby limit himself to one having an absolutely true vertical motion, but he merely specified that as the best form in which his invention could be embodied. A plunger moving upward in a diagonal line would be within the claim. On this point the authorities are without dissent.

The earliest case by the Supreme Court is *Winans vs. Denmead*, 15 How., 330, where the invention was for an improvement in coal cars. The car-body was made in the form of the frustum of a cone, with a trap-door in the bottom. On withdrawing a bolt, the weight of the coal caused the door to fall, and the entire contents were thereby discharged without further labor. The form of the car-body permitted it to extend down between the wheels nearly to the ground,

thus lowering the center of gravity and increasing the carrying capacity, which was very much further increased by the uniform distribution of pressure resulting from the form of the car-body. The patentee, however, was not happy in the language in which he framed his claim, which was as follows:

“Making the body of a car for the transportation of coal, etc., *in the form of the frustum of a cone*, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions and does not tend to change the form thereof, so that every part resists its equal proportion, and by which also the lower part is so reduced as to pass down within the truck frame, and between the axles, to lower the center of gravity of the load, without diminishing the capacity of the car, as described.”

This claim afforded a loop-hole for the technical evader. It called for the *frustum of a cone*, which is a definite geometric figure. Substantially all of the advantages of the invention could be obtained, however, by substituting for the frustum of a cone the *frustum of a pyramid*, and that is what the infringer did. He had evaded the letter of the claim, because the frustum of a pyramid is no more the frustum of a cone than is a sphere a cube. When charged with infringement, the defendant triumphantly asserted to the patentee: “Your claim calls for the frustum of a cone. I use no

“ cone; I use the frustum of a pyramid. I have escaped
 “ the language of your claim.” The lower court was
 impressed with this specious argument, and adjudged
 that there was no infringement; but the Supreme Court
 reversed the ruling, and Mr. Justice Curtis, speaking
 for that tribunal, said:

“Now, it is undoubtedly true that the patentee may
 “ so restrict his claim as to cover less than what he in-
 “ vented, or may limit it to one particular form of
 “ machine, excluding all other forms, though they also
 “ embody his invention, yet such an interpretation
 “ should not be put upon his claim if it can fairly be
 “ construed otherwise. * * * It is generally true
 “ when a patentee describes a machine and then claims
 “ it as described, that he is understood to intend to
 “ claim, and does by law actually cover, not only the
 “ precise form he has described, but all other forms
 “ which embody his invention; it being a familiar rule
 “ that to copy the principle or mode of operation de-
 “ scribed is an infringement, although such copy should
 “ be totally unlike the original in form or proportion.
 “ Why should not this rule be applied to this case? It
 “ is not sufficient to distinguish this case to say that here
 “ the invention consists in a change of form and the pat-
 “ entee has claimed one form only.

“Patentable improvements in machinery are almost
 “ always made by changing some one or more forms
 “ of one or more parts, and thereby introducing some
 “ mechanical principle or mode of action not previ-
 “ ously existing in the machine, and so securing a new

“ or improved result. And in numerous cases, in
 “ which it has been held that to copy the patentee’s
 “ mode of operation was an infringement, the infringer
 “ has got forms and proportions not described in the
 “ terms claimed. If it were not so, no question of in-
 “ fringement could arise. If the machine complained
 “ of were a copy in form of the machine described in
 “ the specification, of course it would be at once seen
 “ to be an infringement. It could be nothing else.
 “ It is only ingenious diversities of form and propor-
 “ tion, presenting the appearance of something unlike
 “ the thing patented, which give rise to questions; and
 “ the property of inventors would be valueless if it were
 “ enough for the defendant to say: ‘Your improvement
 “ ‘consisted in a change of form; you describe and
 “ ‘claim but one form. I have not taken that, and so
 “ ‘have not infringed.’ The answer is: ‘My improve-
 “ ‘ment did not consist in a change of form, but in the
 “ ‘new employment of principle or powers, in a new
 “ ‘mode of operation embodied in a form by means of
 “ ‘which a new or better result is produced. It was
 “ ‘this which constituted my invention; this you have
 “ ‘copied, changing only the form.’ And that answer
 “ is justly applicable to this patent.

“Undoubtedly there may be cases in which the let-
 “ ters patent do include only the particular form de-
 “ scribed and claimed. *Davis vs. Palmer*, 2 Brock.,
 “ 309, seems to have been one of those cases. But they
 “ are in entire accord with what is above stated.

“The reason why such a patent covers only one geo-
 “ metrical form, is not that the patentee has described
 “ and claimed that form only; it is because that form
 “ only is capable of embodying his invention; and con-

“sequently, if the form is not copied, the invention is
“not used.

“Where form and substance are inseparable, it is
“enough to look at the form only. Where they are sep-
“arable, where the whole substance of the invention
“may be copied in a different form, it is the duty of
“courts and juries to look through the form for the sub-
“stance of the invention—for that which entitled the
“inventor to his patent, and which the patent was de-
“signed to secure; where that is found, there is an in-
“fringement; and it is not a defense that it is embodied
“in a form not described and in terms claimed by the
“patentee.

“Patentees sometimes add to their claims an express
“declaration to the effect that the claim extends to the
“thing patented, however its form or proportions may
“be varied. But this is unnecessary. The law so in-
“terprets the claim without the addition of these
“words. The exclusive right to the thing patented is
“not secured, if the public are at liberty to make sub-
“stantial copies of it, varying its form or proportions.
“And, therefore, the patentee, having described his
“invention and shown its principles, and claimed it in
“that form which most perfectly embodies it, is, in
“contemplation of law, deemed to claim every form
“in which his invention may be copied, unless he mani-
“fests an intention to disclaim some of those forms.”

It is impossible to distinguish the Winans-Denmead case from the case at bar. Winans claimed, in terms, the frustum of a *cone*; the defendant had used the frustum of a *pyramid*; but, as both devices accomplished

the same purpose in substantially the same way, they were held to be mechanical equivalents. Jensen has claimed, in terms, a *vertically*-moving plunger, while Letson & Burpee have used a plunger which does not move in a true vertical line, but does move *upwardly on an inclined line*—in a word, a *diagonally*-moving plunger. It, however, performs identically the same function as the true vertical plunger, and in substantially the same way. Consequently, it is the mechanical equivalent.

Another case equally in point is *Ives vs. Hamilton*, 92 U. S., 426, relating to a method of hanging and runnings saws in saw-mills. The claim was worded as follows:

“Giving to the saw in its downward movement a rocking or rolling motion by means of the combination of the cross-head working in the *curved guides* at the upper end of the saw, the lower end of which is attached to a cross-head, working in *straight guides* and pivoted to the pitman *below* the saw, with the crank-pin, substantially as described.”

It will be seen that this claim, in terms, calls for a cross-head working in *curved* guides at the upper end of the saw, and a cross-head at the *lower* end of the saw working in straight guides and pivoted to the pitman *below* the saw.

In the infringing machine *angular* guides were substituted for the curved guides of the upper cross-head, and the lower end of the saw was pivoted to the pitman *below* instead of *above* the cross-head, thus reversing the patentee's arrangement without changing the result. The decision of the lower court is published in 6 Fish., 244, where a very elaborate opinion was rendered by Judge Longyear. The Supreme Court concurred in that opinion, and, through Mr. Justice Bradley, said:

“The substitution of guides at the top, made crooked
 “by a broken line instead of a curved line, is too trans-
 “parent an imitation to need a moment's consideration.
 “A curve itself is often treated, even in mathematical
 “science, as consisting of a succession of very short
 “straight lines, or as one broken line, constantly chang-
 “ing its direction; and many beautiful theorems were
 “evolved by the early mathematicians on this hypothe-
 “sis. At all events, in mechanics, when, as in this
 “case, a broken line is used instead of a regular curve,
 “being deflected at one or more points by a very slight
 “angle, and performing precisely the same office as a
 “curve similarly situated, the one is clearly the equiva-
 “lent of the other.

“The attaching of the lower end of the saw to the
 “pitman below the cross-head instead of above it, and
 “thereby getting the same movement as before by re-
 “versing the motion of the crank, is no change in prin-
 “ciple. This is too obvious for discussion.

“The combination of the two things in the defendants’ mill, namely, the crooked guides above and the connection of the saw with the pitman below at a point removed from its center of motion, both being calculated to give to the saw its precise rocking or vibratory motion desired, is a close copy of the plaintiff’s invention; quite as close as is usually made by those who attempt to evade a patent whilst they seek to use the substance of the invention.”

A similar ruling was made in *Reed vs. Smith*, 40 Fed. Rep., 882, where it was held that a broken line was the equivalent of a true curve.

If, therefore, it be true that a broken line is the equivalent of a true curve in the case of a pioneer invention, how is it possible to escape the conclusion that the upward travel of Letson & Burpee’s plunger on an incline is the mechanical equivalent of the true vertical movement of Jensen’s plunger?

On the same point, we refer to the cases, already quoted, of *Brush vs. Condit*, 132 U. S., 39, where a square clamp was held to be the equivalent of a circular clamp; *Manufacturing Co. vs. Bushing Co.*, 31 Fed. Rep., 76, where a circular bung-hole was held to be the equivalent of a conical one; the *Accumulator case*, 38 Fed. Rep., 143, where a round hole was held to be the equivalent of a square hole; and *Moore vs. Clark*, 65 Fed. Rep., 526, where a square bowl in a stationary

wash-stand was held to be the equivalent of a circular or oval bowl.

Another instructive case is that of *Machine Co. vs. Murphy*, 97 U. S., 120, where the Supreme Court, through Mr. Justice Clifford, used the following language:

“Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the patent law when they perform different functions or in a different way, or produce a substantially different result.

“Nor is it safe to give much heed to the fact that the corresponding device in two machines organized to accomplish the same result is different in shape or form the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as at the means by which the result is attained.

“Inquiries of this kind are often attended with difficulty; but if special attention is given to such por-

“tion of a given device as really does the work, so as
 “not to give undue importance to other parts of the
 “same which are only used as a convenient mode of
 “constructing the entire device, the difficulty attending
 “the investigation will be greatly diminished if not en-
 “tirely overcome. (*Cahoon vs. Ring*, 1 Cliff., 620.)

“Authorities concur that the substantial equivalent
 “of a thing, in the sense of the patent law, is the same
 “as the thing itself; so that if two devices do the same
 “work in substantially the same way and accomplish
 “substantially the same result, they are the same, even
 “though they differ in name, form, or shape. (*Cur-
 “tis, Patents* (4th ed.), Sec. 310.)”

Still another case worthy of consideration is *Murphy vs. Eastman*, 5 Fish., 306, where a patentee had claimed a brush having around the head, near the bristles, an angular groove, in which was fitted a band of rubber made in the form of a parallelogram or rhombus, with one of its angles projecting outward, so as to prevent the hard brush-head from coming in contact with the glass or other surface to be dusted. The defendants' brush had around the head, near the bristles, a semi-circular groove, in which was fitted a round rubber band for the same purpose as the patentee's angular rubber band.

The claim called, in words, for the *angular* form, and it was contended that the *circular* form was no infringement, because outside of the strict language of

the claim. But Judge Shepley brushed aside this technicality in the following forcible language:

“The patentee, in his specification and claim, has only described one geometrical form of groove or furrow, and three geometrical forms for the rubber ring, *i. e.*, the parallelogram, rhombus, and triangle. Perhaps a strict construction of the language would exclude the triangle from the list of forms of the rubber ring in the claim. The patentee does not, as is sometimes done, claim, in terms, the thing patented, however its form and proportions may be varied; but the law so interprets his claim without the addition of these words. In contemplation of law, after he has fully described his invention and shown its principles, and claimed it in a form which perfectly embodies it, unless he disclaims other forms, he is deemed to claim every form in which his invention may be copied.

“Undoubtedly, in some cases the letters patent include only the particular form described and claimed, not for the reason that the patentee has described and claimed that form only, but because the invention consists in form only, and only in that form can be embodied, so that when the form is not copied the invention is not used. (*Winans vs. Denmead*, 15 How. (56 U. S.), 343.)

“We must look, therefore, into the nature of the invention, and see whether its forms and its substance are inseparable. If they are inseparable, then the respondents, having changed the form, do not copy the substance of the invention; but if they are separable, and the substance of the invention which the patent is

“ designed to secure is to be found in the manufactures
 “ of the respondents, although copied and embodied in
 “ a form not described, or different from the form de-
 “ scribed and specifically claimed by the patentee, then
 “ they have infringed. The invention, as described
 “ and claimed, is for a brush-head, provided with an
 “ angular groove or furrow, with an India-rubber
 “ band in that furrow.

“As the operative part of the rubber band can come
 “ in contact with the wood or glass to be dusted or
 “ brushed only at one line in the periphery of the band,
 “ it can make no difference in the result whether the
 “ shape of the rubber is circular or angular; whether a
 “ cross-section of the rubber band would be a parallel-
 “ ogram, a rhombus, or—what a circle practically is—
 “ a many-sided polygon; or whether the shape of the
 “ groove be semi-circular or polygonal or triangular,
 “ they would accomplish the same result in the same
 “ manner, and by the same means. Cut away from
 “ the defendants’ band a segment of the circle on both
 “ sides of the line in the periphery of the band where
 “ it touches the glass to be brushed, and you have only
 “ removed a superfluous and inoperative part; and the
 “ same principle, *mutatis mutandis*, applies to the band
 “ in the groove and the groove itself. One geometrical
 “ form as much as the other may embody the substance
 “ of this invention, and copy and use the invention it-
 “ self. Decree for injunction and account.”

A recent case in point is *Metallic Extraction Co. vs. Brown*, 104 Fed. Rep., 345-6, decided by the court of appeals of the eighth circuit. There the invention was

a roasting furnace, and amongst other things the claim called, in terms, for a supplemental chamber *at the side* of the main roasting chamber. The defendant had used a supplemental chamber, not at the side of, but *underneath or at the bottom* of the main roasting chamber. It was held to be an infringement, because the invention was held to be of a pioneer character.

In the case of *Hoyt vs. Horne*, 145 U. S., 302, the claim called for a device operating in a *horizontal plane*. The defendant had evaded the wording of the claim by causing his device to operate in a *vertical*, instead of in a horizontal, plane, and the question was whether this was the mechanical equivalent of the patented arrangement. The court held that it was. The decision is a most interesting one, but we do not deem it necessary to quote from it at length. It is conclusive of the case at bar. The parallel is perfect. In one the question was whether a vertical plane was the equivalent of a horizontal plane; in the other, the question is whether a diagonal line is the equivalent of a vertical line. Not until this Supreme Court decision is overruled can a decision adverse to Jensen be logically made.

Another case of a pioneer invention, where the defendant had evaded the language of the claim, is *Reece Button Hole Machine Co. vs. Globe Button Hole Co.*,

61 Fed. Rep., 958, relating to a sewing machine. The claim called for a moving frame and a stationary plate, whereas the defendant had used a stationary frame and a moving plate. The court of appeals for the first circuit held the two arrangements to be equivalents.

In *Harmon vs. Struthers*, 57 Fed. Rep., 637, the court of appeals for the third circuit made a similar ruling regarding a pioneer invention. There the claim called for a *vertical* shaft, whereas the defendant had used a *horizontal* shaft; but the two machines accomplished the same result, and they were held to be equivalents on the authority of *Morley Machine Co. vs. Lancaster* and *Winans vs. Denmead*.

The case of *Westinghouse vs. Boyden*, 170 U. S., 537, is another instance where the rule was laid down that there may be an infringement, although the device is outside of the literal language of the claim. The court there said:

“We have repeatedly held that a charge of infringement is sometimes made out though the letter of the claim be avoided.”

And in support of that the court cited *Machine Co. vs. Murphy*, 97 U. S., 130; *Ives vs. Hamilton*, 92 U. S., 426; *Morey vs. Lockwood*, 8 Wall., 230; *Elizabeth vs.*

Pavement Co., 97 U. S., 137; *Sessions vs. Romadka*, 145 U. S., 29; *Hoyt vs. Horne*, 145 U. S., 302.

We thus see that, in the case of pioneer inventions, form is of no moment; and where the invention may be embodied in different geometrical forms, a claim in one form does not exclude other forms. According to the cases cited, the following forms have been held equivalents:

A pyramid=a cone.

A broken line=a true curve.

A square=a circle.

An oval=a circle.

A circular groove=an angular one.

A vertical plane=a horizontal plane.

A vertical shaft=a horizontal shaft.

How, then, is it possible to escape the conclusion that Letson & Burpee's *diagonally*-moving plunger is a mechanical equivalent of Jensen's *vertically*-moving plunger?

But after all, the contention of defendants' counsel that the Letson & Burpee plunger is not "vertically-moving" is more specious than sound. That device is, in reality, "a vertically-moving plunger." It is quite true it has an additional motion, to wit: a motion in a circular path; but, nevertheless, it actually has a verti-

cal motion also. It has two motions, one vertical and the other circular, both going on at the same time. The vertical motion is due to the fact that the stem 18 of the plunger passes through the bored-out vertical hole of the bracket 14a. There can be no doubt of that. A rod cannot travel through a vertical hole without having a vertical motion, any more than a locomotive's piston can not travel through a horizontal steam cylinder without having a horizontal motion. The circular motion of defendants' plunger is due to the fact that the bracket 14a rotates around the central shaft 13, while the plunger is moving vertically. In other words, the plunger is rotating while moving vertically. This compounding of motions was copied from Jensen's patent involved in 90 Fed. Rep., 415. In that respect it is analogous to the case of a marine engine on a steamboat. The cylinders of those engines are vertically placed, and the motion of the piston is vertical. The fact that the boat is moving horizontally on the water while the engine is operating does not prevent the piston from being truly called a vertically-moving piston.

But the defendants' own patent proves our contention. In its claim 1, the upper plungers, or cap-pressers, as they are styled, are described as "vertically re-

reciprocal." By reference to the drawings, it will be seen that those "vertically reciprocal" cap-pressers are marked 26, and that their motion is precisely the same as that of the lower plungers 19. In his testimony, the defendant Burpee admits this. He was questioned about these two devices, the upper and lower plungers, and he answered as follows:

"X. Q. 163. What I mean is, if one of them moves vertically the other moves vertically, and if one does not move vertically, then the other does not move vertically?"

"A. That is correct.

"X. Q. 164. Their motions are similar in that respect?"

"A. They are similar in that respect."

Therefore, since the upper plungers are "vertically" reciprocal, it follows that the lower ones are likewise "vertically" reciprocal.

In claim 2 of the Letson & Burpee patent, we find the expression "vertically reciprocal cap-pressers"; in claim 4, the expression "reciprocating disks"; in claim 5, the expression "reciprocating disks vertically above and below"; in claim 6, the expression "reciprocating can and cap disks beneath and above"; in claims 7 and 10, the expression "reciprocating can and cap disks below and above"; in claim 18, the expression "vertically

reciprocal cap-pressers"; and in claim 21, the expression "vertically reciprocating disks."

Similar expressions are found in Jensen's patent. In claim 11, it is said that the plunger is "reciprocated vertically." In claims 12, 13, 14, and 15, we find the expression "vertically moving disk"; in claims 9, 10 and 11, "vertically moving plunger."

From the foregoing it is apparent, we submit, that Letson & Burpee, in their patent, intended to, and did, describe these plungers, both the upper and lower one, as "vertically moving," or, to use the exact expression, "vertically reciprocal," which conveys the same idea. Consequently, they are estopped from now urging the contrary.

It is admitted by defendant Burpee in his testimony (X. Q. 145, 148), that his machine has all the other elements of claim 9, and, consequently, it will not be necessary to discuss them.

INFRINGEMENT OF CLAIM 10.

This claim is the same as claim 9, with the addition of "the second plunger moving vertically above the cap " and following it down by gravitation or otherwise, so " as to steady the can in its descent, after the cap has " been applied."

Concerning this added element, it is sufficient to say that the Letson and Burpee machine has the same. It is called in their patent a "cap-presser," and is designated by the figure 26. That is Jensen's upper plunger, nothing more and nothing less. The only pretense of a difference, and it is nothing but a pretense, which the defendants point out between the two devices, is the assertion that in their machine the upper plunger is used for a different purpose from that specified as its use in the Jensen machine. They admit having the device, the thing itself, but say that they use it for a different purpose. If so, that is no palliation for the infringement, because the patentee is entitled to all the uses to which his device may be put, whether he specified them in his patent or not. Even though some of such uses were unknown to him, he is entitled to the same. His patent covers the *device itself*, not the functions of the device, or the uses to which it may be put, and he is entitled to use the patented device for any and all uses and purposes to which it may be put.

This was decided by the supreme court in *Roberts vs. Ryer*, 91 U. S., 157, where it was said:

"It is no invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no

“matter whether he had conceived the idea of the use
“or not.”

The same rule was laid down in:

Stow vs. City of Chicago, 104 U. S., 547.

Heald vs. Rice, 104 U. S., 737.

Eames vs. Andrews, 122 U. S., 40.

Brown vs. Dist. of Columbia, 130 U. S., 87.

Miller vs. Manufacturing Co., 151 U. S., 201.

Ligowsky vs. American Co., 34 Fed. Rep., 331.

Thomson vs. Gildersleeve, 34 *Id.*, 45.

Steyner vs. Blake, 36 *Id.*, 186.

Western Elec. Co. vs. Sperry, 58 *Id.*, 186.

Appleton vs. Star, 60 *Id.*, 411.

Galt vs. Parlin, 60 *Id.*, 422.

Thomson vs. Meter Co., 65 *Id.*, 427.

Goshen vs. Carpet Co., 72 *Id.*, 74-75.

Stearns vs. Russell, 85 *Id.*, 226.

Therefore, if the defendants have taken Jensen's upper plunger and applied it to a different use from that specified in the patent, they are infringers.

But is the upper plunger in defendants' machine used for a different purpose? We think not, within the true intent and spirit of the patent law.

It is stated in the Jensen patent that his upper

plunger, designated by the letter U, follows the can down after it is capped and steadies it in the descent.

Defendant Burpee contends that his upper plunger is not used for that purpose, but is used for pressing the cap on its seat, and thereby acts as a back-plate or resisting plate, when the can-body is forced into the cap.

If this be true of defendants' machine, it is equally true of Jensen's. There can be no doubt whatever about this. See Dep. of Seely, p. 117, where the witness says of the Jensen upper plunger: "The upper plunger forms a backing or abutment for the cap during the heading operation." It is true that the specification does not mention the fact; but it is apparent from the mechanism itself that the fact exists; consequently, it is immaterial that the specification does not mention it. We have the supreme court as authority for the contention that Jensen is entitled to such use of his plunger, even though he has not specified it in his patent. (See cases cited *supra*.)

But we contend that the Letson & Burpee upper plunger is actually used for the same purpose as the specified use of Jensen's upper plunger, viz: to follow the capped can down and steady it. The only difference between the two is that the Jensen plunger follows the can *all the way* down, whereas the Letson & Burpee plunger follows the can only *part of the way* down.

By cross-question 198, Burpee was asked to what extent his upper plunger followed the can down, and he answered, "It follows it part way down," etc., etc. (Rec., 410.)

And in answer to cross-question 199, viz: "Does it not follow the can down and in contact with it to some extent?" he answered: "Just of the slackness in the fit of the roll in the cam-way, it does to that extent, but it is not intentional. It is just manufactured that way on account of the ease in manufacturing it that way." (Rec., 410.)

And furthermore, he testified that sometimes a can would stick in the opening 21, and would not descend, and that in such case the upper plunger would descend against it and eject it. (See X. Q. 200-206, Rec., 410-412.) Of course, it goes without saying that in such case the plunger follows the capped can down.

We think it clear from the foregoing that the Letson & Burpee upper plunger performs the same function as the Jensen. But whether it does or not, it is the device itself that is patented, not its use, and defendants are infringers, if they use that device for any purpose whatever.

INFRINGEMENT OF CLAIM II.

II. *The vertically moving plunger upon which the can is received, a carrier for placing the can upon the plunger, and a mechanism by which this plunger is reciprocated vertically, in combination with a second plunger, which rests upon the top of the cap and steadies it while descending, and a mechanism for raising the second plunger before the arrival of the next cap, substantially as herein described.*

The elements of this claim are, (1) the vertically moving plunger; (2) a carrier for placing the can on the plunger; (3) a mechanism by which the plunger is reciprocated vertically; (4) a second plunger overhead; and, (5) a mechanism for raising this second plunger before the arrival of the next cap.

If we are correct in the argument already made concerning the other claims, there can be no question as to this one. The first element has already been considered, and nothing further regarding it will be necessary.

The second element consists of a carrier for placing the cans upon the lower plunger. This element is broad and unlimited. Any automatic carrier which places the can on the plunger falls within its language, and it is idle to assert that the Letson & Burpee machine has

not a carrier which does that thing. The learned judge of the lower court held that this element was limited to the specific mechanism shown; but we have already shown in this brief that such holding was error, because both the language of the claim and the state of the art show that the claim is not so limited.

The third element, a mechanism by which the plunger is reciprocated vertically, is likewise broad and unlimited in terms. Any mechanism which will reciprocate the plunger is sufficient. The mechanism illustrated in Jensen's patent drawings for that purpose is a moving cam, while the device used by Letson & Burpee is a stationary cam. Such motions are plainly the equivalents of each other. Both motions are old and well-known in mechanics. The fourth element, a second plunger, is the same second plunger referred to in claim 10, and has already been considered.

The last element is a mechanism for raising this second plunger before the arrival of the next cap. The language is broad, and any mechanism that would accomplish that purpose would be within the language of the claim. This function is performed in the defendants' machine. They have a separate plunger, and they have the mechanism for raising it before the arrival of the next cap.

We have now gone over all of the claims in controversy, and, in conclusion, we submit that they are all pioneer claims, entitled to a broad and liberal construction, and that when so construed, the Letson & Burpee machine is an infringement thereof.

REPLY TO DEFENDANTS' BRIEF.

We desire to say a few words in answer to the defendants' printed brief. There appear to be four main points advanced in said brief, viz:

1. *That the Letson & Burpee machine is a continuously operating machine, whereas the Jensen machine is an intermittent one, and consequently, that there can be no infringement.*
2. *That some of the individual elements of the combinations in the two machines cannot be substituted for one another, and hence, they cannot be mechanical equivalents.*
3. *That the Letson & Burpee machine is a faster one and will cap more cans in a given time than the Jensen machine.*
4. *That the Jensen machine is not patented as a whole.*

Regarding the first point above stated, we have already made some observations in this brief, and only a word more will be necessary. It seems to be the main point relied on by counsel for defendants. His argument is that the Letson & Burpee machine, taken as an entirety, as a whole, operates on a different principle from the Jensen machine taken as an entirety, as a whole. In other words, that the Letson & Burpee machine is a continuously operating machine as a machine, while the Jensen machine is an intermittently operating machine. But this difference is utterly immaterial to the claims in controversy. Those claims do not purport to cover the machine as a whole. They are sub-combinations, that is to say, claims for different parts and portions of the machine. The machine as a whole performs various and sundry operations before the ultimate capping is complete, and these various operations are performed by various sub-combinations or groups of mechanical instrumentalities. For instance, the first operation is to feed the cans, and that is performed by means of the belt, arms swinging over the belt and the stop. There the function of that sub-combination ceases. After this is performed, a second operation takes place, which consists in the delivery of the cans, after they have left the belt, to the capping mechanism,

and that operation is performed by the feeder or carrier F, and its actuating mechanism. Still another operation, or sub-operation, (if we may be allowed to use such a term), consists in the releasing of the caps by the cans themselves, and that operation is performed by the trigger, the stop, connecting mechanism between the two, and the pulling of the trigger by the cans. Still another operation, or sub-operation, in the machine is the carrying of the caps, after being released, into the capping mechanism. The final operation is the capping mechanism, which is performed by the combination of the plungers, slides, and actuating mechanism.

Now it must be perfectly apparent that many, if not all, of these sub-operations can be performed in a continuous, as well as in an intermittent machine, and the proof of this is that they are actually performed in the Letson & Burpee machine, which is a continuous machine. Jensen has claimed those sub-combinations, and, therefore, he is entitled to them whether used in a continuous or an intermittent machine. He considered the best form of machine in which to use them was of the intermittent kind, and accordingly he described and illustrated such a machine in his patent; but there is nothing in these claims to indicate that the sub-com-

binations are limited to an intermittent machine. This is too palpable for discussion. If Jensen had claimed the machine as a whole, then there might be more force in the counsel's argument; but he has not done that in these claims. He has claimed the sub-combinations broadly without regard to the character of the machine, as a whole, in which they may be used. Consequently, it is an infringement to use them in a continuous machine, or in any other kind of a machine.

As sharply illustrating the distinction we are seeking to make, attention is called to claim 16 of the Jensen patent, which is a claim for the entire machine, including even the crimper, and that claim specifies the machine as intermittently operating. This shows that when Jensen claimed the entire machine, he limited it to an intermittent machine. But when he claimed the various sub-combinations, he did not limit them to any particular kind of a machine, because they could be used in many kinds of machines.

The second point urged by defendants' counsel in his brief, is, that the individual elements, or rather some of the individual elements in the defendants' machine, cannot be substituted for the corresponding elements in the Jensen machine. His precise point is that these elements cannot be bodily taken from the defend-

ants' machine and put into the Jensen machine, without alteration or modification, and he cites the definition of mechanical equivalents given in *Jensen Can Filling Machine Co. vs. Norton*, 67 Fed. Rep., 239.

We agree with the counsel that the definition quoted is accurate and correct, but the counsel appears to misunderstand it, for certainly he has not properly applied it. According to the definition, the devices in the alleged infringing structure are mechanical equivalents of the patented devices, when they "can be *adapted* to "perform the functions" of the patented devices, etc.

By this is meant that if the devices can be made to perform the functions of the patented devices with only such change or alteration as is within the knowledge of skilled mechanics, then equivalency exists. It is sometimes, though rarely the case, that the elements in one machine can be bodily removed therefrom and put into the patented machine without any change or alteration whatever. In such cases, there can be no doubt as to equivalency. But such cases are rare. In the great majority of cases which occur, it is not possible to remove certain elements from one machine and put them into another without some change, alteration, or modification, and the material question is whether such changes, alterations and modifications are within the

knowledge of a skilled mechanic. If they are, then the substituted devices are mechanical equivalents; if not, that is to say, if a skilled mechanic would not know how to make those changes, alterations and modifications, but the faculty of invention would be necessary therefor, then the substituted devices are not equivalents.

In the definition quoted the expression "can be *adapted* to perform the functions of those specified " devices for which they are employed as substitutes," is used. We understand that the word "adapted" is there used to express the idea which we have been endeavoring to set forth; for such, we assert, is the law. When the substituted devices *can be adapted* to perform the functions of those whose place they take, then they are mechanical equivalents.

Apply these views to the facts in hand. The counsel asserts that the cap-carrying belt of Letson & Burpee cannot be substituted for the cap-carrying chute in Jensen's machine. Probably it is true that his belt cannot be bodily taken from his machine and put in the place of the chute in the Jensen machine without any change or alteration; but it is perfectly apparent that this belt can be substituted for the chute in the Jensen machine when the alterations and modifications are

made to adapt it to its new sphere, and also that such alterations and modifications are clearly within the knowledge of a skilled mechanic. In the language of the definition, the belt "*can be adapted* to perform the "function of the chute."

The same argument applies to the other various elements. Of course, there are some elements in the Letson & Burpee machine, which cannot be bodily removed therefrom and substituted for the corresponding elements in the Jensen machine without alteration or modification, but it is equally true that such substitution can be made when the alterations and modifications are made, which are necessary to adapt them to their new sphere of action, and that such alterations and modifications are within the knowledge of skilled mechanics. It would subserve no purpose of utility to discuss each of the elements in question, for we fear that this brief is already too lengthy, and therefore we shall not go into further details. The broad proposition above stated will be sufficient to show our position in the matter.

The next point of alleged difference is that the Letson & Burpee machine is a faster machine than the Jensen. This point is scarcely worthy of serious consideration. The question to be considered is not whether the defendants' machine operates faster, caps more cans than

the Jensen machine; but whether the devices used operate in substantially the same way. It may be a better machine, in view of the fact that the defendants have had the benefit of eleven years' experience with the Jensen machine. It must be remembered that the Jensen machine was the first of its kind, that nothing preceded it, that he had nothing to aid him in designing it. Consequently, it is not surprising that eleven years afterward skilled mechanics can get up an improvement upon the original machine. It is usually the case with an infringer to laud his own machine to the sky, and to show that it is very superior to that of the patentee, whose ideas he has appropriated. But such argument cannot aid the court in solving this question of infringement. It is not a material matter of inquiry.

But one word more on this point. The learned counsel asserts that the Letson & Burpee machine "will head "twice as many cans as will the Jensen machine." In this statement he is in error, as will appear from the testimony in the case. His own client, Mr. Burpee, testified that he recommends as the proper speed for his own machine 120 cans per minute. In other words, in the normal operation of his machine 120 cans per minute will be capped. The testimony of Mr. Munn, superintendent of the Alaska Packers' Association, shows that the normal speed of the Jensen machine is 90 cans

per minute. Consequently, there is a difference between the two machines of about 25 per cent in favor of the Letson & Burpee machine, and the counsel is in error when he says that the Letson & Burpee machine will cap twice as many cans in a given time as will the Jensen.

As has already been remarked, we do not consider this a material matter, but advert to it merely for the purpose of accuracy and in justice to Mr. Jensen's machine. It is sufficient for our purpose that his machine does successfully cap filled cans at a rate of speed sufficient to make it highly profitable. If the defendants have devised a machine which will cap more cans in a given time and be more profitable, we congratulate them upon the achievement, but submit that they are not entitled, in working out that result, to encroach upon the patented right of Mr. Jensen.

It is further urged by counsel for defendant that the Jensen machine is not patented as a whole, but only as to certain specified parts, and from this he concludes that there is no claim in the patent covering a pioneer invention.

We fail to appreciate the reasoning of such logic, for there is no rule of law requiring an inventor to claim his whole machine in order to be placed in the category of pioneer inventors. Indeed, the very opposite would

appear to be the case, for the claim for the whole machine would necessarily include so many elements that a person might easily evade the same by omitting some one or more of said elements. The more elements there are in a combination the easier it is to evade the claim therefor. It is generally the case that there is some one vital feature in a machine which gives it its value and distinctly stamps it as something different from all others. In order to utilize this feature, however, it is necessary generally to make use of subsidiary mechanisms old in the art. If in such case the patentee claims the whole machine as an entirety, thereby including in the combination all the elements of the machine, he would obtain but little protection. If, however, he claims different parts of the machine separately, thereby forming combinations of a limited number of elements, he would be able to secure the necessary protection.

Such is the case at bar. Jensen designed the first automatic machine for heading filled cans, which machine embodies various successive steps or operations accomplished by separate and distinct combinations of elements. The first step in this composite machine consists in supplying the filled cans automatically and regularly preparatory to the heading operation. This

distinct and separate step is performed by the combination of the first claim, as we have already pointed out in this brief. It is a step separate and distinct from everything else, and if new, is patentable. That it is new is admitted. That it is a primary and pioneer operation is equally clear, because prior to Jensen no machine of any kind had been used for automatically heading filled cans, and consequently, no method of supplying cans to such a machine was known. Therefore, we assert, without fear of successful contradiction, that this initial step in the operation of the machine, covered by the combination of claim 1, is a primary and pioneer invention.

The second step in the operation of the machine consists in the removal of the unfilled cans from the point at which they have been deposited by the first step, and carrying them away by means of an automatic feeder and delivering them to the capping mechanism. This step is separate and distinct from the first one, and the same argument applies to this claim that we used in reference to the first claim.

The next step in the operation consists in the automatic feeding of the caps, whereby each can releases its own cap, and this feature is covered by claim 5. Concerning it there appears to be no serious dispute.

That the operation of this claim is pioneer in character is too plain to admit of a doubt.

The final step in the operation of the machine consists of the capping operation, covered by claims 9, 10 and 11. This is likewise a separate operation and is the final step in the process.

Thus we see that the machine is of a composite character, employing several distinct and independent operations, each of which is covered by distinct and independent claims. This method of claiming a pioneer invention is the most effective that can be conceived, and we can see no valid objection to it. Had the patentee attempted to claim all of these sub-operations in one big combination, he would not have secured the protection he is entitled to, because such combination might be evaded by the omission of one of its elements.

For instance, suppose the claim had been framed in language such as the following:

In a machine for automatically heading filled cans, the combination of a mechanism for supplying the cans in an upright position, a mechanism for transferring the cans to the capper, a mechanism for supplying the caps by the movement of the cans, a mechanism for capping the cans, and a mechanism for removing the cans after being capped.

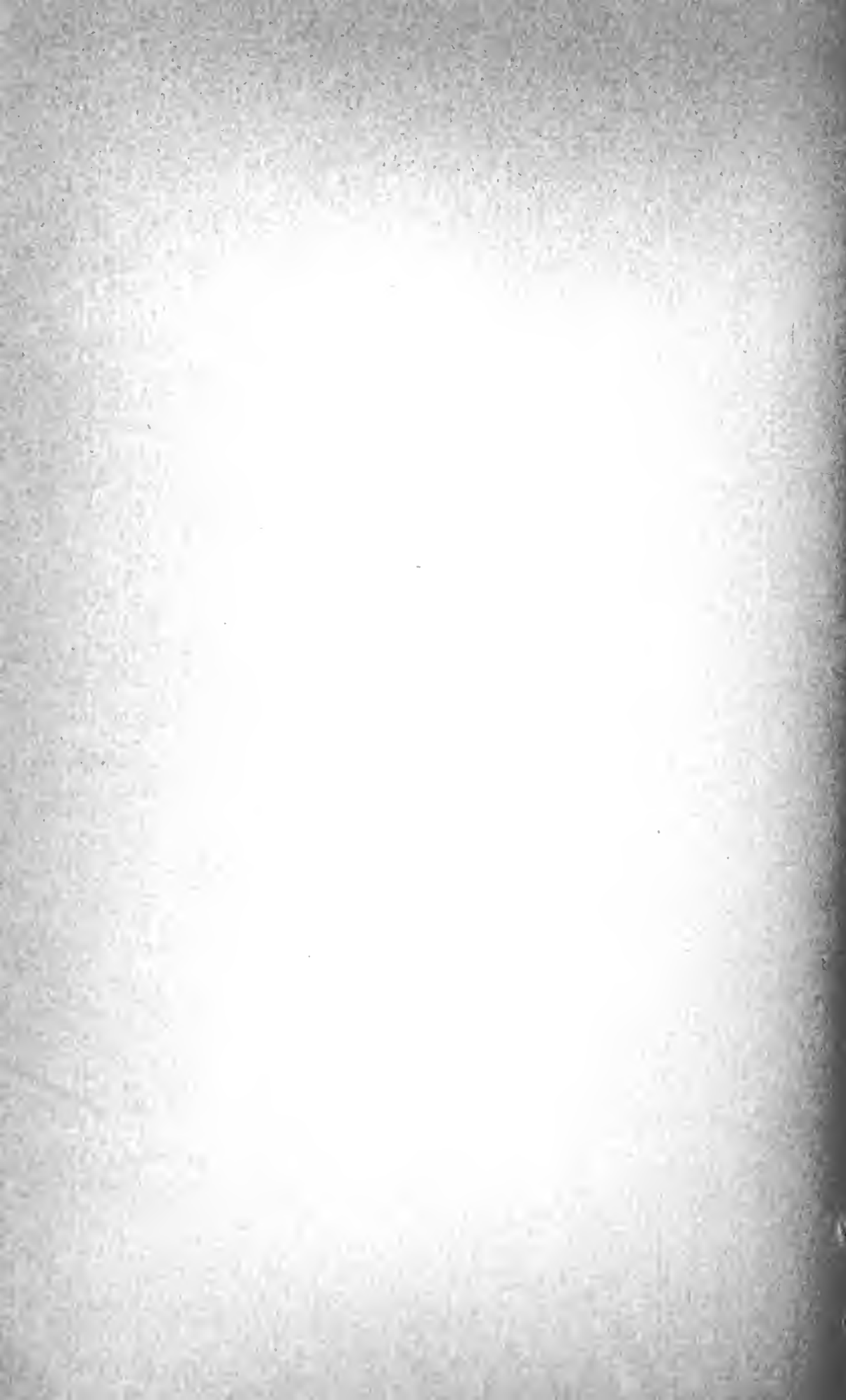
Such a claim would be a claim for the entire machine; but it requires only small knowledge of patent law to see that such a claim could be easily evaded by any adroit mechanical pirate. In order to avoid such contingency the patentee has pursued the course of making a separate and distinct claim for each separate and distinct operation. That he had a right to do this admits not of a doubt. That it more effectually protects him is palpably apparent. We fail, therefore, to see any force in the argument of the learned counsel when he urges that Jensen's claims cannot be construed as primary and pioneer because they are not claims for the entire machine and are claims only for sub-combinations.

In conclusion we submit that we have made out a meritorious case, and that we are entitled to the relief asked for. This Jensen patent is one of unusual merit, and belongs to that class of patents which the courts delight to protect. It is unfortunately the case that a great many patents are for trivial and insignificant details not worthy of judicial protection, covering, as Mr. Justice Mathews expressed it in *Hollister vs. Benedict Manufacturing Co.*, "a mere shade of the shadow of an idea." Such patents tend to bring the patent system into disrepute, but patents covering basic ideas of origi-

nality and utility stand on a different footing, and the courts look upon them with liberality and favor. Such a patent is the one now before the court. It represents a basic idea, a fundamental principle. It has aided most materially to bring to a state of perfection one of the greatest industries on the Pacific Coast, or, for that matter, in the entire world. Its novelty is not denied; its utility is not questioned; its validity is not challenged. It certainly, in our judgment, fulfills to the letter that section of the constitution which provides for the issuance of patents "in order to promote the "progress of science and the useful arts."

We respectfully submit that all that portion of the decree denying relief as to claims 1, 3, and 11, should be reversed, and all that portion granting relief as to claims 5, 9, and 10 affirmed.

JOHN H. MILLER,
For Alaska Packers Association.



No. 944

IN THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT.

J. M. K. LETSON AND F. W.
BURPEE,

Appellants and Petitioners,

vs.

THE ALASKA PACKERS'
ASSOCIATION,

Appellee,

THE ALASKA PACKERS'
ASSOCIATION,

Appellant,

vs.

J. M. K. LETSON AND F. W.
BURPEE,

Appellees and Petitioners.

**Petition for a Rehearing of the Appellants
J. M. K. Letson and F. W. Burpee.**

M. A. WHEATON,
I. M. KALLOCH,
Counsel for Appellants.

FILED
MAR 31 19

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Appellees and Petitioners.

**Petition for a Rehearing of the Appellants
J. M. K. Letson and F. W. Burpee.**

The appellants herein, J. M. K. Letson and F. W. Burpee, now come and respectfully petition this Honorable Court to grant a rehearing in this case, and they

especially ask for a rehearing as to claims No. 3 and No. 11 of the Jensen patent, upon which this action is based.

The issue in this case is upon the question of infringement and it is this question alone that we shall present in this petition.

The Alaska Packers' Association has brought this suit alleging infringement of six claims out of the sixteen claims of its letters patent No. 376,804, dated January 24, 1888, and issued to Mathias Jensen for an improvement in can capping machines. The complainant and appellee asserts the infringement of claims 1, 3, 5, 9, 10 and 11 of said patent. The Circuit Court decided that claims No. 5, 9 and 10 were infringed, by the defendants, and that the other claims were not infringed.

The machine made by the appellants, and which is asserted by the appellees to contain the alleged infringing combinations, was made according to the description contained in the patent granted by the U. S. Government to the appellants No. 629,574, bearing date July 25, 1899, more than 11 years after the issuance of appellees' said patent.

We have believed for many years last past that the method adopted by this Court, and also the Circuit Court of this circuit, for ascertaining the proper construction to be given to patent claims, and also the extent to which patent claims should be made to reach out and cover other machines than those described in the patent, was at variance with the decisions of the U. S. Supreme Court and with the U. S. courts generally throughout the East. That our contentions in this regard have been correct

we think is shown by the recent decision of the U. S. Supreme Court in the case of *Cramer vs. Singer Manufacturing Co.* In this Cramer case the Circuit Court here decided there was an infringement. The Singer Mfg. Co. appealed the case to this Court and this Court affirmed the judgment, its decision being reported in 109 Fed. Rep. 652.

The Singer Co., however, succeeded in obtaining a writ of certiorari from the U. S. Supreme Court, and the case was taken to, and decided by, that high tribunal. The case was only decided on the first day of last February, and we believe it is not yet reported in the official reports of the Supreme Court. The decision is, however, reported in Vol. 108 of the U. S. Patent Office Official Gazette, at page 1870. The Supreme Court reversed the decision of this Court of Appeals, and also the judgment of the Circuit Court. The mandate of the Supreme Court is now on file in this Court.

This Cramer case was a suit at law, and on the trial thereof, when the evidence was all in, the defendant moved the Court to instruct the jury to bring in a verdict for the defendant, upon the ground that there was no infringement shown, and the Supreme Court decided that this instruction should have been given.

We think the decision of the Supreme Court in the Cramer case is particularly applicable to the case at bar. In the Cramer case the machine which was alleged to contain the infringing combination, and which this Court and the Circuit Court decided did contain it, was made in accordance with letters patent No. 306,469, bearing date

October 14, 1884, and granted to Phillip Diehl for a sewing machine stand and treadle. In that case the alleged infringing machine was invented long after Cramer had made his invention. In the case at bar the alleged infringing machine of Letson & Burpee was also invented long after the Cramer patent was granted. In this respect the two cases are parallel.

In the case at bar the question decided by the Circuit Court and by this Court was upon the issue of invention, both courts holding that Letson & Burpee machine was an infringement of the Jensen patent.

In the Cramer case the Supreme Court decided the case upon the issue of infringement alone.

In the Cramer cases what the defendants manufactured, that was held to be an infringement, was not what was described or claimed in the Cramer patent, but the decisions of infringement were reached only by an application of the doctrine of mechanical equivalents, both by the Circuit Court and by this Court of Appeals.

In the case at bar the defendants did not make or use the mechanism that was described and claimed in the Jensen patent, but the Jensen patent was made to reach out and cover the Letson & Burpee machine only by means of an application of the doctrine of mechanical equivalents.

With all these similarities between the two cases, we think that the decision of the Supreme Court in the Cramer case is especially in point and applicable to the decision of the Circuit Court and of this Court in the case at bar.

Of course there can be no question but that the decision of the Supreme Court did decide upon the identical issue of infringement which was decided by the Circuit Court, and also by this Court in their ruling and holding that the defendant in the Cramer case was not entitled to have the jury instructed to bring in a verdict for the defendant upon the ground that no infringement whatever had been shown. That exact question was decided by the Circuit Court and by this Court and by the Supreme Court, all of the decisions being made in that one identical case, and the decision of the Supreme Court being a direct review of the decisions of the Circuit Court and of this Court.

With this decision of the Cramer and Singer Mfg. Co. case in our favor we will approach the discussion of this petition for a rehearing with courage and an expectant hope that it will be granted. We shall endeavor to present the subject in such a way as to convince the Court that its past methods of construing patents so as to extend claims and make them cover subsequent inventions, which were not made by the patentee who obtained the patents sued upon, will be substantially changed.

Take for instance the said Cramer case to illustrate the need of making such a change in order that equal and exact justice may be done by the Courts, and each inventor protected in his patented invention to the full extent of such invention.

In the Cramer case the Diehl patent covered a new invention which was not described in the Cramer patent nor covered by the language of its claims. It was a new

and useful invention and went into very extensive use in the machines that were made and sold by the Singer Co. Cramer's invention, however, as it was described in his patent, and manufactured by him, never did go into any extensive use. Experience proved that it was not as desirable as other methods already in use in other machines and consequently it never drove any of the other machines out of the market. The Cramer patent expired by its own limitation in January, in the year 1900. It has therefore been open to the public to use for more than four years last past, yet we can learn of no instance in which it has ever been applied to use in any sewing machine since the patent expired. While it would operate mechanically it was not as good as other devices in use in the frames and treadles of sewing machines, and consequently, like the great mass of patents that are issued by the patent office, it never had any intrinsic commercial value. Yet a judgment was entered in Cramer's favor for over \$12,000 damages on account of the use by the Singer Co. of the Diehl patented combination. This amount was for damages alleged to have resulted from the use of the Diehl machine in the Northern District of California alone. Several other suits in other districts were brought on the Cramer patent, but none of them have so far been tried. If the Supreme Court had not come to the rescue of the Singer Co. the amount of damages which would have been recovered by Cramer on account of the use by the Singer Co. of the Diehl mechanism would probably have been something frightful to contemplate. This looks worse when we remember that no one but Cramer ever made or sold his patented device,

and even he abandoned it before he had succeeded in selling fifty of them. This was shown by the evidence at the trial, and not contradicted.

We are not intending to make any captious use of the decision of the Supreme Court in the Cramer case, but are using it to show that some, at least, of the decisions of this Court made in construing patents and in the extension of patent claims, so as to make them cover later inventions, never made by the owner of the patent sued on, and not covered by the language of the claims of his patent, must necessarily result in giving to one man the property of another and must be doing great injustice. We assert that the true rule is to give to every inventor his own invention, and we are intending to make herein an earnest appeal to the Court to adopt this principle, and to give to every inventor his actual invention as made and claimed, and no more. We believe and assert, that by so doing the Court will be doing exact justice to all the patent litigants that come before it, and will be administering the law just as it exists. We have many times heretofore complained of plaintiff's actions in patent cases in leaving the patent sued upon, when he comes to taking his testimony, and often leaving his invention described in the patent sued upon, and which may have had no intrinsic value at all, and shifting his patent over on to the defendants' later invention which had proved to be valuable. Suits are seldom brought against late inventions and patents which have not proved to be valuable. We do not believe that one patent in fifty of the great mass of patents which are issued by the U. S.

Government ever has any commercial value, for the reason that what they cover are not as useful or desirable as other things already in use.

We believe that if the Court here in the trying of patent cases, would adopt the practical rule of ascertaining just where each patented invention commences and ends and then giving to each patentee his actual invention, that its decisions would then be in harmony with the decisions of the U. S. Supreme Court and of the Eastern courts generally, and do equal and exact justice to all.

It is often said that the specifications and drawings of a patent should be liberally construed. With this principle we fully agree; but the specification and drawings of a patent are liberally construed for the one and single purpose and object of making those specifications, if possible, cover the whole of the patentee's invention. It is often the case that specifications are carelessly drawn and do not by their terms or language contain a full description of the invention, and the courts therefore believe, and hold, that no nice strictness of construction should be given to the language of the description and claims of a patent, that may prevent them from reaching to the limitations of the invention and covering the whole of it. This rule of construction we have always believed in, and we believe in it now. Like all the rules of patent law for which we contend, such rule of construction tends to the doing of exact justice in giving to an inventor what actually and rightfully belongs to him.

Such rule of construction, however, never carries the description and claims of a patent beyond the patentee's own invention. Only the *language* of the specification and claims are made broad enough, whether by construction or otherwise, to cover and protect the patentee's actual invention, and they are never to be extended any farther, since if they are, they go beyond the protection of the patentee in his own invention and patent to assist him in plundering, either from the public or from other inventors, things which he was not the inventor of and had no right to claim.

It is sometimes the case that a *liberal* construction of the specifications and claims of a patent consists in giving to the language thereof the very narrowest construction and narrowest meanings that can be extracted from them. This happens when the invention is a thin one, and the language of the specifications and claims of a patent are so broad and general that they would plainly cover things in prior public use that were public property, or the prior inventions of others and would therefore render the whole patent entirely void. Another instance as stated in Sec. 183 of Walker on Patents, which says:

“Claims which are functional in form; that is to say “claims which literally purport to cover a result rather “than a process or a thing, are properly construed to “cover only the process or the thing which produces that “result, for otherwise such claims would be void.” Citing *Fuller vs. Yentzer*, 94 U. S. 288, and several other cases.

The foregoing are instances in which the very narrowest construction of the language of the specification and

claims becomes a liberal construction thereof for the reason that it saves to the patentee so much of the patented invention as belongs to him instead of compelling him to lose the whole of what the patent covers.

MECHANICAL EQUIVALENTS.

But what after all is the ultimate result, and the limit thereof, to which a broad construction and interpretation is given to the specification and claims of a patent? What is the extent to which such construction and interpretation may lawfully go and what are the boundaries which stop it from going farther, and limits its application in particular cases?

We have had an intimate acquaintance with the practice of the patent law as well as an intimate knowledge of the decisions of the courts in construing, applying and administering such law for some 35 years last past, and believe that we understand all of these questions fully and thoroughly.

We assert that the extent to which liberality goes in the construction of a patent simply determines the extent to which the patentee may cover by his patented claims what are known in law as mechanical equivalents.

§

Liberality in the construction of combination claims never goes farther than to allow the patentee to cover with his patent claims, to a greater or less extent, mechanical equivalents for each of the mechanical elements of the combination which his claims cover. We are not now speaking of entirely new machines where the patents

cover the machines as a whole. The great mass of contention in patent litigation is over the inventions which are covered by combination claims only.

Again we state that equal and exact justice to all requires the Court to give to a patent and its claims just such a construction as can be done within the terms of their language and give to each patentee just what he has invented, no more and no less.

Now the extent to which the combination claim of a patentee may be allowed to cover mechanical equivalents depends entirely upon the extent of his invention, and particularly to the extent to which he has introduced into it new mechanical operations or actions that produce novel results that were new to the world. There is an immense difference in the nature and quality of patented inventions. For instance, the decision of the Supreme Court says in this identical Cramer case, quoting from one of its former decisions made in the case of *Westinghouse vs. Boyden Power Brake Co.*, 170 U. S. 537, page 561,

“To what liberality of construction these claims are
 “entitled depends to a certain extent upon the character
 “of the invention, and whether it is what is termed in or-
 “dinary parlance a ‘pioneer.’ This word, although used
 “somewhat loosely, is commonly understood to denote a
 “patent *covering a function never before performed,*
 “a wholly novel device, or one of such novelty and im-
 “portance as to mark a distinct step in the progress of
 “art, as distinguished from a mere improvement or per-

“fection of what had gone before. Most conspicuous
 “examples of such patents are: The one to Howe of the
 “sewing machine; to Morse of the electrical telegraph;
 “and to Bell of the telephone. The record in this case
 “would indicate that the same honorable appellation
 “might be safely bestowed upon the original air-brake
 “of Westinghouse, and, perhaps, also, upon his auto-
 “matic brake. In view of the fact that the invention in
 “this case was never put into successful operation, and
 “was to a limited extent anticipated by the Boyden pat-
 “ent of 1883, it is perhaps an unwarrantable extension of
 “the term to speak of it as a ‘pioneer,’ although the prin-
 “ciple involved subsequently and through improvements
 “upon this invention became one of great value to the
 “public.”

Now it is evident that in such instances as that of Howe sewing-machine and others which the Supreme Court mentions as pioneer inventions there *was an original conception of the possibility of producing a certain result which conception was itself new to the world* and was the foundation upon which he built his machine. Everything, from the ultimate effect of sewing any kind of a continuous seam by any kind of a sewing-machine, and the action of the smallest and least important device in the whole machine, was absolutely new and novel with Howe. The whole principle of the mechanical action of the machine as a whole and of every moving device in the machine was all of Howe's invention, discovery and accomplishment.

It is this class of inventions that the Supreme Court in its said quotations calls the pioneer inventions. Number-

less were the various new inventions upon sewing-machines that were made after Howe had made the first sewing-machine, by a multitude of inventors and patentees, not one of whom, however, could or would have made the pioneer machine if Howe had never lived. These subsequent inventions were of all degrees of novelty and were produced by the exercise of most all degrees of invention, excepting only, that none of them was or could be the pioneer inventor of a mechanical sewing-machine. Howe was the first to make that and there *never can be but one first* in anything. We treated more at length on this subject in our brief filed herein, pages 29 to 46. Howe's patent was of course given a very liberal construction but still it was never made to cover anything except his invention. But his invention was so broad, consisting of the entire machine, and every part and parcel of it, that the various mechanical equivalents that were adopted by other manufacturers who subsequently made sewing-machines came within Howe's invention, and were covered by his patent. Howe, no more than others, was ever allowed to spread his patent so as to make it cover the inventions of others, or to cover anything except what was included within his own discovery and invention.

Without undertaking to trace the different degrees of inventions that were made by the multitude of inventors in sewing-machines, who followed after Howe, we will come down to Cramer's patent as an illustration of an invention which was not to be allowed a liberal construction and therefore not allowed to cover mechanical equivalents of the particular devices which he used.

In Cramer's invention there was not a single new or novel mechanical action of any part of the moving machinery. He used only the sewing parts of the sewing-machine that were made by others. He used only the same kind of a treadle and pitman to connect his treadle with the sewing part of the machine that had already been in use by others from whom in fact he obtained them. There was therefore nothing of any new mode of operation that was invented or discovered by him. His was not a case in which the Supreme Court allowed the patent to cover mechanical equivalents. While the Supreme Court did not say this in so many words, it did in effect, as it did not allow the patent to cover what was claimed by Cramer's counsel to be the mechanical equivalent of the knife-edge bars, etc., named in the claim as a part of its combination.

Now to what extent ought a patentee to be allowed to cover mechanical equivalents in combination claims? We assert that the extent and limit to which the combination claims may be allowed to cover mechanical equivalents is measured by the extent and limit to which that combination *has produced a new mode of mechanical action or mechanical operation*, whether that be more or less. In a combination which has made but very little change in the mode of mechanical operation the range of mechanical equivalents which the claims may cover would be very narrow, while in the combinations that are more productive of results in producing or changing or modifying mechanical actions, the range of mechanical equivalents which will be covered, when put in place of any omitted

devices of the combination, will be correspondingly increased.

We believe that this rule is the one which is produced by the boiling down of the great mass of adjudications made by the Supreme and other U. S. Courts, and that it is a just and correct one. If so, by following the rule in most cases, the constructions of the claims and the proper extent to which they may be made to cover mechanical equivalents is comparatively easy.

We have complained and do now complain that the U. S. courts here have given to narrow patents the same broad construction, and have allowed narrow claims to cover mechanical equivalents to the same extent that it has allowed broad claims for broad inventions to do the same thing. It was admitted by the Circuit Court that the Cramer patent was a very thin patent, yet it allowed the claim to cover mechanical equivalents to the fullest extent that it was possible to go by giving the claim the broadest construction that possibly could be given to it.

This Court also gave the patent a very broad construction and allowed it to reach out and cover the later Diehl invention, no part of which had ever been made by Cramer.

There are a line of cases which the U. S. Supreme Court has made applicable to very broad inventions—among them are the cases of *Winans vs. Denmead*, 15 Howard 330; *Ives vs. Hamilton*, 15 How. 330. These cases are authorities on broad inventions and patents especially. But this Court, in deciding the Cramer case, cited as applicable thereto those same cases with some

others of the same nature as pertinent authorities, by which to construe the Cramer invention and patent. See the Singer case, page 655 of 109 Fed. Rep. where the said authorities are quoted by this Court. There is a very large number of other cases decided by the Supreme Court *applicable to narrow inventions and patents* which we seldom see cited by the courts here.

Among them are :

Rowell vs. Lindsay, 113 U. S. 97 ;

Wicke vs. Ostrum, 103 U. S. 461 ;

Blake vs. San Francisco, 113 U. S. 679 ;

McMurray vs. Mallory, 111 U. S. 97 ;

Electric Signal Co. vs. Hall Signal Co., 114 U. S. 87.

See page 96 and cases cited by the Supreme Court on page 98.

Dryfoos vs. Wiese, 124 U. S. 32, last half page 37 and first half page 38 ;

Weatherhead vs. Coupe, 147 U. S. 322 ;

Werner vs. King, 96 U. S. 218 ;

and very many others in which the Supreme Court has protected the rights of defendants in patent cases.

Sometimes, however, this Court, and also the Circuit Court, here has cited such cases. Some of them were cited by this Court in the case of *Norton vs. Jensen*, 90 Fed. 415, on page 429. In fact, on said page 429 there is pure law and authorities enough declared and cited by this Court to win the case at bar for the defendants sev-

eral times over, if the Court would only apply that law and those authorities to the case. Also in the case of *Wheaton vs. Norton*, 70 Fed. 833, on pages 841 and 842, this Court cites and applies to the facts of the case, the law and authorities, which we claim ought to be applied in this case, and we cannot understand why the Court does not so apply them.

When the case of the *Singer Mfg. Co.*, plaintiffs in error, vs. *Herman Cramer*, defendant in error, was before this high tribunal Wheaton & Kalloch filed a brief for the Singer Co. Now that we have the Supreme Court upon our side of these questions which we discussed at considerable length in that brief we will quote the following from pages 89 to 103 thereof, as follows:

“The Court understands that there are innumerable cases in which the Supreme and other Courts have held that the rule of equivalents could not apply. Among the cases in which the rule does not apply are those in which the invention is very narrow, and in which no new mechanical principle or new mode of operation is developed.

Curtis on Patents, Sec. 455, defines the character of inventions in which the patentee may claim other forms of his invention than the one contained in his patent. In speaking of construing a patent Curtis says: “Or his
 “invention may be so stated as to render it doubtful
 “WHETHER HE HAS INVENTED OR DISCOVERED THE GENERAL APPLICATION OF A
 “PRINCIPLE TO PRODUCE A PARTICULAR EFFECT, AND IS THEREFORE ENTITLED TO
 “CLAIM ALL THE FORMS IN WHICH THE SAME

“PRINCIPLE CAN BE APPLIED TO PRODUCE
 “THE SAME EFFECT, OR, WHETHER HE HAS
 “ONLY INVENTED OR DISCOVERED A FORM OF
 “GIVING EFFECT TO A PRINCIPLE THE APPLI-
 “CATION OF WHICH WAS KNOWN BEFORE.”

In Sec. 456, and those following, Mr. Curtis has stated the rules as to what constitutes a broad invention and what constitutes a narrow invention, and they amount to this: So far as the inventor has invented or discovered a new principle, or what is the same thing, a new mode of operation, he can claim that new principle, or new mode of operation. But in so far as he has only used a principle that has already been known and applied, then he has only invented a new mode of applying that principle or mode of operation, and his patent will be limited to that new mode which he has discovered or invented. Discovery and invention mean the same thing in cases of this kind. Walker on Patents, Sec. 2.

Any number of authorities might be cited, and we have cited many of them in other cases before this Court, tending to repeat these rules here cited from Curtis. It would seem that their evident justice and compliance with the law that provides for granting patents would commend them to the judgment of any Court. These rules give to each inventor just what he has invented, and that is what the law provides for, and it is just what an inventor is entitled to in common honesty. But these rules do not take from other later inventors what they have invented, and give all of the inventions to one who happens to be the plaintiff in an infringement suit.

Now the only way that we know of that has ever been used by the courts, by means of which an inventor of a new principle is protected in the use of that principle, is by the application of the rules of equivalents. If he has described his invention, and shown means by which it may be applied in one form, he is protected when his invention is appropriated by other means which are substantially the same. But he is not protected in the result that he produces. His patent covers only the means by which he has applied his principle, and such analogous means as are the mechanical equivalents of those specific means which he has shown. Usually when an inventor has made an entirely new discovery like the telephone or telegraph, his invention is very broad and covers the machine as a whole; and in such cases he will be protected against any other machine which operates on the same principle, even if other mechanisms are used. Such are cases where a patent covers the entire machine, which is so entirely new that it produces for the first time in the world not only a new result, but a new kind of result that was never before known and never before produced. Compare, or rather contrast, the depth of discovery and the invention of means by which the speaking telephone was brought into the light of the world with the mere changing of the hanging of a well-known treadle in the well-known and "usual" vertical double brace instead of in the web of the legs of a well-known stand of a well-known sewing machine. Compare this mere changing of the place in the hanging of the well-known bearings of a sewing-machine treadle with the invention of Fulton, who astonished the world by applying for the first time

in the world steam to a floating vessel and driving it up stream against the river's current. Compare it with the invention and discovery of Morse, who for the first time in the world applied electricity to the producing of an intelligible alphabet and established the instantaneous communication thereof between persons situated at great distances apart.

While making these comparisons, and noticing the contrasts between Mr. Cramer's alleged invention and those great discoveries, we ask the Court to realize that the Circuit Court HAS GIVEN TO MR. CRAMER'S PATENT AND INVENTION AS BROAD A CONSTRUCTION AS IT COULD HAVE GIVEN TO MORSE'S PATENT, OR TO FULTON'S PATENT, OR TO BELL'S TELEPHONE PATENT, IF THOSE PATENTS HAD COME BEFORE IT FOR ADJUDICATION. The Court gave to Cramer the entire result that might flow from hanging the treadle in or from the cross brace. It gave to him all the means through and by which the treadle could be supported not only in the brace, but all means by which it might be indirectly supported from the brace; it allowed him to take out from the claim of his patent the trunnions with their knife-edges, and construe the patent to be for attaching the treadle to the brace indirectly by means of intervening point centers. Cramer was allowed full latitude to take out of his claim, not only the trunnions, but also its knife edges and the holes through the lower extremities of the brace to serve as bearings, and also the knife-edge and every other kind of bearings fitted or unfitted to oscillate

in those bearings or in any bearings that were in holes provided in the lower extremities of the brace. No broader construction, and no greater range of proofs, was ever given, or could be given, to the Fulton patent, or to the Morse patent, or to the telephone patent.

From all this it seems to us that this Court must see and feel that a great error has been committed by the Circuit Court that ought to be corrected.

We remind the Court that the *only effect of a broad construction* in any machine patent is that it allows a greater range in proving the application of mechanical equivalents of the devices described in the patent sued upon. A narrow construction does not allow the proof of mechanical equivalents to the same extent as does the allowance of a broad construction. If a plaintiff is allowed to prove the use of mechanical equivalents on the part of a defendant, and thereby work out an infringement, it is because the Court gives to the patent sued upon a broad construction.

Now a broad, or a narrow, or a medium construction should be given to a patent according to the actual scope of the invention. The authorities that sustain this proposition are legion, and they are concentrated by Curtis in the language above quoted from him.

In Walker on Patents, from Sec. 359 to Sec. 362, the author cites three cases of the Supreme Court upon the application of the rule stated. The three cases are:

McCormick vs. Talcott, 20 How. 405;

Railway Co. vs. Sayles, 97 U. S. 556;

Morley Machine Co. vs. Lancaster, 129 U. S. 273.

The author quotes from the first of these cases the following:

“If the patentee be the original inventor of the device
 “or machine called the divider, he will have a right to
 “treat as infringers all who make dividers operating on
 “the same principle, and performing the same functions
 “by analogous means or equivalent combinations, even
 “though the infringing machine may be an improvement
 “of the original, and patentable as such. But if the in-
 “vention claimed be itself *but an improvement on a*
 “*known machine by a mere change of form or combina-*
 “*tion of parts*, the patentee cannot treat another as an
 “infringer who has *improved the original machine by use*
 “*of a different form or combination performing the same*
 “*functions*. The inventor of the first improvement can-
 “not invoke the doctrine of equivalents to suppress all
 “other improvements, which are not mere colorable in-
 “vasions of the first.”

He quotes from the second of these cases the following:

“In such cases, if one inventor precedes all the rest,
 “and strikes out something which *includes and underlies*
 “*all that they produce*, he acquires a monopoly, and sub-
 “jects them to tribute. But if the advance toward the
 “thing desired is gradual, and proceeds step by step, so
 “*that no one can claim the complete whole, then each is*
 “*entitled only to the specific form of device which he*
 “*produces*, and every other inventor is entitled to his

“own specific form, so long as it differs from those of his competitors, and does not include theirs.”

And from the third of these cases as follows:

“Where an invention is one of a primary character, and the mechanical functions performed by the machine, *are, as a whole, entirely new*, all subsequent machines which employ *substantially the same means* to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine.” The author adds: “And the Court also said that secondary patents ought to receive a narrower construction than this.”

The rule is stated by the United States Supreme Court, perhaps as plainly as it could be stated, in the case of *Miller vs. Eagle Mfg. Co.*, 151 U. S., on page 207, as follows:

“The range of equivalents depends upon the extent and nature of the invention. *If the invention is broad or primary in its character, the range of equivalents will be correspondingly broad*, under the liberal construction which the courts give to such inventions. The doctrine is well stated in *Morley Machine Co. vs. Lancaster*, 129 U. S. 263, 273, where it is said ‘Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, ENTIRELY NEW, all subsequent machines which employ *substantially the same means to accomplish the same result* are infringements, although the subsequent

“ ‘machine may contain improvements in the separate
 “ ‘mechanisms which go to make up the machine.’ ”

The Supreme Court adds on the same and the next pages:

“ Tested by this rule, and in view of the prior devices
 “ and the great variety of springs in use previous to the
 “ granting of his patent, Wright cannot be treated as a
 “ pioneer in the art. *Neither can he, nor his assignee, be*
 “ *allowed to invoke the doctrine of equivalents, such as*
 “ the courts extend to primary inventions, so as to include
 “ all forms of spring devices and adjustments which
 “ operate to perform the same function, or accomplish
 “ the same result.”

“ Again, the issuance of the patents to Gardiner &
 “ Downey, Berlew & Kissell, and Elder creates a *prima*
 “ *facie* presumption of a patentable difference from that
 “ of the Wright patent of 1879.” *Corning vs. Burden*, 15
 How. 252; *Duff vs. Sterling Pump Company*, 107 U. S.
 636.

“ We think it manifest, from the prior state of the art,
 “ if the invention covered by his patent of 1879 was not
 “ anticipated, and if it has any validity, that it must be
 “ *limited and confined to the specific spring device which*
 “ *is described in the specification and shown in the draw-*
 “ *ings forming parts of the letters patent. Being thus*
 “ limited, there is clearly no infringement in the device
 “ used by the appellants or their principals, P. P. Mast
 “ & Company.”

The evident justice of this rule is apparent to every intelligent mind. It gives to the inventor just what he has invented, no more and no less. This is what the law says he may have, viz: A PATENT FOR WHAT HE HAS INVENTED. Sec. 4886 Revised Statutes.

The cases in which the rule has been applied and a narrow construction given to a patent that covered only a narrow invention, and thereby narrowed the range of mechanical equivalents applicable, are too numerous to mention. The following are some of them:

Lehigh Valley Railroad Co. vs. Kearney, 158 U. S. 461, latter part page 476.

Jeffrey Mfg Co. vs. Independent Electric Co., 83 Fed. 191, page 201, and cases there cited.

Illinois Steel Co. vs. Kilmer Mfg. Co., 70 Fed. 1012, latter part page 1016.

Campbell Printing Press Co. vs. Duplex Printing Press Co., 86 Fed. 315, page 323, also latter part of page 326 and page 327.

Boyd vs. Janesville Hay Tool Co., 158 U. S. 260, first half of page 267.

St. Louis Car-Coupler Co. vs. Malleable Castings Co., 81 Fed. 706, page 724, and authorities there cited.

Phoenix Castér Co. vs. Spiegel, 133 U. S. 360, beginning near bottom of page 368.

Wells vs. Curtis, 66 Fed. 318, last paragraph page 324, page 325.

Noonan vs. Chester Park Athletic Club Co., 99 Fed. 90, page 93.

“ ‘machine may contain improvements in the separate
 “ ‘mechanisms which go to make up the machine.’ ”

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Phoenix Caster Co. vs. Spiegel, 133 U. S. 360, beginning near bottom of page 368.

Wells vs. Curtis, 66 Fed. 318, last paragraph page 324, page 325.

Noonan vs. Chester Park Athletic Club Co., 99 Fed. 90, page 93.

St. Louis Car-Coupler Co. vs. National Malleable Co., 87 Fed. 885, pages 900 and 901.

Ney vs. Ney Mfg. Co., 69 Fed. 405.

Fay vs. Cordesman, 109 U. S. 408, pages 416 and 417.

Yale Lock Co. vs. Sargent, 117 U. S. 373, last paragraph on page 378.

Craig vs. Michigan Lubricator Co., 72 Fed. 173, pages 176, 177, 178.

Penfield vs. Chambers Bros. Co., 92 Fed. 630.

Duff vs. Pump Co., 107 U. S. 636.

Snow vs. Railway Co., 121 U. S. 617.

Carter Co. vs. Hanes, 70 Fed. 859.

New Departure Co. vs. Hardware Co., 69 Fed. 154.

Engle Co. vs. City of Elwood, 73 Fed. 486.

King Co. vs. Hubbard, 97 Fed. 795.

In *Jensen Can-Filling Machine Co. vs. Norton*, 67 Fed. 236, on page 239 this Court defines a mechanical equivalent in the following language :

“Mechanical equivalents, as that phrase is to be understood in this connection, are such devices as were known previously, and which in the particular combination of devices specified as constituting the patented invention, can be adapted to perform the functions of those specified devices for which they are employed as substitutes, without changing the inventor’s idea of means.”

Since the trunnions of the Cramer patent performed the one office of filling up the space between the edge of the foot piece of the treadle and the bearings in the brace so as to connect the oscillating bearings in the brace with

the edge of the foot piece of the treadle, in order that the foot piece should be supported by those bearings, and also in order that the oscillation of the foot piece should operate to oscillate the bearings, and as the point center bolt did not perform either one of these functions, it could not be a mechanical equivalent of the trunnions. The point center bolts were not "adapted to perform the functions" of those trunnions and could not have been any equivalents of them.

The foregoing list of cases might be extended to a very great length. While the very broadest construction is given to original pioneer inventions, such inventions are now so very few in number that there are few opportunities for such application of the rule in practice. Howe's original sewing machine, Morse's telegraph, Fulton's first steamboat and Bell's telephone are among the inventions which the courts have pronounced to be pioneer inventions. Improvements on such pioneer inventions have been produced by thousands. As the Supreme Court says in *Machine Co. vs. Lancaster*, 129 U. S. 263, page 273, and in *Miller vs. Eagle Manufacturing Co.*, 151 U. S., page 207:

"Where an invention is one of a primary character, "and THE MECHANICAL FUNCTIONS PERFORMED BY THE MACHINE ARE AS, A WHOLE, "ENTIRELY NEW, all subsequent machines," etc. To be a pioneer invention the functions performed by the machine *must as a whole be entirely new*. Those functions must never have been performed before by any ma-

chine, otherwise that prior machine, and not the later, is the pioneer machine.

These rules, established by the cited authorities, give to an inventor all that he has invented and obtained his patent for. This is all that in common justice and honesty can belong to him. If he has invented a machine which for the first time in the world has produced useful results that had never been produced before, he has developed a new principle, a new mode of operation, and the law protects him in it by allowing him to invoke to the fullest extent the doctrine of mechanical equivalents, and to shut off others who, after learning of his machine, and finding out the new results obtained by it, and its new mode of operation, undertake to appropriate to themselves that new result and mode of operation by embodying them in another machine, constructed on the same principle and embodying the same mode of operation and producing the same results. But if that inventor himself had seen prior machines producing those same results, and had himself made a new machine which produced those old results by new mechanism operating in substantially the same way, he is not a pioneer inventor, although his mechanism may be new as he has applied it. He is using what he obtained from the prior knowledge of others. Is it not plain that it is the discoverer of the original principle, who has produced it for the first time, that is entitled to cover, by applying the doctrine of mechanical equivalents, all subsequent machines which adopt that same mode of operation and thereby produce a repetition of the same new results? And is it not equally

plain that so long as those equivalents belong to the first inventor they cannot in the nature of things also belong to the second party who has built the second machine, although he has made it with new mechanism, which we may concede he has invented? *Both cannot be the owners of the same principle or mode of operation of the machine. Both did not invent or discover it.* Both cannot therefore be the owners of the mechanical equivalents which third parties may use in building a third machine, with still newer machinery, but which embodies the same old mode of operation and produces the same old result that was new with the first inventor.

To illustrate a little farther; suppose, as is often the case, that the builder of the second machine makes a valuable and patentable improvement on the first pioneer machine. To some extent he has in such case produced a new mode of operation by his new mechanism. To some extent he has put into the machine something of value which the pioneer inventor did not put into the pioneer machine. In such case, as to the *additional* new mode of operation, the builder of the second machine becomes a pioneer and may call to his aid the doctrine of mechanical equivalents to protect his invention, *but only to the extent that he has developed and produced a new result, and a new mode of operation.* But he cannot go back and appropriate to himself any part of the pioneer invention *nor any part of the mechanical equivalents that belong to it.* His rights cannot begin until those of the pioneer are passed, and his ownership can only begin where the rights and ownership of the pioneer ended. The owner-

ship of the mechanical equivalents of that pioneer mechanism belonged to the pioneer inventor until his patent expired, and then those mechanical equivalents belong to the public.

Smith vs. Nichols, 21 Wall. 112, pages 118 and 119.

It is usual, after an original machine of great value has been produced and gone into general and extensive use, for subsequent inventors to make an almost unlimited number of so-called improvements on that machine, and to go still further and make and patent changes and additions which are not improvements but are only changes for the worse. Such changes have no value, because no users of the machine want them, nor will they have them. They commonly involve no invention, but are made in attempts to appropriate a valuable machine, although that machine belongs to the original inventor; or, if his patent has expired, it belongs to the public.

Applying the state of the art and the rules of construction to the Cramer patent, we find beyond any question that it is not only not a primary invention, but it is one of the very narrowest, if it is any invention at all. There is not contained in it a single shade of a shadow of new movement in any of its parts. Its knife-edge bearings, rocking in their underneath bearings, were in the Wilcox & Gibbs, as were also the pitman and band wheel.

Not only was there no *new* motion obtained by Cramer, but there was not the remotest shade of a shadow of *difference* in motion produced by Cramer. The

knife-edges, the treadle with its trunnion arms, the underneath bearings in which the knife-edge bearings rested and oscillated, the treadle and band wheel, all from beginning to end acted just as the same devices, whether taken singly or collectively, individually or in combination, had acted in the Wilcox & Gibbs. The Cramer patent as to its first claim is as narrow a patent as ever issued from the patent office. There can be no reasonable doubt of this fact. There can therefore be no "range of equivalents" in this case. Since there was no new motion of any kind in any one of the devices used, nor in the combination of devices as a whole, there could not be and was not any new mode of operation produced whatever, no new mechanical principle was developed. There could be no mechanical equivalents of what was contained in the Cramer *except what were mechanical equivalents of, and belonged to, the owners of the Wilcox & Gibbs*; and as the Wilcox & Gibbs patent has now expired, those mechanical equivalents have become the property of the public."

We have quoted the foregoing from our former brief in the Cramer case, both because we deem it a pertinent argument to use in this petition, and also because it shows how faithful we have been in following the decisions of the Supreme Court, and the provisions of the patent law as those provisions have been interpreted and administered by the adjudications of the Supreme Court. This conspicuously appears by taking what we have above quoted from our said former brief and comparing it with the said late decision of the Supreme Court in the same Cramer case.

The real questions are as to who invented the Letson & Burpee machine, and who has the patent on it? Was it Jensen, or was it Letson & Burpee? The date on their patent shows that Letson and Burpee did not apply for their patent until 1893. Jensen is a native of Europe, and for many years last past he has been in Europe and is there yet. It is safe to say that he has never yet even seen one of the Letson & Burpee machines. How could he be an inventor of a machine which was made by others, which he had no hand in making, had not even known anything of it until long after it was made and completed by Letson and Burpee, and which he has never even seen? We cannot believe that Jensen invented the Letson & Burpee machine, and we all know that his patent does not describe it, and we know equally well that the claims of his patent do not include the Letson & Burpee machine, nor do we believe that they cover any part of it

The Letson & Burpee machine is a new machine not made until eleven years after the Jensen patent was issued. It is confessedly a much better machine than the Jensen. It is much more valuable. If Jensen invented it he must have known of it. If he knew of it, or if any one knew of it, why did it remain unknown to the world for eleven long years? Why was it not made and put into use?

In the defendant's machine there are two vertical rotating spindles, each one of which carries two skeleton wheels, which are rigidly attached to, and rotate with it. These two spindles and the two wheels which each of

them carry are foundation mechanical elements in the machine. They are its main moving parts. Are those two spindles and their four skeleton wheels Jensen's invention? Whereabouts in the Jensen machine are those spindles found? Whereabouts in the Jensen machine are those wheels, or either one of them found? Those skeleton wheels are made up in part by the pockets which take the can bodies from off the belts and drive them around on the rotating plungers.

Really, all that is necessary for this Court to do in order to construe the patents and decide upon the question of infringement, is to compare the specifications and drawings of the Jensen patent with the specifications and drawings of the defendants' patent. In the Cramer case, as in this case, the defendant's machine was described in a patent covering a later invention, the Diehl invention in the one case and the Letson & Burpee invention in the present case. As the Supreme Court says in the Cramer case,

“As in each of the patents in question it is apparent
 “from the face of the instrument that extrinsic evidence
 “is not needed to explain terms of art therein, or to ap-
 “ply the descriptions to the subject-matter, and as we are
 “able from mere comparison to comprehend what are the
 “inventions described in each patent and from such com-
 “parison to determine whether or not the Diehl device is
 “an infringement upon that of Cramer, the question of
 “infringement or no infringement is one of law and sus-
 “ceptible of determination on this writ of error. (*Heald*

“vs. *Rice*, 104 U. S. 737; *Market Street Cable R. Co. vs. Rowley*, 155 U. S. 621, 625.)”

A comparison of the two patents, whether made with or without whatever light may be thrown upon the comparison by the use of the testimony in the case, makes it evident that the two machines are entirely different in their construction, in their mode of operation, in the devices of which they are composed, and in the sub-combinations of those devices. The defendants' machine is a continuously operating machine while the Jensen machine is an intermittent machine only. This difference in the mode of operation of the two machines compelled the defendants to make an entirely new plan for their machine. It was a new plan *of operation* and compelled a new plan of *construction* and new kinds of operating devices all the way through. The *novelty goes all through the defendants' machine*, and the plan of it. It is not an added improvement to the Jensen machine. If the defendants' machine was an improvement upon the Jensen machine there would of course be some place in the defendants' machine where the Jensen machine would stop, and the defendants' improvements on the Jensen machine would commence. But no such place can be found. No such place has been found either by the counsel or by the Court. On pages 185-186 and 187 of the appellee's brief, counsel assert that the claims in controversy do not purport to cover the defendants' machine as a whole. That those claims are for sub-combinations only. But on page 187 of their brief counsel assert that claim 16 of the Jensen patent is a claim for the entire machine, and

that that claim specifies the machine as *intermittently operating*.

This statement, with the fact that there has been no assertion that claim 16 of the Jensen patent was infringed by the defendants' machine, constitutes a direct admission that the continuously operating machine of the defendants, taken as a whole, is no infringement of the Jensen patent, wherein is covered the intermittently operating machine as a whole.

This admission is undoubtedly correct but this distinction between a continuously operating mechanism and an intermittently operating mechanism *runs all through the two machines*. It is first incorporated in the plans of the machines as entire machines. Also in the construction of the machines as entire machines. It is equally certain that all the material sub-combinations of the machines develop the same distinctions and differences. But more of this hereafter.

On said page 187 of appellee's brief referring to Jensen's patent, it says: "But when he claimed the various sub-combinations, he did not limit them to any particular kind of a machine, because they could be used in many kinds of machines."

If by the last few words it was intended to assert that the sub-combinations of the Jensen machine could be used in a continuously operating machine the same would be absolutely incorrect. *The mechanical sub-combinations of the Jensen machine can not be used in a continuously working can capping machine*. It would be as impossible

as the construction of a perpetual motion machine. It is an utter physical impossibility to operate any material sub-combination of mechanism that is used in the Jensen machine in any kind of a continuously operating machine.

Probably the worst feature, however, of the above quotation from appellee's brief is that part wherein it is asserted that Jensen, in his claim of the various sub-combinations, did not limit them to any particular kind of a machine, etc. The pretense that an inventor may extend his claims so as to reach out and cover what he has never invented by simply saying that he does not limit himself, is a slander of the patent law. The patent law allows no patentee to claim anything that he has not invented or anything that he has not described in his specification and drawings. How would a claim of this kind read?

“I do not limit myself to my invention as I have described it herein as other machines may be invented hereafter by other parties by means of which filled fish cans may be headed automatically, and as in such machines the effect of heading filled fish cans will be accomplished, I therefore claim all machines by whomsoever hereafter invented that will accomplish the effect of automatically heading filled fish cans.”

Of course such a claim could never get past a demurrer in any court, yet counsel is practically claiming that his claims be given an interpretation that would fairly come within the foregoing language, and they expect to have the Court give the claims such construction and have them reach over and cover the defendants' machine accordingly.

We respectfully ask the Court to review its decision rendered herein and see if it has not come dangerously near to making just such a decision as appellee's counsel are claiming. We assert with all the emphasis which we can throw into the assertion that a patentee cannot extend in his patent specification, or afterwards in the courts, that he has not limited himself to what he has described his patent claims beyond his invention by stating either in his specifications.

We now return to a comparison of the two machines, the Jensen and the defendants. On pages 99 and 100 of our brief on file herein, we cited Sec. 256 of Robinson on Patents, in which the rule is laid down *that new and subsequent inventions cannot be any infringement* of an earlier patent. There are many authorities, including decisions of the U. S. Supreme Court, and also including the decision of this Court in the case of *Ransome vs. Hyde*, 69 Fed. 148, which holds that a defendant's patent is evidence for him just as much as a plaintiff's patent is evidence for the plaintiff. The defendants' patent has twenty-one claims. Claims 1 and 2 cover their machine as an entire machine. The subsequent claims go through their machine and cover the several sub-combinations and devices of which it is composed. Nothing of their machine seems to be missed from their claims.

In the defendants' machine there are two vertical rotating spindles, each one of which carries two skeleton wheels. These two spindles and the two wheels which each of them carry are foundation mechanical elements of the machine. They are its main moving parts. Now

we ask, are those spindles, which are necessary to the defendants' machine, found in the Jensen patent or not? If they are not they are certainly no part of Jensen's patented invention.

What is there in the Jensen machine of which those spindles or either of them is a mechanical equivalent? Of course there is nothing. Who then invented the spindles and first put them in a can capping machine? Was it Jensen or was it the defendants? Have not the defendants the patent covering those spindles as a part of their machine? Did Jensen ever have any patent that covered those spindles in any way, shape or manner as a part of his invention? It will not be pretended that he ever did.

Who invented the rotating skeleton wheels that are mounted upon the said spindles and which revolve with them and embodied those wheels in a can capping machine? Was it Jensen or was it the defendants?

Who has a patent for the incorporation of those rotating skeleton wheels into the can capping machine? Did Jensen get such patent or did the defendants get it? It will not be pretended that Jensen ever made such an invention or ever obtained such a patent for it, or that defendants did not make the invention, and they certainly have a patent for it.

Next, who invented the pockets and placed them in each corner of said rotating wheels in such connection with other devices that they were operative for the first time in a can capping machine? Did Jensen invent such

pockets or combine them with such rotating wheels, or was it the defendants, Letson & Burpee, who invented those pockets and placed them in the rotating wheels, and thus, for the first time in the world, utilized them as devices incorporated into a can capping machine? Was this the invention of Jensen or was it the invention of the defendants, and who obtained a patent for those inventions? Was it Jensen or was it the defendants? It must be admitted that this invention was made by the defendants, was never made by Jensen, and that defendants have a patent which covers the invention, and the plaintiff has not any such patent.

Next, who invented the rotating moving plungers of the defendants' machine, and for the first time in the world placed them as operative devices in a can capping machine, and placed them in a machine in combination with other devices which made them operative in can capping machines? Was it Jensen that did this, or was it the defendants who did it, eleven years after Jensen had reached his limit in inventing improvements in can capping machines? Of course it was the defendants who made these inventions, and it is the defendants who have a patent for them. Are these moving plungers described in Jensen's patent or covered by any of his claims? They certainly are not. It was not Jensen's invention, but it was the defendants' invention, and the defendants have their patent for it, properly granted to them.

Jensen had reached the end of his inventions in can capping machines *eleven years before any part of the de-*

defendants' machine was produced. When Jensen ceased work on can capping machines, he had not made, or attempted to make, any continuously operating machine. He never did attempt to use traveling plungers, nor to so plan a machine that traveling plungers could be used in it. He had never used or attempted to use the spindles, such as defendants use, nor the skeleton wheels which those spindles carry, nor the pockets which are carried by, and operate in combination with, those wheels and spindles, nor, in short, any of those things which are described in and covered by the claims of the defendants' patent. All those things were eleven years behind the date at which Jensen quit the field of invention. All of them were to remain eleven years longer unknown, and they did remain eleven years longer unknown, and until the defendants brought them to light, and to the knowledge of the world.

All this being so, *indisputably*, by what right are they, or any of them taken from the defendants' patent and given to the Jensen patent? It is incomprehensible to us. We cannot understand it.

CLAIMS THREE AND ELEVEN OF THE JENSEN MACHINE.

We make a special appeal to the Court to reconsider its ruling with reference to Claims 3 and 11. His Honor, Judge Hanford, decided that the defendants' machine did not infringe either one of these claims for the reason that the claims were combination claims and that the feeder F was one of the mechanical elements of each of the com-

binations, and that such feeder F was not in defendants' machine at all. As is well known, Judge Hanford is a gentleman who possesses mechanical faculties of an unusually high order, and who reads naturally and correctly the movements, actions and operations of any machine that he may observe when it is at work. He has, as we understand, himself invented a very ingenious machine especially designed for the heading of filled fish cans. The fact that Judge Hanford could not find the feeder F of the Jensen patent in the defendants' machine is certainly very strong proof that it is not there. The action and the operation of the feeder F in the Jensen machine is very fairly described by this Court in its decision herein rendered. The feeder F is a straight back with four arms projecting at right angles, forming three pockets. It is attached to three vertical cranks which rotate, giving the feeder an eccentric sweeping motion. The feeder F in this sweeping movement catches the can in the first pocket between the first pair of arms and, pushing it at right angles to the line of the belt travel, moves it a short distance and then recedes, leaving the can stationary till the next sweep, when it is received into the middle pocket and moved upon the plunger S. The Jensen feeder F is carried upon cranks so arranged as to give the feeder an eccentric sweeping horizontal motion, and *this motion is absolutely necessary* to create the intermittent motion by which the cans are moved forward through the machine. Without that *intermittent*, horizontal, eccentric sweeping motion the Jensen machine would not head any cans and would not perform any successful operation whatever. Said claim 3 is as follows:

“In combination with a transverse belt the feeder having the projecting arms between which the cans are received from the belt and the actuating devices by which the motions of the feeder are produced, substantially as herein described.”

Now this claim is clearly a combination claim. Its elements being a transverse belt, the feeder F having the *straight back*, and the projecting arms H, *between which* the cans are received from the belt and the *actuating devices by which the motions of the feeder are produced*.

Now what are the motions of the feeder which are produced by the actuating devices? They are of course the said *eccentric sweeping* motions by means of which the cans are moved *intermittently* forward. The claim therefore calls for *actuating devices by which these eccentric sweeping motions of the feeder are produced*. Those actuating devices constitute *one of the mechanical elements of the combination* of claim 3.

Now are there any such actuating devices in the defendants' machine? We do not think that this Court or any judge of this Court would think for a moment of asserting that there were any actuating devices in the defendants' machine that would produce the eccentric sweeping motion of the feeder F.

This mechanical element, the actuating devices for producing the *motions of the feeder* seems not to be taken into consideration by this Court at all in passing upon the issue of infringement of said claim 3, although those actuating devices are one of the mechanical elements of said claim 3. The Court in its opinion says:

“The question is, do the appellants use a feeder with
 “projecting arms between which the cans are received
 “from the belt? It is apparent at a glance that the peri-
 “pheric wheel could be constructed as well with project-
 “ing arms as with the curved pockets and that its opera-
 “tion would not be altered. If the appellee is entitled to
 “be protected in the claim as it is made in his patent, and
 “it is not disputed that he is entitled to such protection,
 “we think infringement cannot be avoided by merely
 “changing the shape of the arms of the feeder. Nor do
 “we think that the fact that the wheel 36 of the appel-
 “lants’ machine moves in a true circle, while the feeder
 “of the appellee’s moves eccentrically and intermittently
 “sufficient to constitute a fundamental difference.”

Now in this the Court leaves entirely out of considera-
 tion the fact that these actuating devices constitute an
 element of the combination, and the decision actually
 holds in effect, that a combination claim is infringed
 when one of the necessary indispensable mechanical ele-
 ments of the combination has not been used by the defend-
 ants. Must we be denied the benefit of that rule of pat-
 ent law which says that a combination claim cannot be
 infringed unless every one of the mechanical elements
 that are included by the claim in its combination has
 been used by the defendants? What have we done that
 so elemental and universal a rule should be refused to us,
 though allowed to every one else? Are these defendants
 outlaws, or what is the trouble? We believe that a great
 wrong has been done us in this respect by denying to us
 the benefit of this rule of law and we now come and
 respectfully ask the Court to right that wrong.

And in the consideration of this portion of its decision we ask the Court to notice particularly that what said claim three calls for are actuating devices by which the *motions of the feeder F* are produced. It is not a claim for devices that will produce other motions which do not belong to the feeder F. The devices must produce the eccentric sweeping motions of the feeder, as those are the only motions which are given to the feeder. No matter what the form of the arms H of the feeder may be, the actuating devices must produce those eccentric sweeping motions which belong to, and must govern the feeder. The actuating devices of claim three are not to produce any true circular motions. Such motion would destroy the whole action of the Jensen machine.

If every member of this Honorable Court was to examine the defendants' machine through a Lick telescope, with its magnifying power increased a thousand fold, not one of them could find in the machine the shade of a shadow of those actuating devices which are an element of said claim three. Those actuating devices are not only not in the defendants' machine, but they could not be put into it, nor any equivalent of them, without destroying the entire action of the machine.

We now assert that those actuating devices are one of the mechanical elements of said claim three, and that there cannot be any infringement of said claim unless those actuating devices are used in the infringing machine, and we further assert that those actuating devices are not in the defendants' machine, and that therefore the combination that is covered by said claim is not used

in the defendants' machine, and the machine therefore is not, and cannot be any infringement of the said claim.

We are striving to so impress this fact upon the attention of the Court that it will not be overlooked or disregarded and passed over without notice. There is so much of argument made, and so many authorities cited in our brief herein filed which the Court has not noticed in its decision, that we trust to be excused for apprehending that the same thing might happen with points made in this petition unless such points are pressed somewhat upon the attention of the Court.

Now we do not believe that there is any pretense or belief on the part of any member of this Court that the *actuating devices which produce the eccentric sweeping motion* of the feeder F, which is *especially called for by said claim 3*, can be found in the defendants' machine. Not only is the feeder F not there but those actuating devices which give to the feeder F its motions are not there either. Not only are those actuating devices which produce the motions of the feeder F as called for by the claim not in the defendants' machine, but they could not be put into it without absolutely destroying its entire operation. It is shown overwhelmingly by the testimony that the feeder F is not in the defendants' machine and that it could not be put in the defendants' machine without destroying the machine. There is no one who understands the two machines but that knows this to be the fact. It is not a case of putting the feeder F in the defendants' machine merely changing the shape of its arms H, but it is a case where neither the feeder, *nor its*

movements, could be put into the defendants' machine without destroying the entire movements and mode of operation of the defendants' machine.

Judge Hanford was right when he decided that the feeder F was not in the defendants' machine. As the feeder F is a mechanical element in the claim eleven and as the feeder is not in the defendants' machine the decision of Judge Hanford with reference to claim three, and also claim eleven, ought to be sustained. Nor do we for a moment yield assent to the position taken by appellee's counsel, that it makes no difference that the Jensen patent covers the intermittent machine only, while the defendants' machine is not intermittent but is a continuous motion machine. By being made continuous motion the defendants' machine is a very much more effective and more valuable machine. It is only made continuous motion by leaving out of it almost every device utilized in the intermittent motion machine and using instead thereof an entirely different set of devices having different operations and movements and made up of a set of devices, most of which are new in can heading machines and which could not be used and were not used in any intermittently moving can heading machine. If it were possible to transfer the devices from one machine to the other without absolutely spoiling and destroying the machine it would be a different proposition. Let the Court go over the defendants' machine and undertake to pick out devices from it that could be put into the Jensen machine without destroying it, and it will find the number of such devices to be too small to be of any importance.

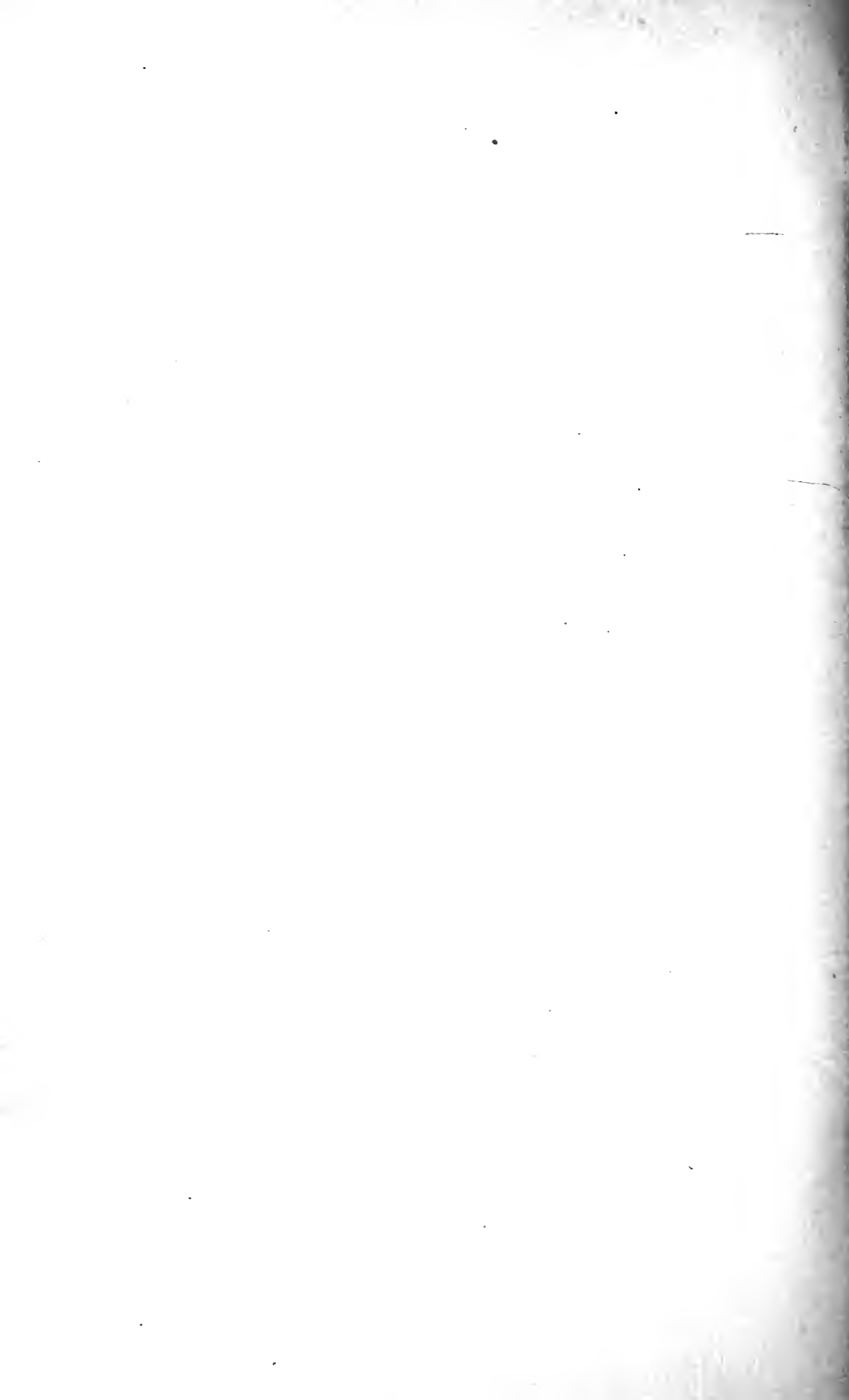
We desire to make this petition short and do not undertake to cover the whole case but to strike at enough that is vital to show that a rehearing ought to be granted. If a rehearing is granted we will make a farther presentation as to the other claims which Judge Hanford held were infringed.

Respectfully submitted,

M. A. WHEATON,
of Counsel for Appellants.

We, the undersigned, counsel for petitioner, hereby certify that in our judgment the foregoing petition is well founded and that it is not interposed for delay.

M. A. WHEATON,
I. M. KALLOCH.



UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE NINTH CIRCUIT.

CLARA E. SACKETT,

Plaintiff in Error,

vs.

MARY McCAFFREY AND JOSEPH
McCAFFREY,

Defendants in Error.

TRANSCRIPT OF RECORD.

Upon Writ of Error to the United States Circuit
Court for the District of Montana.

FILED

MAY 29 1903

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In the Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Caption.

Be it remembered on the 27th day of August, A. D. 1902, the plaintiff above named filed herein a complaint, which said complaint is entered of record herein as follows, to wit:

In the Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Complaint.

The plaintiff complains of the defendant and for cause of action alleges:

That the plaintiff is a resident and citizen of the State of New York.

That the defendants are residents and citizens of the County of Deer Lodge, in the State of Montana.

That the matter in dispute in this action exclusive of interest and cost exceeds the sum of \$2,000.

That on the 28th day of May, A. D. 1902, the plaintiff was, and ever since has been, and she now is, the owner of and seised in fee, and entitled to the possession of that certain tract of land, situated in the town, now city, of Anaconda, in the county of Deer Lodge, State of Montana and described as follows, to wit:

All of lot numbered eleven (11), in block numbered eighty-nine (89), in the said town, now city, of Anaconda, according to the plat and survey thereof on file in the office of the County Recorder of said Deer Lodge County.

That the defendants, without right or title, have withheld the possession thereof from plaintiff and excluded the plaintiff from said premises, and now unlawfully and without right or title withhold the possession of said premises from the plaintiff to her damage in the sum of \$100.00.

That the value of the rents, issues and profits of said premises from the said 28th day of May, 1902, and while the plaintiff has been excluded therefrom by the defendants, is at the rate of \$50.00 per month.

That the value of the said premises is \$2,500 and more.

That since the 28th day of May, 1902, and prior to the commencement of this action, the plaintiff demanded of

the defendants the possession of the premises, but the defendants refused, and still refuse to deliver up the same to plaintiff.

Wherefore the plaintiff prays judgment against the defendants.

I. For the recovery of the possession of the demanded premises, and for the sum of \$100, damages for withholding the possession thereof.

II. For the sum of \$50 per month, the value of the said rents, issues and profits, and costs of suit.

W. H. TRIPPET, and
GEO. B. WINSTON,
Attorneys for Plaintiff.

State of Montana, }
County of Deer Lodge. } ss.

George B. Winston, being duly sworn, deposes and says:

That he is one of the attorneys for the plaintiff in the above-entitled action; that he has read the foregoing complaint and knows the contents thereof, and that the matters therein stated are true, according to his best knowledge, information and belief.

That he makes this verification in the place of the plaintiff, and on behalf of the plaintiff, for the reason that said plaintiff is now absent from the county of Deer Lodge, State of Montana, where this affiant resides and has his office.

GEO. B. WINSTON.

Subscribed and sworn to before me this 26th day of Aug., 1902.

[Seal] W. H. TRIPPET,
Notary Public in and for Deer Lodge County, State of
Montana.

[Endorsed]: Title of Court and Cause. No. 203. Complaint. Filed and entered Aug. 27th, 1902. Geo. W. Sproule, Clerk. By F. H. Drake, Deputy Clerk. Filed on transfer, January 13th, 1903. Geo. W. Sproule, Clerk.

And thereafter, to wit, on the 27th day of August, A. D. 1902, a summons was duly issued herein, which said summons is entered of record as follows:

Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Action brought in said Circuit Court, and the Complaint filed in the office of the Clerk of said Circuit Court, in the City of Helena, County of Lewis and Clarke.

Summons.

The President of the United States of America, Greeting, to the Above-named Defendants, Mary McCaffery and Joseph McCaffery:

You are hereby summoned to answer the complaint in this action which is filed in the office of the clerk of this court, a copy of which is herewith served upon you, and to file your answer and serve a copy thereof upon the plaintiff's attorney within twenty days after the service of this summons exclusive of the day of service; and in case of your failure to appear or answer, judgment will be taken against you by default, for the relief demanded in the complaint.

Witness, the Honorable MELVILLE W. FULLER, Chief Justice of the United States, this 27th day of August, in the year of our Lord one thousand nine hundred and two, and of our Independence the 127th.

[Court Seal]

GEO. W. SPROULE,

Clerk.

By Frederick H. Drake,

Deputy Clerk.

UNITED STATES OF AMERICA.

*Circuit Court of the United States, Ninth Circuit, District
of Montana.*

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH Mc-
CAFFERY,

Defendants.

State of Montana,

County of Deer Lodge.

} ss.

Daniel Lynch being duly sworn, deposes and says:

That he is a citizen of the United States over the age of twenty-one (21) years, and that he is not a party to nor is he interested in the above-mentioned action.

That he received the within annexed summons on the 28th day of August, 1902, and personally served the same on the 28th day of August, 1902, upon Mary McCaffery and Joseph McCaffery, the defendants named in said action, by delivering to and leaving with each of said defendants named in said action, personally, at the city of Anaconda, in the county of Deer Lodge, State of Montana in said District, a certified copy thereof, together with a copy of the complaint in said action certified to by the clerk of said Court and attached thereto.

DANIEL LYNCH.

Subscribed and sworn to before me August 29th, 1902.

[Seal]

GEORGE B. WINSTON,

Notary Public in and for Deer Lodge County, State of
Montana.

[Endorsed]: No. 203. Title of Court and Cause. Summons. Geo. B. Winston and W. H. Trippet, Plaintiff's Attorneys. Filed and entered Sept. 4th, 1902. Geo. W. Sproule, Clerk. By F. H. Drake, Deputy Clerk. Filed on Transfer Jan. 13th, 1903. Geo. W. Sproule, Clerk.

And thereafter, to wit, on the 15th day of Sept., 1902, defendants filed their answer herein, which said answer is entered of record herein as follows:

In the United States Circuit Court, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Answer.

Now come the above-named defendants and file this their answer to plaintiff's complaint herein:

1. Admit that the plaintiff is a resident and citizen of the State of New York.

2. Admit that the defendants are residents and citizens of the county of Deer Lodge, in the State of Montana.

3. Deny that on the 28th day of May, A. D. 1902, or at any other time or at all, the plaintiff was, and ever since has been or was, or ever since has been, or that plaintiff is now the owner of and seised in fee or the owner of or seised in fee, or in any other way or at all, or entitled to the possession of the land described in her complaint, or to any part or parcel thereof.

4. Deny that the defendants, without right or title, have withheld the possession of said land from plaintiff, and excluded the plaintiff from said premises, or now or at any other time, or at all, unlawfully or without right or title, withhold the possession of said premises from the plaintiff, to her damage in the sum of one hundred dollars, or in any other sum or any sum at all, but defendants aver that they have been at all the times in said complaint mentioned in the lawful possession of the whole of said premises, and now and have at all times in said complaint mentioned held and claimed the said premises lawfully and under a valid title.

Deny each and every allegation in said complaint contained not herein specifically admitted or denied.

For a further and separate defense herein these defendants allege:

1. That on the 24th day of November, 1900, and for a long time prior thereto, the defendants Joseph McCaffery and Mary McCaffery were, and now are, husband and wife, and at all of said times the defendant Mary

McCaffery resided, and now resides, with her said husband in and upon the following described land, to wit: Lot numbered eleven (11) in block numbered eighty-nine (89), in the town (now city) of Anaconda in the county of Deer Lodge, State of Montana, according to the plat and survey of said town (now city) of Anaconda, on file in the office of the county recorder of Deer County, which said premises are the premises claimed by and sued for by the plaintiff in this action.

2. That on the 24th day of November, A. D. 1900, and for a long time prior thereto, the said defendants were, and ever since have been, and now are, the owners in fee simple of the above-described land, and the same constituted and now constitutes the homestead of the said defendant Mary McCaffery, and of her said husband, the defendant Joseph McCaffery.

3. That on the 24th day of November, A. D. 1900, the said defendant Mary McCaffery (her husband, the said defendant, Joseph McCaffery, not having made such selection) executed and acknowledged in the same manner as a grant of real property is acknowledged, a declaration of homestead upon and for the above-described land, and the dwelling-house thereon and its appurtenances.

4. That said declaration of homestead so made and executed as aforesaid contained a statement that her husband had not made such declaration of homestead, and that she, the said Mary McCaffery, therefore made such declaration of homestead for the joint benefit of herself and her said husband, Joseph McCaffery, and

a statement that she, the said Mary McCaffery, the person making such declaration of homestead, was residing upon said premises and claimed them as a homestead, and said declaration of homestead contained a description of the above-described premises so claimed as a homestead as aforesaid, and also an estimate of the actual cash value of said premises.

5. That on the 26th day of November, 1900, the aforesaid declaration of homestead was filed for record in the office of the clerk of the county of Deer Lodge, State of Montana, within which said county the premises so claimed as a homestead as aforesaid were situated.

6. That the land so claimed for a homestead as aforesaid did not exceed in quantity one-fourth (1-4) of an acre, and did not, and does not now, exceed in value the sum of twenty-five hundred (\$2500.00) dollars.

That the said defendant Mary McCaffery, at all the times herein mentioned, claimed, and does now claim, the above-described land and the dwelling-house thereon, and its appurtenances, as a homestead for the joint benefit of herself and her husband, the said defendant Joseph McCaffery.

Wherefore the above-named defendants demand judgment that the plaintiff take nothing by this action, and that defendants have judgment for their costs herein.

RODGERS & RODGERS,
Attorneys for Defendants.

State of Montana, }
County of Deer Lodge. } ss.

Mary McCaffery, being first duly sworn, deposes and says as follows:

That she is one of the defendants in the above-entitled action, that she has heard read the foregoing answer, and knows the contents thereof, and that the matters and facts therein stated are true of her own knowledge.

her
MARY X McCAFFERY.
mark

Witness to the mark of Mary McCaffery:

HIRAM W. RODGERS.

Subscribed and sworn to before me this 13th day of September, A. D. 1902.

[Seal] HIRAM W. RODGERS,
Notary Public in and for Deer Lodge County, Montana.

Due service of the foregoing answer is hereby admitted, and copy received this 13th day of September, 1902.

W. H. TRIPPET,
GEO. B. WINSTON,
Attorneys for Plaintiff.

[Endorsed]: No. 203. Title of Court and Cause. Answer. Filed and entered September 15th, 1902. Geo. W. Sproule, Clerk. Filed on Transfer January 13th, 1903. Geo. W. Sproule, Clerk. Rodgers & Rodgers, Attorneys for Defendants.

And thereafter, to wit, on the 11th day of October, 1902, the plaintiff filed herein her reply, which said reply is entered of record as follows:

In the United States Circuit Court, Ninth Circuit, for the District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCaffery and JOSEPH McCaffery,

Defendants.

Reply.

The above-named plaintiff, for reply to the further, separate and affirmative defense and answer—

First.—Denies that the said defendants, or either of them, have been the owner of the premises as mentioned in the complaint, or any part thereof, since the 12th day of May, 1902.

Second.—Denies that the said premises, or any part thereof, on the 24th day of November, A. D. 1900, or prior thereto or since, or at any time, or at all, constituted or now constitutes the homestead of the defendant Mary McCaffery or her husband, the defendant, Joseph McCaffery, or either of them; denies that the said premises, or any part thereof, has at any time been, or is now, the homestead of the defendants, or either of them.

Third.—Denies that the defendant Mary McCaffery, on the 24th day of November, A. D. 1900, or at any other

time, executed and acknowledged, or executed or acknowledged a declaration of homestead upon the said land and dwelling-house thereon and appurtenances, or any part thereof.

Fourth.—Denies that the declaration mentioned in said answer of defendant contained a statement or estimate of the actual cash value of said premises, or any statement or estimate of the actual cash value or any value of said premises.

Fifth.—Denies that any declaration of homestead was filed for record or filed in the office of the clerk of the county of Deer Lodge, State of Montana.

Sixth.—Denies that defendant Mary McCaffery at any time mentioned in said answer claimed, or now claims, the said land or any part thereof, and the dwelling-house thereon and its appurtenances, as a homestead, except under the instrument, and as hereinafter mentioned.

For a further reply to the separate defense and affirmative answer of the defendants filed herein, the said plaintiff alleges:

(1) Said plaintiff admits that on the 24th day of November, 1900, the defendant Mary McCaffery executed and acknowledged an instrument purporting to be a declaration of homestead on the premises described in the plaintiff's complaint and in said answer, being the so-called declaration of homestead mentioned in said affirmative answer, and which said instrument reads in words and figures as follows, to wit:

“Know all men by these presents: That I do hereby certify that I am the wife of Joseph McCaffery, and that

I do now, at the time of making this declaration, actually reside with my family on the land and premises hereinafter described.

That the land and premises on which I reside are bounded and described as follows, to wit: Lot number (11) in block number (89), in the city of Anaconda, Deer Lodge County, Montana. That it is my intention to use and claim the said lot of land and premises above described, together with the dwelling-house thereon, and its appurtenances, as a homestead.

And I do hereby select and claim the same as a homestead. That I make this declaration for the joint benefit of myself and husband, and I declare that my husband has not made a declaration of homestead. That the actual cash value of said property I estimate to be _____.

In witness whereof, I have hereunto set my hand and seal this 24th day of November, A. D. 1900.

her

MARY X McCAFFERY. [Seal]

mark

Witness to mark:

J. T. CASEY.

State of Montana, }
County of Deer Lodge. } ss.

On this 24th day of November, A. D. 1900, before me, John T. Casey, a notary public in and for the county and State aforesaid, personally appeared Mary McCaffery, known to me to be the person whose name is subscribed

to the within instrument, and acknowledged to me that she executed the same.

In witness whereof I have hereunto set my hand and affixed my notarial seal the day and year first above written.

[Notarial Seal]

JOHN T. CASEY,

Notary Public in and for Deer Lodge County, Montana."

(2) The plaintiff admits that on the 26th day of November, A. D. 1900, the said defendant Mary McCaffery filed said alleged declaration of homestead, and had the same recorded in the office of the county clerk of said Deer Lodge County, which said instrument so executed, acknowledged and filed for record as aforesaid is the same and identical instrument, and none other, as mentioned in said answer as a declaration of homestead, executed and acknowledged by the said Mary McCaffery.

(3) But said plaintiff alleges that said instrument at the time of filing thereof did not contain an estimate of the actual cash value of the premises therein described; that by reason of said omission said instrument was not at the time of the filing thereof, or at any time subsequent thereto, and is not now a declaration of homestead, but was at all of the times, and is now, wholly void and of no effect.

And said plaintiff, for a further, separate and partial reply for the said affirmative answer of said defendants, alleges:

(1) The said plaintiff alleges the facts in regard to the declaration of homestead mentioned in said defendant's answer to be as heretofore alleged in her affirmative reply, and to the same extent and as full as men-

tioned in said reply, and as full as if the said allegations in the said affirmative reply were here again repeated.

That at the time of the filing of the alleged declaration mentioned in defendant's answer, and long prior thereto, and ever since the time of said filing, the said defendant Mary McCaffery and her husband, or either of them, did not reside on that part of said lot (11), block (89), described as follows:

“Beginning at a point on the west end line of said lot number (11), in said block (89), from which the northwest corner of said block bears north 13 degrees 40 minutes east, 86.25 feet, and running thence south 76 degrees 20 minutes east at right angle to west end line of lot number (11), 36.50 feet; thence north 13 degrees 40 minutes east, 9 feet; thence south 76 degrees 20 minutes east, 65 feet; thence south 13 degrees 40 minutes west, 12 feet; thence south 76 degrees 20 minutes east, 38.50 feet to a point on the east end line of said lot number (11); thence south 13 degrees 40 minutes west along east end line of said lot number (11), 10.75 feet to the southeast corner of said lot number (11); thence north 76 degrees 20 minutes west, 140 feet to the southwest corner of said lot number (11); thence north 13 degrees 40 minutes east along west end line of said lot 13.75 feet to the place of beginning,” or any part thereof; but that the same was occupied by and rented to tenants of defendant Mary McCaffery; and that the same was not, and could not have been, a homestead, or any part of a homestead of said defendant Mary McCaffery and her husband, or either of them.

(2) That the said tenant premises, at the time of the

filing of the said alleged declaration, and long prior thereto, and ever since said filing, have been entirely separate and distinct from the premises used by defendants, or either of them as a home, and have consisted of said described portion of said lot (11), block (89), together with the dwelling-house and outbuildings on said portion of said lot entirely distinct and separate from the dwelling-house occupied by the defendants, or either of them, as a residence, and from the outbuildings used in connection with said defendants' home; and that during all of said times said described portion of said lot, and said dwelling-house and outbuildings thereon, have been rented and used exclusively by tenants of defendant Mary McCaffery, and occupied by them as a home.

(3) That at the time of filing said declaration, and ever since said time, the said defendant Mary McCaffery and her husband, and each of them, have resided and have had their home upon the other part of said lot (11), block (89), not included in said above description.

Wherefore plaintiff asks judgment as prayed for in her complaint.

GEO. B. WINSTON and
W. H. TRIPPET,

Attorneys for Plaintiff.

State of Montana, } ss.
County of Deer Lodge. }

George B. Winston, being duly sworn, upon his oath says:

That he is one of the attorneys for the plaintiff mentioned in the foregoing reply for the said plaintiff in the foregoing action.

That said attorney resides in the county of Deer Lodge, State of Montana, that the said plaintiff is a resident of New York, and is now absent from the said county of Deer Lodge and from the State of Montana, and for that reason the said plaintiff cannot verify the foregoing reply.

That the said affiant verifies said reply, by reason of the absence of the said plaintiff from the State of Montana, and said affiant says that the matters stated in the said reply are true to his best knowledge, information and belief.

GEO. B. WINSTON.

Subscribed and sworn to before me this 25th day of September, A. D. 1902.

[Seal]

W. H. TRIPPET,

Notary Public in and for Deer Lodge County, State of Montana.

Service of the foregoing reply is hereby admitted September 30th, 1902.

RODGERS & RODGERS,

Attorneys for Defendants.

[Endorsed]: No. 203. Title of Court and Cause. Reply to Answer. Filed October 1st, 1902. Geo. W. Sproule, Clerk. Filed on Transfer January 13th, 1903. Geo. W. Sproule, Clerk. W. H. Trippet and Geo. B. Winston, Attorneys for Plaintiff.

And thereafter, to wit, on the 26th day of March, 1903,
a verdict was rendered herein, which said verdict is
entered of record as follows:

*In the Circuit Court of the United States, Ninth Circuit,
District of Montana,*

AT LAW.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

No. 203.

Verdict.

We, the jury, sworn to try the above-entitled cause,
do find for the defendants.

Butte, Montana, March 26th, 1903.

FRED GAMER,

Foreman.

[Endorsed]: No. 203. Title of Court and Cause. Ver-
dict. Filed and entered March 26th, 1903. Geo. W.
Sproule, Clerk. By T. B. Stephens, Deputy Clerk.

And thereafter, to wit, on the 31st day of March, 1903, a judgment in accordance with said verdict was duly entered herein, which said judgment is entered of record as follows:

In the Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Judgment.

The above cause coming on for trial regularly in the above-entitled court, and a regular term of said court had and held in the city of Butte, county of Silver Bow, State of Montana, during the month of March, 1903, the above-named plaintiff appearing by her attorneys, Messrs. Trippett and Howell, and the above-named defendants appearing by their attorneys, Messrs. Rodgers and Rodgers and J. H. Duffy, and the above cause being at issue and for trial in the above Honorable Court before a jury duly impaneled and sworn to try said cause on the 20th day of March, 1903, and each of the above respective parties having introduced their testimony before the above Honorable Court, and aforesaid jury; and after said cause had been duly argued by the said

respective counsel herein, and after having received the charge of the above Honorable Court in the above-entitled cause, the aforesaid jury retired on the 26th day of March, 1903, to deliberate upon their verdict, and afterwards, to wit, on the said 26th day of March, 1903, the said jury returned into court with the following verdict:

“We, the jury, sworn to try the above-entitled cause, do find for the defendants.

“FRED GAMER, Foreman.”

Wherefore, by reason of the law and the premises, it is this 26th day of March, 1903, in open court, ordered, adjudged and decreed that the above-named defendants do have and recover of the above-named plaintiff judgment in the above cause for their costs therein expended, and which costs are taxed at one hundred thirty-two 90.100 (\$132.90) dollars.

And it is further ordered, adjudged and decreed that the plaintiff in the above-entitled action take nothing in said action.

Judgment entered March 31st, 1903.

[Court Seal]

GEO. W. SPROULE,

Clerk.

*In the Circuit Court of the United States, Ninth Circuit,
District of Montana,*

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

No. 203.

Clerk's Certificate to Judgment-Roll.

I, George W. Sproule, clerk of the United States Circuit Court, Ninth Circuit, District of Montana, do hereby certify that the foregoing papers hereto annexed constitute the judgment-roll in the above-entitled action.

Attest my hand and the seal of said Circuit Court,
this 31st day of March, 1903.

[Court Seal]

GEO. W. SPROULE,

Clerk.

No. 203. Title of Court and Cause. Judgment-Roll.
Filed March 31st, 1903. Geo. W. Sproule, Clerk.

And thereafter, to wit, on the 7th day of April, 1903, a bill of exceptions was filed herein, which said bill of exceptions is as follows, to wit:

*In the Circuit Court of the United States, Ninth Circuit,
District of Montana.*

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

In Ejectment.

Bill of Exceptions.

Be it remembered that the above-entitled cause came on regularly for trial on the 20th day of March, 1903, at a stated term of said Court, to wit, the term of February, A. D. 1903, begun and holden at Butte, in and for the District of Montana, before his Honor, Hiram Knowles, District Judge, sitting with a jury, the plaintiff being represented by Messrs. W. H. Trippet and E. B. Howell, her attorneys, and the defendants by Messrs. Rodgers & Rodgers and J. H. Duffy, their attorneys.

And upon the said trial, the attorneys for the said Clara E. Sackett, plaintiff, to prove her title to the premises in controversy and described in the complaint, offered in evidence the following deeds and records, viz.:

An exemplified copy of the judgment-roll in the case of Mrs. M. A. Sackett vs. Mary McCaffery and Joseph McCaffery, the same being an action brought in the District Court of the Third Judicial District of the State of

Montana in and for Deer Lodge County on the fifth day of December, 1900, in which action judgment was rendered by default against said defendants on January 7, 1901, for the sum of \$1,705.80 and costs, and a decree was entered for the foreclosure of a mortgage upon lot 21 in block 5 of the town of Anaconda, Montana, and for the sale of the said mortgaged premises.

An exemplified copy of the order of sale issued out of said Court to the sheriff of said county of Deer Lodge upon the judgment and decree last above mentioned for the sale of the said mortgaged premises in the manner provided by law, together with the said sheriff's return endorsed thereon showing that in pursuance of said order, on the 31st day of January, 1901, he sold said premises to said judgment creditor for the sum of \$800.00, leaving a deficiency of said judgment amounting to \$1,119.68.

An exemplified copy of the judgment docket of said District Court of Deer Lodge County, showing said deficiency to have been docketed against said Mary McCaffrey and Joseph McCaffrey, judgment debtors, and in favor of said Mrs. M. A. Sackett, judgment creditor, on February 8th, 1901.

An exemplified copy of an execution for deficiency on foreclosure, issued on April 9th, 1901, out of said District Court of Deer Lodge County, upon the deficiency last above described and directed to the sheriff of said Deer Lodge County, directing him to make the amount of said deficiency, to wit, \$1,119.68, together with the legal interest, out of the personal property of said judgment debtors Mary McCaffery and Joseph McCaffery, or

if sufficient personal property of said debtors could not be found, then out of their real property situated in said county of Deer Lodge, together with the return of said sheriff endorsed thereon, showing that on the 8th day of May, 1901, he sold in the manner provided by law all of the property described in the complaint, to wit, lot 11 in block 89 of the town (now city) of Anaconda, in two tracts, the first of said tracts being described as follows, to wit:

“Beginning at a point on the west end line of said lot number (11), in said block (89), from which the northwest corner of said block bears north 13 degrees 40 minutes east, 86.25 feet, and running thence south 76 degrees 20 minutes east (at right angles to the west end line of lot number (11), 36.50 feet; thence north 13 degrees 40 minutes east 9 feet; thence south 76 degrees 20 minutes east, 65 feet; thence south 13 degrees 40 minutes west, 12 feet; thence south 76 degrees 20 minutes east, 38.50 feet to a point on the east end line of said lot number (11); thence south 13 degrees 40 minutes west (along the east end line of said lot number (11); 10.75 feet to the southeast corner of said lot number (11); thence north 76 degrees 20 minutes west, 140 feet to the southwest corner of said lot number (11); thence north 13 degrees 40 minutes east (along the west end line of said lot) 13.75 feet to the place of beginning.”

The second tract being described as all the rest and residue of said lot 11 not included in the portion of said lot last above described.

The first of said tracts having been sold to said Mrs. M. A. Sackett for the sum of \$950.00, and the second

of said tracts having been sold to said Mrs. M. A. Sackett for the sum of \$250.25.

An exemplified copy of said sheriff's certificate of sale issued on May 15th, 1901, to said Mrs. M. A. Sackett in pursuance of the sale on execution last above described.

An exemplified copy of the deed under execution of said sheriff duly executed and delivered on May 19th, 1902, to said Mrs. M. A. Sackett, judgment creditor above described, conveying to said judgment creditor the premises in controversy herein, to wit, all of lot 11 in block 89 of the town (now city) of Anaconda, Deer Lodge County, Montana, under and by virtue of the judgment and execution on deficiency and sale thereunder above named.

An exemplified copy of the deed of Mrs. M. A. Sackett, widow, of Westfield, New York, dated May 8th, 1902, and acknowledged May 28th, 1902, conveying all of said lot 11, block 89 in the said town (now city) of Anaconda, to Clara E. Sackett, her daughter, residing at Buffalo, New York.

Plaintiff further introduced evidence showing that the property in controversy is, and at the time of the commencement of this action was, of a value in excess of \$2,000.00.

And thereupon said plaintiff rested her case.

Whereupon the attorneys for said Mary McCaffrey and Joseph McCaffrey, defendants, for the purpose of showing that the premises in controversy were, at the date of their said sale under execution, exempt from

execution, offered in evidence the following alleged homestead declaration, to wit:

“Know all men by these presents: That I do hereby certify that I am the wife of Joseph McCaffery, and that I do now, at the time of making this declaration, actually reside with my family on the land and premises hereinafter described. That the land and premises on which I reside are bounded and described as follows, to wit: Lot number (11) in block number (89), in the City of Anaconda, Deer Lodge County, Montana. That it is my intention to use and claim the said lot of land and premises above described, together with the dwelling-house thereon, and its appurtenances, as a homestead. And I do hereby select and claim the same as a homestead. That I make this declaration for the joint benefit of myself and husband, and I declare that my husband has not made a declaration of homestead.

That the actual cash value of said property I estimate to be \$2,000.00.

In witness whereof I have hereunto set my hand and seal this 24th day of November, A. D. 1900.

her

MARY X McCAFFERY. [Seal]

mark

Witness to mark:

J. T. CASEY.

State of Montana, }
County of Deer Lodge. } ss.

On this 24th day of November, A. D. 1900, before me, John T. Casey, a notary public in and for the County

and State aforesaid, personally appeared Mary McCaffery, known to me to be the person whose name is subscribed to the within instrument, and acknowledged to me that she executed the same.

In witness whereof I have hereunto set my hand and affixed my notarial seal the day and year first above written.

[Notarial Seal]

JOHN T. CASEY,

Notary Public in and for Deer Lodge County, Montana.

[Endorsed]:

State of Montana, }
County of Deer Lodge. } ss.

I hereby certify that the within instrument was filed in my office on the 26th day of November, A. D. 1900, at 50 minutes past 4 o'clock P. M., and is recorded on page 632 of Book "S," Misc. Records of Deer Lodge County, State of Montana.

Attest my hand and seal:

M. MARTIN,

County Recorder.

Declaration of Homestead of Mary McCaffery. Compared. Indexed."

Whereupon the counsel for plaintiff did then and there object to said offer of evidence on the ground that the same was incompetent, irrelevant and immaterial, for the reason (1) that the said instrument offered in evidence was not stamped, as required by the laws of the United States in force at the date of its execution; and (2) that the notarial certificate of acknowledgment to said instrument offered in evidence was not stamped

as required by the laws of the United States in force at the date of its execution; and (3) that the filing for record of the same in its unstamped condition was in violation of said laws, and the record thereof was void and of no effect as against the rights of plaintiff. But the Court did overrule plaintiff's said objection, and did then and there allow and permit said evidence to be introduced.

To which ruling of the Court counsel for plaintiff did then and there except. Plaintiff prays that this her bill of exceptions to said ruling may be settled and allowed. And the foregoing bill of exception is hereby signed, sealed, settled and allowed this 7th day of April, A. D. 1903.

HIRAM KNOWLES, [L. S.]

Judge.

The plaintiff offered in rebuttal an exemplified copy of the records of the United States land office at Missoula, Montana, showing that on July 15th, 1896, the defendant Joseph McCaffery made homestead entry of the south half of the northeast quarter, the southeast quarter of the northwest quarter, and the northwest quarter of the southwest quarter, of section 31, township one south, range 15 west, Montana base and principal meridian, containing 160 acres; and that on December 16th, 1901, final certificate number 999 was issued to the said Joseph McCaffery for the said tract; and thereafter, on October 11th, 1902, a United States patent was issued to the said Joseph McCaffery for the said tract.

Which offer of evidence was by the Court refused un-

less plaintiff should promise to follow up said evidence with proof that defendant Joseph McCaffery had at some time actually resided upon said homestead tract, which counsel for plaintiff declared themselves unable to show; whereupon said offer was by the Court refused; to which ruling of the Court the plaintiff then and there by her counsel duly excepted.

Plaintiff presents this her bill of exception to said ruling and asks that the same be settled and allowed. And the foregoing bill of exception is hereby signed, sealed, settled and allowed this 7th day of April, A. D. 1903.

HIRAM KNOWLES, [L. S.]

Judge.

Counsel for plaintiff further offered in rebuttal evidence tending to sustain the allegation of the reply that for several years both before and after the filing of the said declaration of homestead, the principal use of a certain portion of the premises described in the complaint, which portion is in said reply described by metes and bounds, had been and was as tenement property.

In support of said allegation J. H. COLLINS, a witness in behalf of the plaintiff, testified that he knew the defendants Joseph and Mary McCaffery, and knew the house described in the reply as tenant property; that on or about the 12th day of May, 1901, he rented the same from defendant Joseph McCaffery, and moved into said house with his family; that the premises rented by him included the building (with the exception of a one-roomed wooden or frame addition or lean-to on the

(Testimony of J. H. Collins.)

rear thereof, which was reserved by said Joseph McCaffery), the yard in the rear of said building, and the woodshed; that defendant Joseph McCaffery told witness that he reserved said frame lean to or addition because he wanted to sleep there on account of holding possession; that said Joseph McCaffery showed witness the backyard where he would have room to hang clothes-lines, and the woodshed on the back end; that witness and his family occupied four rooms, being all of the brick portion of said house, and paid \$20 a month rental; that the roof of the porch in front of the north house, occupied by the McCafferys, extended across to the wall of the house occupied by witness; that there was access through witness' portion of the backyard to witness' woodshed and through the woodshed to the alley in the rear of the lot; that the frame addition was built right up against the brick part that witness occupied, and connected with it; that the part of the woodshed that witness used was separate from the other part; that witness judges the dwelling-houses on the lot to be within about eight feet of the sidewalk in front of the lot; that witness does not know whether anyone slept in the frame addition while he was there; that he saw a folding-bed in the frame addition but did not notice anything else in there; that witness saw Mr. McCaffery in there maybe 2 or 3 times, but only in the daytime; that witness could and did see into the frame addition from his pantry, through the window, and there was nothing to obstruct the view through the window, no curtain;

(Testimony of David G. Boyd.)

that there was no door connecting the frame addition and the brick part of the southerly house; that the porch did not extend across, that the roof ran over but the porch was separate.

On the same subject DAVID G. BOYD, a witness on behalf of the plaintiff, testified that he had resided in Anaconda a little over five years, and was acquainted with the premises described in the complaint; that in 1898 he rented the southerly house upon said premises, and occupied the same with his family consisting of a wife and three children; that the little frame addition or lean-to next to the kitchen was used by his children as a playroom and by his wife as a storeroom; that there was a woodshed next to the alley used by the witness for firewood; that there was a board fence between the premises occupied by witness and his family and the north part of the lot, which fence ran from the rear of the building occupied by witness to the woodshed. That the portion of the lot occupied by witness at that time backward to where the woodshed was was about the width of the building; that witness paid \$22.50 or \$25 a month as rental for said premises, and rented the same from the defendant Mary McCaffery; that witness occupied said premises about four months, and that the prior occupant of said premises was John Griffin and witness bought his furniture; that witness had nothing whatever to do with the front yard, and if it was ever attended to, it was attended to by the defendants McCafferys.

On the same subject J. T. DULIN, a witness on behalf of the plaintiff, testified that he knew the premises in controversy in this action; that about June, 1900, he examined the southerly house upon said premises with a view to renting it, and was shown the premises by one of the defendants' daughters; that witness saw two houses on the property, one on the north and one on the south, both fronting to the west; that it was the one on the south that witness looked at; that there was a fence on the rear of the lot dividing the lot into two portions; there was no division fence in front of the houses; there was a one-roomed frame addition built on to the back end of the house witness looked at; witness looked into this one-roomed addition and there was nothing in it except perhaps some old rags or something of that kind lying on the floor; there was nothing in the brick portion; that there was a woodshed on the back end of the lot which witness looked at; that there was a fence dividing the two lots at the back end at that time; that according to witness' recollection the fence ran all the way back; that witness did not remember what kind of a fence it was; witness did not rent the property. On cross-examination witness stated that he was certain that there was not a folding-bed in the frame addition; witness went to the door and looked in; witness had not special object or purpose in view in examining the property, further than renting it.

On the same subject W. E. PINEGAR, a witness on behalf of the plaintiff, testified that he was a civil engineer and surveyor by profession; that he is ac

(Testimony of W. E. Pinegar.)

quainted with lot 11, block 89, the premises in controversy; that he made a survey of said lot, he thinks, about the middle of March, 1901; that he made a map of the lot from his survey; that the date on the map is March 16th, 1901, and the map was probably made a couple of days after the survey was made; that the house on the north side of the lot, as represented on the map, witness thinks was occupied by Mr. McCaffery's people at the time he made the survey; that at the east end of the south house, as represented on the map, there is a frame shed; that was a partition in the woodshed on the back end of the lot and the map shows the woodshed and the partition; that the irregular line running from the house to the woodshed at the east end of the lot was a fence; on the map the hatched portion was a porch, covered by a roof connecting the two houses and the sidewalk leading to the porch is also represented; there was an entry between the two houses; the width of that entry between the two houses, as shown by the map, is four feet three inches at one point and six feet at another point; that the fence along the line that witness has drawn on the map between the two parts joined the brickhouse on the south portion of the lot at a point near the northeast corner of the house, which is the most northeasterly corner of the house, the fence began at that point and ran easterly about fifty-two feet, then it went southerly about twelve feet—there was a fence on that line, and from there to the woodshed it was fenced off too; that all the fence referred to was of about the same sort, consisting of a couple of rails

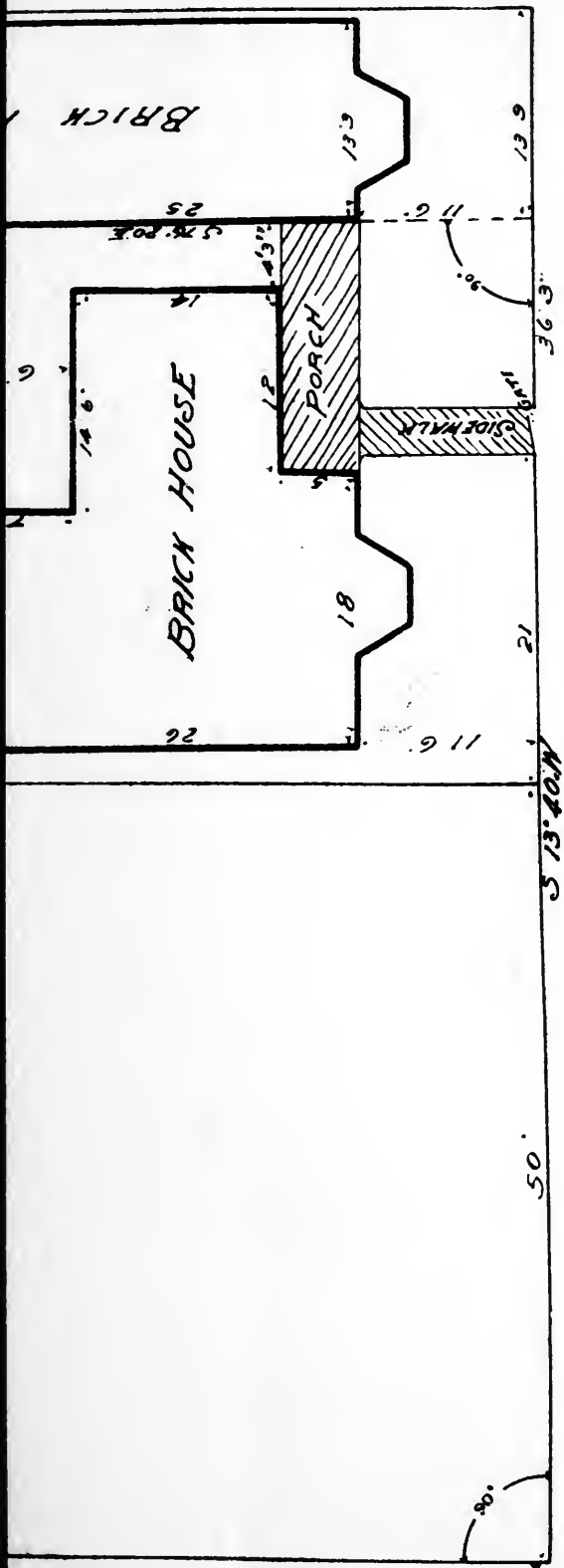
(Testimony of W. E. Pinegar.)

with boards nailed on; that on the north part of the property there was a building at the rear, the north-east corner of the lot, a log house on the corner, that there was a gate in the fence about opposite where the southerly brick building and its frame addition joined; the fence ran parallel with the northerly side of the frame building (addition); the fence was entirely up at that time along the length of it at the time witness made the survey; that the map is a correct representation of what it purports to represent; the description at the bottom of the map is a correct description of the lot that witness surveyed, the south side of that lot.

The map referred to by the witness was produced by him, and plaintiff offered the same in evidence, and the same was received in evidence without objection and marked Plaintiff's Exhibit No. 3, and the following is a copy of said map:

(The clerk will here insert a copy of said map.)





Cherry Street.

Description of house and premises on South portion of Lot No. 11, of Block No. 89, Anaconda, Montana, beginning at a point on the west end line of Lot No. 11, of Block No. 89, Original Townsite, Anaconda, Montana, from which the N. W. corner of said Lot bears N. 13 degrees 40 minutes East 36.25 feet, and from which the N. W. corner of said block bears N. 13 degrees 40 minutes E. 86.25 feet, and running thence S. 76 degrees 20 minutes E. 36.50 feet; thence N. 13 degrees 40 minutes E. 9.00 feet; thence S. 76 degrees 20 minutes E. 65 feet; thence S. 13 degrees 40 minutes W. 12 feet; thence S. 76 degrees 20 minutes E. 38.50 feet to a point on the east end line of lot No. 11; thence S. 13 degrees 40 minutes W. 10.75 feet to the S. E. corner of said Lot No. 11; thence N. 76 degrees 20 minutes W. 140.00 feet along the south side line of said Lot No. 11 to the S. W. corner of same; thence N. 13 degrees 40 minutes E. 13.75 feet along the west end of said Lot No. 11 to the place of beginning, containing in all 0.055 acres.

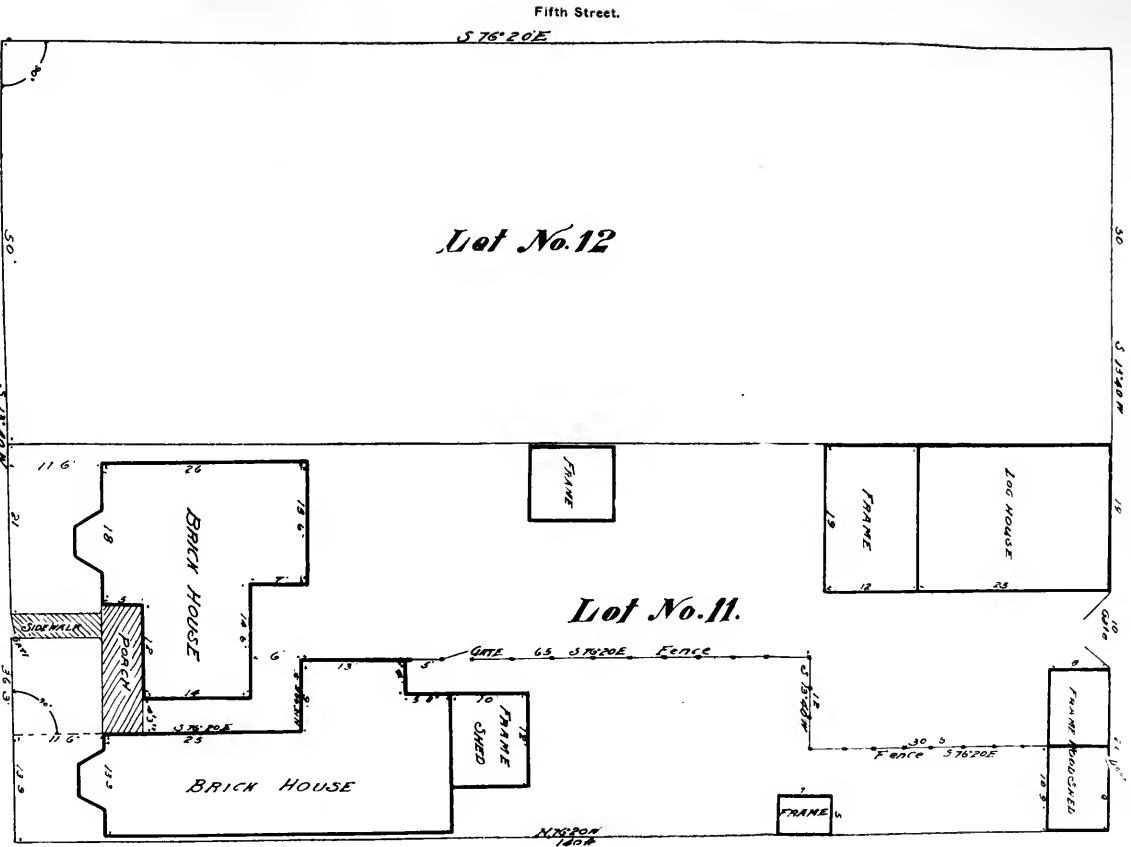
Plaintiff's Ex. 3. No. 203. Filed and entered Mar. 24, 1903. Geo. W. Sproule, Clerk, By T. B. Stephens, Deputy Clerk.

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Plat Showing Lots Nos. 11 and 12, Block No. 89, Anaconda, Mont., March 16th, 1901.

W. E. Pihagar, Surveyor.



Fifth Street.

S 76° 20' E

Lot No. 12

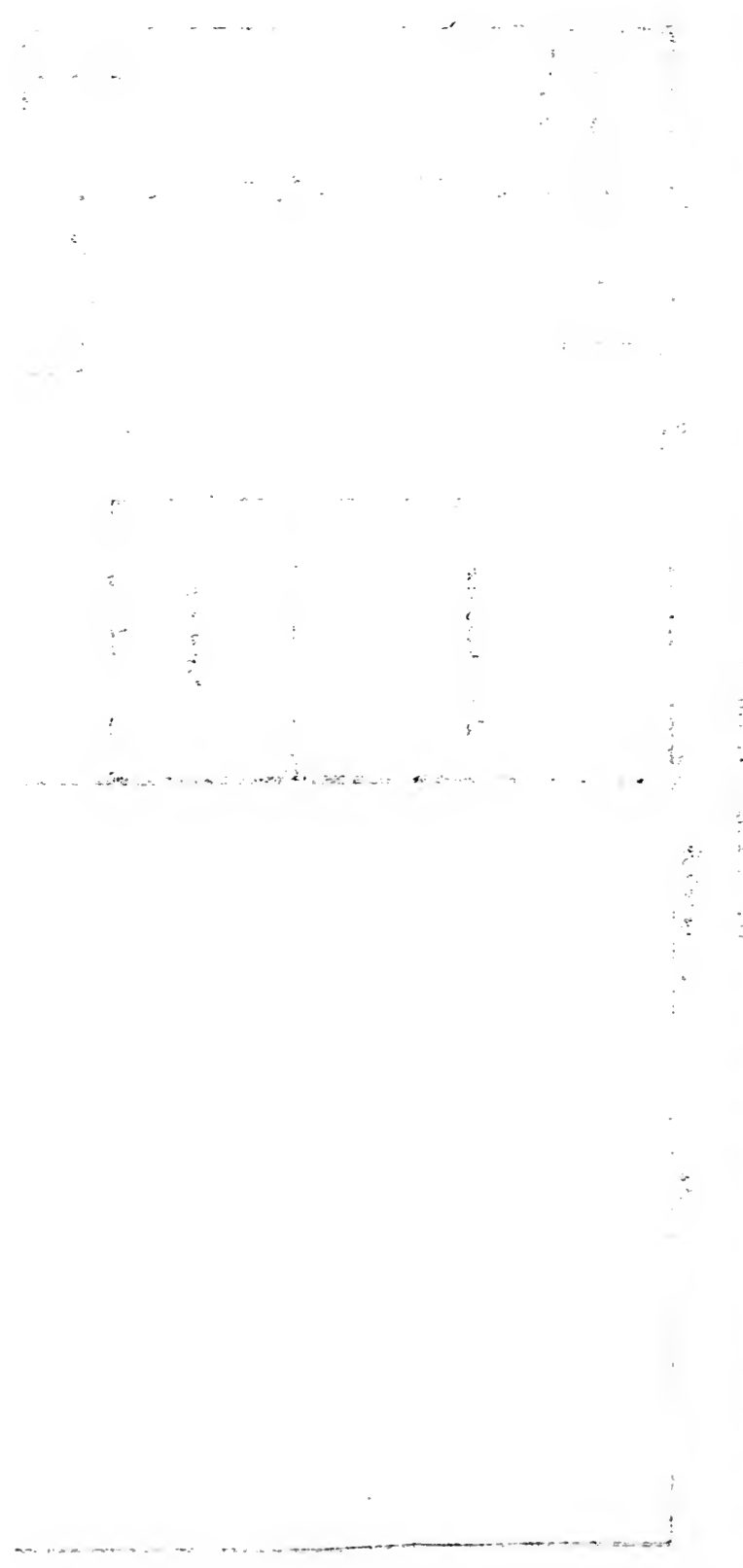
Lot No. 11.

Cherry Street.

Description of house and premises on South portion of Lot No. 11, of Block No. 89, Anaconda, Montana, beginning at a point on the west end line of Lot No. 11, of Block No. 89, Original Townsite, Anaconda, Montana, from which the 13 degrees 40 minutes E. 86.25 feet, and running thence S. 26 degrees 30 minutes E. 26.50 feet; thence N. 14 degrees 40 minutes E. 2.00 feet; thence S. 76 degrees 20 minutes E. 66 feet; thence S. 13 degrees 40 minutes W. 12 feet; thence S. 76 degrees 20 minutes E. 28.50 feet to a point on the east line of Lot No. 11; thence S. 13 degrees 40 minutes W. 10.75 feet to a point on the S. 76 degrees 20 minutes E. corner of same; thence N. 13 degrees 40 minutes W. 13.25 feet along the west end of said Lot No. 11 to the place of beginning, containing in all 0.055 acres.

Platting Ex. A. No. 29. Filed and entered Mar. 24, 1901. Geo. W. Sprague, Clerk, by T. B. Stephens, Deputy Clerk.

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(Testimony of Lizzie McCaffery.)

Said witness further stated that the description by metes and bounds in plaintiff's reply of the property therein referred to as tenant property correctly describes the portion of the premises in controversy occupied by the southerly house, and included within the fence referred to running from the northeast corner of the southerly house to the woodshed. There was no division fence in front of the houses nor between them.

In addition to the foregoing testimony offered by plaintiff in rebuttal, the defendants showed by the testimony of witness LIZZIE McCAFFERY, that at the date of the execution of and filing for record of the alleged declaration of homestead, the four rooms in the brick portion of said southerly house were rented to one Moohr and wife, and that defendants Joseph McCaffery and his wife Mary McCaffery were alternately occupying the frame addition to the said building as a sleeping-room; said witness further testified that for four or five years prior to said date the said southerly building had been rented to tenants in a similar manner; that the fence built from the northeast corner of the southerly house was built of drygoods boxes and strips, was about three feet high and was built to keep the McCaffery chickens out of the southerly yard because they were bothersome to the occupants of the southerly house, and also for the purpose of keeping the chickens out of the garden on the south side, which was kept by the occupants and the McCafferys jointly; that lot 11

described in plaintiff's complaint and covered by defendant's homestead declaration contained less than one-fourth of an acre of land, which fact was shown by the testimony and uncontradicted.

Upon this evidence the plaintiff moved the Court to instruct the jury as follows, to wit:

“Instruction No. 2: Section 1670 of the Civil Code of Montana provides:

The homestead consists of the dwelling-house in which the claimant resides and the land on which the same is situated, selected as in this title provided.

Under the provisions of this section, the claimant cannot hold two dwelling-houses, one of which he occupies as a residence and the other he lets to tenants. It is the principal use which is made of a house which determines whether it is to be regarded as the residence of the claimant or not. Thus, if the principal use of a house is as the permanent home of the claimant's family, it does not destroy its character as a homestead if one or more rooms are used as a shop in which the claimant carries on his trade or business. In the same manner, if the principal use of a house is as a tenement building, it does not make it the homestead or part of the homestead because some member of the claimant's family may occasionally use one of its rooms as a sleeping apartment.

The above section 1670 also requires that the homestead must be selected in the manner required by law. The requirements of the law are defined to you in these instructions.”

Which motion was by the Court overruled and said instruction refused; to which ruling of the Court the plaintiff then and there in open court, and while the jury was still at the bar of the Court, by her counsel duly excepted.

And plaintiff presents this her bill of exception to said ruling, and asks that the same be signed, settled and allowed.

The foregoing bill of exception is signed, settled and allowed this 7th day of April, 1903.

HIRAM KNOWLES, [L. S.]

Judge.

And upon the said foregoing evidence the plaintiff, by her counsel, further moved the Court to instruct the jury as follows, to wit:

“Instruction No. 6: A homestead cannot include two dwelling-houses, one of which is occupied by the claimant and the other let to tenants.

You are instructed that if you find from the evidence that at the time of filing the homestead declaration in question there were two dwelling-houses upon the premises in controversy, the principal use of one of which was as a residence for defendants and the principal use of the other was as a tenement, then the latter house with the land appurtenant thereto was not properly included in the alleged homestead declaration. Whatever the effect of said declaration as to the building in which the defendants lived, the tenement building, if you find it to have been such as herein defined, remained subject to the lien of plaintiff's deficiency judgment, and in that event plaintiff is entitled to recover such tenement

building with its appurtenant land regardless of the question as to whether said alleged homestead declaration was valid or not."

Which motion was by the Court overruled and said instruction refused; to which ruling of the Court the plaintiff then and there in open court, and while the jury was still at the bar of the Court, by her counsel duly excepted.

Plaintiff presents this her bill of exception to said ruling and asks that the same be signed, settled and allowed.

The foregoing bill of exception is signed, settled and allowed this 7 day of April, 1903.

HIRAM KNOWLES, [L. S.]

Judge.

The foregoing bills of exception are hereby respectfully submitted.

CHAS. E. SACKETT,

E. B. HOWELL,

Attorneys for Plaintiff.

Service of the foregoing proposed bills of exception, and the receipt of a copy of the same, are hereby acknowledged this fourth day of April, A. D. 1903.

J. H. DUFFY,

RODGERS & RODGERS,

Attorneys for Defendants.

In the Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Notice as to Presentation of Bills of Exception.

To Rogers & Rodgers, and J. H. Duffy, Esq., Attorneys
for Defendants.

You are hereby notified that the foregoing bills of exception will be presented to the Judge of the above-entitled Court on Saturday, April 4th, 1903, for the settlement of the same during the term at which said cause was tried.

CHAS. E. SACKETT,

E. B. HOWELL,

Attorneys for Plaintiff.

Service of the foregoing notice, and the receipt of a copy thereof, acknowledged this fourth day of April, A. D. 1903.

J. H. DUFFY,

RODGERS & RODGERS,

Attorneys for Defendants.

[Endorsed]: Title of Court and Cause. Bill of Exceptions. Filed and Entered April 7, 1903. Geo. W. Sproule, Clerk. By T. B. Stephens, Deputy Clerk.

And thereafter, to wit, on the 9th day of April, 1903, the plaintiff filed her assignment of error and petition for writ of error herein, which said assignment of error and petition are as follows, to wit:

In the Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Petition for Writ of Error.

Comes now the plaintiff in the above-entitled cause, Clara E. Sackett, and says that on the 26th day of March, 1903, the jury in the above-entitled cause returned a verdict in favor of the defendants and against the plaintiff, and that thereafter, on the ——— day of April, 1903, judgment was entered herein in favor of the said defendants and against the said plaintiff for the costs of said action taxed at the sum of \$132.90.

That in said judgment and the proceedings herein had prior thereto in this court certain errors were committed to the prejudice of said plaintiff, all of which will appear more in detail from the assignment of errors which are on file with this petition.

Wherefore, the plaintiff prays that a writ of error may issue in her behalf from the United States Circuit Court of Appeals for the Ninth Circuit, for the correc-

tion of the errors complained of; and that a transcript of the record and proceedings and papers in this case duly authenticated, may be sent to the Circuit Court of Appeals for the Ninth Circuit; and for such other orders and processes as may cause said errors to be corrected and the said judgment reversed by the said United States Circuit Court of Appeals for the Ninth Circuit.

Plaintiff further prays that an order be made fixing the amount of security which the plaintiff shall give and furnish upon said writ of error, and that upon the giving of such security all further proceedings in this court be suspended and stayed until the determination of said writ of error by the United States Circuit Court of Appeals for the Ninth Circuit.

Dated this 8th day of April, A. D. 1903.

CLARA E. SACKETT.

E. B. HOWELL.

Due service of the foregoing petition for writ of error by copy thereof, together with a copy of the assignment of errors accompanying said petition, are hereby acknowledged this 8th day of April, 1903.

Attorneys for Defendants.

In the Circuit Court of the United States, Ninth Circuit, District of Montana.

CLARA E. SACKETT,	} Plaintiff,
vs.	
MARY McCAFFERY and JOSEPH	} Defendants.
McCAFFERY,	

Assignment of Errors.

Comes now the plaintiff in the above-entitled action, Clara E. Sackett, by her attorneys, Messrs, Charles E. Sackett and E. B. Howell, and says that in the record and proceedings in this cause there is manifest error in this, to wit:

First.—The Court erred in admitting in evidence the alleged homestead declaration of defendant Mary McCaffery for the reason (1) that the said instrument was not stamped as required by the laws of the United States in force at the date of its execution; and (2) that the notarial certificate of acknowledgment to said instrument was not stamped as required by the laws of the United States at the date of its execution; and (3) that the filing of record of the same in its unstamped condition was in violation of said laws, and the record thereof was void and of no effect as against the rights of the plaintiff.

Said homestead declaration being in words and figures as follows, to wit:

“Know all men by these presents: That I do hereby certify that I am the wife of Joseph McCaffery, and that I do now, at the time of making this declaration, actually reside with my family on the land and premises hereinafter described. That the land and premises on which I reside are bounded and described as follows, to wit: Lot number (11) in block number (89), in the city of Anaconda, Deer Lodge County, Montana. That it is my intention to use and claim the said lot of land and premises above described, together with the dwelling-house thereon, and its appurtenances, as a homestead. And I do hereby select and claim the same as a homestead. That I make this declaration for the joint benefit of myself and husband, and I declare that my husband has not made a declaration of homestead.

That the actual cash value of said property I estimate to be \$2,000.00.

In witness whereof I have hereunto set my hand and seal this 24th day of November, A. D. 1900.

her

MARY X McCAFFERY. [Seal]

mark

Witness to mark:

J. T. CASEY.

State of Montana, }
 County of Deer Lodge. } ss.

On this 24th day of November, A. D. 1900, before me, John T. Casey, a notary public in and for the State and County aforesaid, personally appeared Mary McCaffery, known to me to be the person whose name is subscribed

to the within instrument, and acknowledged to me that she executed the same.

In witness whereof I have hereunto set my hand and affixed my notarial seal the day and year first above written.

[Notarial Seal]

JOHN T. CASEY,

Notary Public in and for Deer Lodge County, Montana.

[Endorsed]:

State of Montana, } ss.
County of Deer Lodge. }

I hereby certify that the within instrument was filed in my office on the 26th day of November, A. D. 1900, at 50 minutes past 4 o'clock P. M., and is recorded on page 632 of Book "S," Misc. Records of Deer Lodge County, State of Montana.

Attest my hand and seal:

M. MARTIN,

County Recorder.

Declaration of Homestead of Mary McCaffery. Compared. Indexed."

Second.—The Court erred in rejecting the following evidence offered by the plaintiff, to wit: An exemplified copy of the records of the United States land office of Missoula, Montana, showing that on July 15th, 1896, the defendant Joseph McCaffery made homestead entry of a tract of 160 acres in section 31, township one south, range 15 west, Montana base and principal meridian, and that on December 16th, 1901, final certificate No. 999 was issued to the said Joseph McCaffery for the said tract; and thereafter, on October 11th, 1902, a United

States patent was issued to the said Joseph McCaffery for the said tract.

Third.—The Court erred in refusing to give to the jury the following instruction requested by plaintiff:

“Instruction No. 2: Section 1670 of the Civil Code of Montana provides; The homestead consists of the dwelling-house in which the claimant resides and the land on which the same is situated, selected as in this title provided. Under the provision of this section, the claimant cannot hold two dwelling-houses, one of which he occupies as a residence and the other he lets to tenants.

It is the principal use which is made of a house which determines whether it is to be regarded as a residence of the claimant or not. Thus, if the principal use of a house is as the permanent home of the claimant’s family, it does not destroy its character as a homestead if one or more rooms are used as a shop in which the claimant carries on his trade or business. In the same manner, if the principal use of a house is as a tenement building, it does not make it the homestead or part of the homestead because some member of the claimant’s family may occasionally use one of its rooms as a sleeping apartment.

The above section 1670 also requires that the homestead must be selected in the manner required by law.

The requirements of the law are defined to you in these instructions.”

Fourth.—The Court erred in refusing to give to the jury the following instruction requested by the plaintiff.

“Instruction No. 6: A homestead cannot include two

dwelling-houses, one of which is occupied by the claimant, and the other let to tenants.

You are instructed that if you find from the evidence that at the time of filing the homestead declaration in question there were two dwelling-houses upon the premises in controversy, the principal use of one of which was as a residence for the defendants, and the principal use of the other was as a tenement, then the latter house with the land appurtenant thereto was not properly included in the alleged homestead declaration.

Whatever the effect of said declaration as to the building in which the defendants lived, the tenement building, if you find it to have been such as herein defined, remained subject to the lien of plaintiff's deficiency judgment, and in that event plaintiff is entitled to recover such tenement building with its appurtenant land, regardless of the question as to whether said alleged homestead declaration was valid or not."

Dated this 8th day of April, A. D. 1903.

CHARLES E. SACKETT,

E. B. HOWELL,

Attorneys for Plaintiff.

*In the Circuit Court of the United States, Ninth Circuit,
District of Montana.*

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

State of Montana, }
County of Deer Lodge. } ss.

W. H. Trippet, being duly sworn, says that he is a citizen of the United States, of the State of Montana, and of the county of Deer Lodge, in said State; that he is over the age of 21 years; that he was one of the attorneys for the plaintiff in the above-entitled cause on the trial thereof; that on the 8th day of April, A. D. 1903, at the city of Anaconda, in the said county of Deer Lodge, he served the annexed petition for a writ of error in said cause, and the assignment of errors in said cause attached to said petition on J. H. Duffy and H. W. Rodgers (of the firm of Rodgers and Rodgers), attorneys for the defendants in said cause, by delivering to said J. H. Duffy and H. W. Rodgers a copy of said petition for a writ of error and a copy of said assignment of error, attached together as hereto attached, and exhibiting the original to them, and which service was at the office of said J. H. Duffy, attorney, in the said city of Ana-

ica, for the Ninth Circuit, in and for the State and District of Montana, held at the courtroom in the city of Butte, State of Montana, on the ninth day of April, A. D. 1903. Present: Honorable HIRAM KNOWLES, District Judge.

The plaintiff, Clara E. Sackett, having this day filed her petition for a writ of error from the decision and judgment thereon made and entered herein, to the United States Circuit Court of Appeals for the Ninth Circuit, together with the assignment of errors within due time, and also praying that an order be made fixing the amount of security which defendant should give and furnish upon said writ of error, and that upon the giving of said security, all further proceedings of this court be suspended and stayed until the determination of said writ of error by said United States Circuit Court of Appeals for the Ninth Circuit, and said petition having this day been allowed:

Now, therefore, it is ordered, that upon the said plaintiff, Clara E. Sackett, filing with the clerk of this Court a good and sufficient bond in the sum of five hundred dollars, to the effect that if the said plaintiff, who is also plaintiff in error, shall prosecute the said writ of error to effect, and answer all damages and costs if she fail to make her plea good, and shall pay the judgment for costs, amounting to the sum of \$132.90, heretofore entered in said cause in this court against said plaintiff, and in favor of the above-named defendants, in case said writ of error be determined against her by said United States Circuit Court of Appeals for the Ninth Circuit;

then the said obligation to be void; otherwise to remain in full force and virtue, the said bond to be approved by the Court; that all further proceedings in this court be, and they are hereby, suspended and stayed until the determination of said writ of error by the said United States Circuit Court of Appeals.

HIRAM KNOWLES,
Judge.

[Endorsed]: No. 203. Title of Court and Cause. Order Allowing Writ of Error and Fixing Amount of Bond. Filed and entered April 9th, 1903. Geo. W. Sproule, Clerk. Chas. E. Sackett and E. B. Howell, Attorneys for Plaintiff.

And thereafter, to wit, on the 9th day of April, 1903, a supersedeas and appeal bond, duly approved, was filed herein, which said bond and approval is as follows, to wit:

*In the Circuit Court of the United States, Ninth Circuit,
District of Montana.*

CLARA E. SACKETT,		Plaintiff,
vs.		
MARY McCAFFERY and JOSEPH McCAFFERY,		Defendants.

Supersedeas and Appeal Bond.

Know all men by these presents, that Clara E. Sack-

ett, as principal, and the American Bonding Company of Baltimore, a corporation, as surety, are held and firmly bound unto Mary McCaffery and Joseph McCaffery, the defendants above named, in the sum of five hundred dollars, to be paid to the said Mary McCaffery and Joseph McCaffery, their heirs, executors, administrators or assigns, to which payment, well and truly to be made, we bind ourselves, and each of us jointly and severally, and our and each of our representatives, executors, administrators, successors and assigns, firmly, by these presents.

Sealed with our seals and dated this 9th day of April, A. D. 1903.

Whereas, the above-named plaintiff, Clara E. Sackett, has sued out a writ of error to the United States Circuit Court of Appeals for the Ninth Circuit, to reverse the judgment in the above-entitled cause by the Circuit Court of the United States for the District of Montana,

And whereas a judgment for costs in said cause, amounting to \$132.90, has been entered in the above-entitled court against said plaintiff and in favor of the above-named defendants:

Now, therefore, the condition of this obligation is such that, if the above-named Clara E. Sackett shall prosecute said writ of error to effect and answer all interest, costs and damages if she shall fail to make her plea good, and shall pay said judgment for costs, with interest thereon, in case said writ of error be determined against her by said United States Circuit Court of Ap-

peals for the Ninth Circuit, then this obligation to be void, otherwise to remain in full force and effect.

[Seal] AMERICAN BONDING COMPANY OF
BALTIMORE,

By W. M. BICKFORD,
Vice-President.

Attest: CHAS. S. PASSMORE,
Assistant Secretary.

Sufficiency of surety of foregoing obligation approved
this 9th day of April, A. D. 903.

HIRAM KNOWLES,
Judge.

State of Montana, }
County of Silver Bow. } ss.

On this 9th day of April, A. D. 1903, before me, the subscribed notary public for the State of Montana, residing in the city of Butte, came Chas. S. Passmore, assistant secretary of the American Bonding Company of Baltimore, Md., to me personally known to be the assistant secretary of the said the American Bonding Company of Baltimore, a corporation described in and which executed as surety the annexed bond, and being by me first duly sworn, stated that W. M. Bickford is vice-president of the American Bonding Company of Baltimore, and that the said W. M. Bickford, as vice-president, and Chas. S. Passmore, as assistant secretary, duly executed the preceding instrument by order and authority of the directors of the said the American Bonding Company of Baltimore; and that the seal affixed to the preceding

instrument is the corporate seal of the said company; that the said corporate seal was duly affixed by the authority of the directors of the said company; that the said the American Bonding Company of Baltimore, of the State of Maryland, is duly and legally incorporated under the laws of the State of Maryland, is authorized under its charter to transact and is transacting the business of a Surety Company in the State of Montana; that said company has complied with all the laws of the State of Montana relating to surety companies doing business in that State; and is duly licensed and legally authorized by such State to qualify as sole surety on the bond hereto annexed; that the said company is authorized by its articles of incorporation, and by its by-laws, to execute the said bond; and that said company has assets consisting of capital stock paid in cash and surplus over and above all its liabilities of every kind, exceeding the sum of one million dollars (\$1,000,000.00) and that said W. M. Bickford, as vice-president, and Chas. S. Passmore, as assistant secretary of the said company, have been duly authorized by the board of directors of the company to execute the foregoing bond.

CHAS. S. PASSMORE,
Assistant Secretary.

Subscribed and sworn to before me, this 9th day of April, A. D. 1903.

My commission expires Sept., 1903.

[Seal]

E. G. SMITH,

Notary Public in and for Silver Bow County, Montana.

[Endorsed]: Title of Court and Cause. Supersedeas and Appeal Bond. Filed April 9, 1903. Geo. W. Sproule, Clerk.

And thereafter, to wit, on the 9th day of April, 1903, a writ of error duly issued herein, which said writ of error and answer of the Judges thereto are hereto annexed and are as follows, to wit:

In the Circuit Court of the United States, Ninth Circuit, for the District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Writ of Error.

United States of America—ss.

The President of the United States of America to the Honorable Judge of the Circuit Court of the United States, Ninth Circuit, in and for the District of Montana, Greeting:

Because in the records and proceedings, as also in the rendition of the judgment of a plea, which is in the said Circuit Court before you, between Clara E. Sackett, plaintiff in said cause and plaintiff in error, and Mary McCaffrey and Joseph McCaffrey, defendants in said said cause and defendants in error, a manifest error

hath happened to the great damage of the said Clara E. Sackett, as is said and appears by the petition herein. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid, in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the records and proceedings aforesaid, with all things concerning the same, to the United States Circuit Court of Appeals for the Ninth Circuit, together with this writ, so that you have the same at the city of San Francisco, in the State of California, on the ninth of May next, in the said Circuit Court of Appeals, to be then and there held, that the record and proceedings aforesaid being inspected, the said Circuit Court of Appeals, may cause further to be done therein to correct that error, what of right and according to the laws and customs of the United States should be done.

Witness the Honorable MELVILLE W. FULLER,
Chief Justice of the Supreme Court of the United States, the ninth day of April, in the year of our Lord one thousand nine hundred and three.

[Seal]

GEO. W. SPROULE,

Clerk of the United States Circuit Court, Ninth Circuit,
District of Montana.

Allowed by:

HIRAM KNOWLES,

Judge.

United States of America, }
 District of Montana. } ss.

In obedience to the command of the above writ, I herewith transmit to the United States Circuit Court of Appeals a duly certified transcript of the records and proceedings in the above-entitled cause, with all things concerning the same.

In witness whereof, I hereto subscribe my name and affix the seal of the Circuit Court of the United States, Ninth Circuit, District of Montana.

[Seal]

GEO. W. SPROULE,

Clerk of the Circuit Court of the United States, Ninth Circuit, District of Montana.

Due service of the foregoing writ of error, by copy thereof, admitted this 10th day of April, 1903.

J. H. DUFFY and

RODGERS & RODGERS,

Attorneys for Defendants in Error.

[Endorsed]: Original. No. 203. In the United States Circuit Court, Ninth Circuit, District of Montana. Clara E. Sackett, Plf., vs. Mary & Joseph McCaffrey, Defts. Writ of Error. Filed and Entered Apr. 10, 1903. Geo. W. Sproule, Clerk. By T. B. Stephens, Deputy Clerk.

And thereafter to wit, on the 9th day of April, 1903, a citation was duly issued herein, which said citation is hereto annexed and is as follows, to wit:

In the Circuit Court of the United States, Ninth Circuit, for the District of Montana.

CLARA E. SACKETT,

Plaintiff,

vs.

MARY McCAFFERY and JOSEPH
McCAFFERY,

Defendants.

Citation.

United States of America—ss.

The President of the United States of America to Mary McCaffery and Joseph McCaffery, Greeting:

You are hereby instructed and admonished to be and appear in the United States Circuit Court of Appeals, for the Ninth Circuit, at the city of San Francisco, State of California, within thirty days from and after the date this citation bears, pursuant to a writ of error filed in the clerk's office of the Circuit Court of the United States, in and for the District of Montana, wherein Clara E. Sackett is plaintiff in error and you are defendants in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error as in said writ of error mentioned, should not be corrected and why speedy justice should not be done the parties in that behalf.

Witness the Honorable HIRAM KNOWLES, Judge of the Circuit Court of the United States, in and for the District of Montana, this 9th day of April, 1903.

HIRAM KNOWLES,

Judge.

[Seal] Attest: GEO. W. SPROULE,

Clerk.

Due service of the foregoing citation is hereby admitted, by copy thereof, this 10th day of April, 1903.

J. H. DUFFY and

RODGERS & RODGERS,

Attorneys for Defendants in Error.

[Endorsed]: In the United States Circuit Court, Ninth Circuit, District of Montana. Clara E. Sackett, Plf., vs. Mary and Joseph McCaffrey, Dfts. Citation. Filed and Entered Apr. 10, 1903. Geo. W. Sproule, Clerk. By T. B. Stephens, Deputy Clerk.

Clerk's Certificate to Transcript.

United States of America, }
 District of Montana. } ss.

I, George W. Sproule, clerk of the United States Circuit Court for the District of Montana, do hereby certify and return to the Honorable the United States Circuit Court of Appeals for the Ninth Circuit, that the foregoing volume, consisting of 63 pages, numbered consecutively from 1 to 63, is a true and correct transcript of the pleadings, process, orders, judgment and all pro-

ceedings had in said cause, and of the whole thereof, as appear from the original records and files of said court in my possession; and I do further certify and return that I have annexed to said transcript and included within said paging the original citation and writ of error issued in said cause.

I further certify that the costs of the transcript of record amount to the sum of twenty-three and 45-100 dollars (\$23.45), and have been paid.

In witness whereof, I have hereunto set my hand and affixed the seal of the said United States Circuit Court for the District of Montana, at Helena, Montana, this 20th day of April, A. D. 1903.

[Seal]

GEO. W. SPROULE,

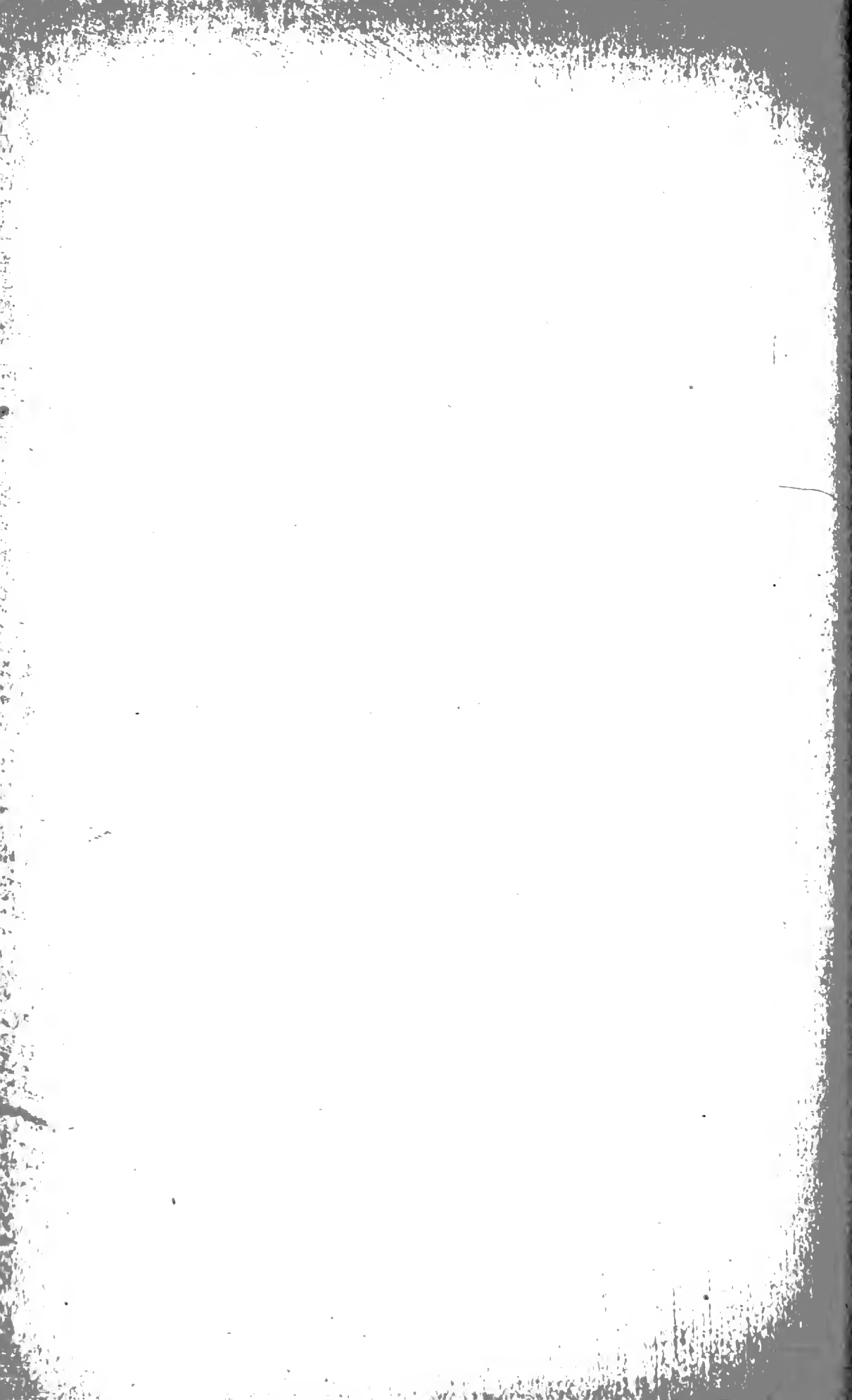
Clerk.

[Endorsed]: No. 957. In the United States Circuit Court of Appeals for the Ninth Circuit. Clara E. Sackett, Plaintiff in Error, vs. Mary McCaffrey and Joseph McCaffrey, Defendants in Error. Transcript of Record. Upon Writ of Error to the United States Circuit Court for the District of Montana.

Filed April 30, 1903.

F. D. MONCKTON,

Clerk.



No. 957.

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

CLARA E. SACKETT,
Plaintiff in Error,

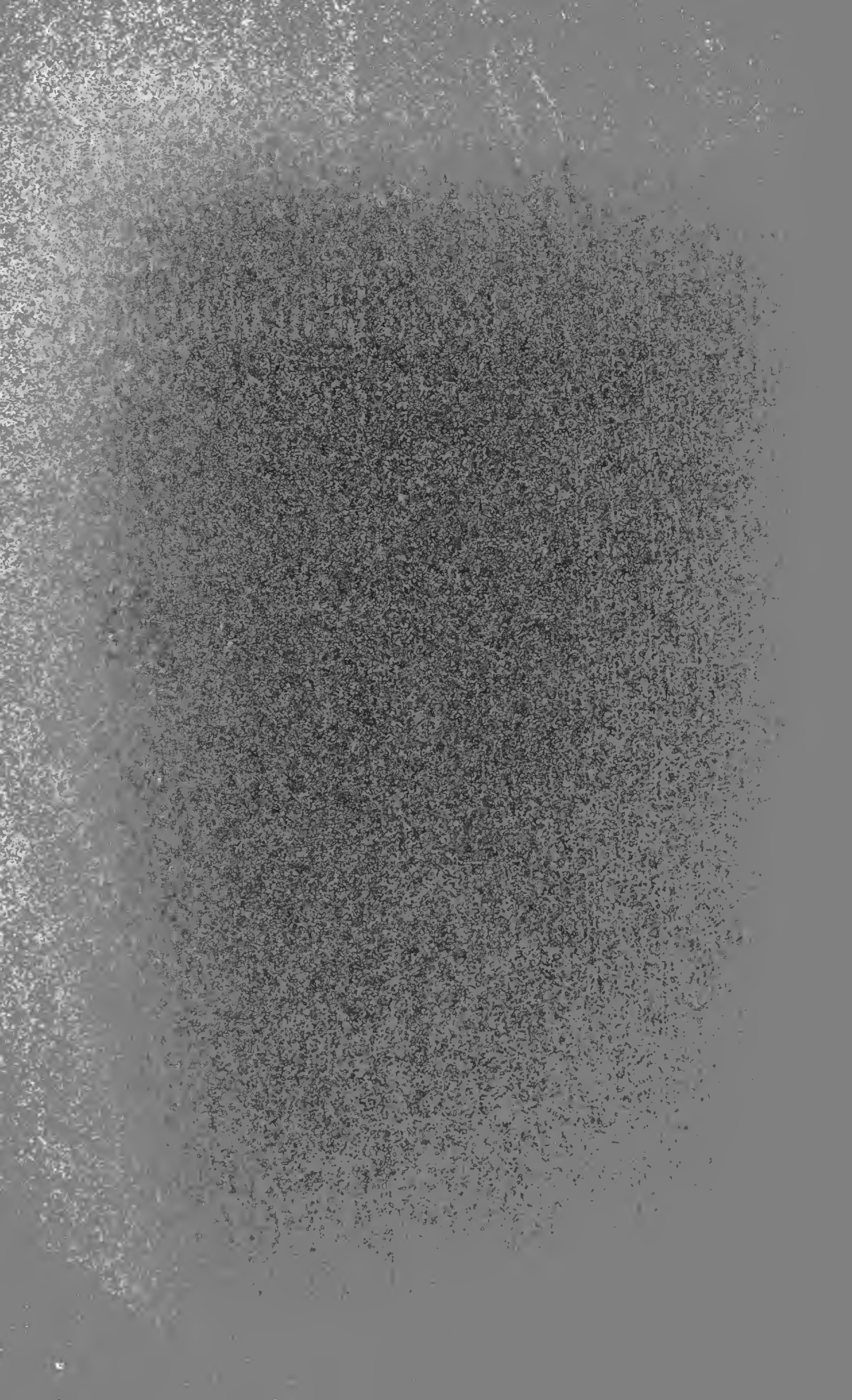
vs.

MARY McCAFFREY and JO-
SEPH McCAFFREY,
Defendants in Error.

FILED
SEP 19 1903

**BRIEF AND ARGUMENT FOR THE APPELLANT
CLARA E. SACKETT**

E. B. HOWELL,
CHARLES E. SACKETT,
Counsel for Plaintiff in Error.



IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

CLARA E. SACKETT.

Plaintiff in Error,

vs.

MARY McCAFFREY and JO-
SEPH McCAFFREY.

Defendants in Error.

STATEMENT OF THE CASE.

This is an action in ejectment to recover Lot 11 in Block 89 in the City of Anaconda, Montana. The complaint alleges that the plaintiff is a resident and citizen of the State of New York, and that the defendants are residents and citizens of Deer Lodge County, Montana; that the matter in dispute in the action, exclusive of interest and costs, exceeds the sum of \$2,000.00; that on the 28th day of May, 1902, plaintiff was and ever since has been and now is the owner and entitled to the possession of said premises, but that the same is unlawfully withheld from her by the defendants.

The answer admits the allegations of the complaint as to the respective residence and citizenship of plaintiff and defendants; denies the ownership of plaintiff in said premises and the wrongful withholding by defendants, and alleges that defendants have at all times mentioned in the complaint been in the lawful possession of said premises. The answer further alleges that on November 24th, 1900, the defendants were and now are husband and wife, and that at all of said times defendant Mary McCaffery resided and now resides, with her said husband in and upon said premises, and that during said times defendants owned the same in fee simple and that the same constituted defendant's homestead. Said answer further alleges:

"3. That on the 24th day of November, A. D. 1900, the said defendant, Mary McCaffery, (her husband, the said defendant, Joseph McCaffery, not having made such selection), executed and acknowledged in the same manner as a grant of real property is acknowledged, a declaration of homestead upon and for the above-described land, and the dwelling-house thereon and its appurtenances.

"4. That said declaration of homestead so made and executed as aforesaid contained a statement that her husband had not made such declaration of homestead, and that she, the said Mary McCaffery, therefore made such declaration of homestead for the joint benefit of herself and her said husband, Joseph McCaffery, and a statement that she, the said Mary McCaffery, the person making such declaration of homestead, was residing upon said premises and claimed them as a homestead, and said declaration of homestead contained a description of the above-described premises so claimed as a homestead as aforesaid,

and also an estimate of the actual cash value of said premises.”

Said answer further alleges that said homestead declaration was filed for record in the office of the Clerk of the County of Deer Lodge on November 26th, 1900, and that the land so claimed as a homestead did not exceed one-fourth of an acre in quantity or \$2,500.00 in value.

By her reply, the plaintiff puts in issue defendant's ownership of said premises after May 12th, 1900, and their homestead character, the execution, acknowledgement and recording of said homestead declaration as alleged in the answer, but admits that on the 24th day of November, 1900, the defendant, Mary McCaffery, executed and acknowledged an instrument purporting to be a declaration of homestead on the premises in controversy, in words and figures as follows, to-wit:

“Know all men by these presents: That I do hereby certify that I am the wife of Joseph McCaffery, and that I do now, at the time of making this declaration, actually reside with my family on the land and premises hereinafter described.

“That the land and premises on which I reside are bounded and described as follows, to-wit: Lot number (11) in Block number (89), in the City of Anaconda, Deer Lodge County, Montana. That it is my intention to use and claim the said lot of land and premises above described, together with the dwelling-house thereon, and its appurtenances, as a homestead.

“And I do hereby select and claim the same as a homestead. That I make this declaration for the joint benefit of myself and husband, and I declare that my husband has

not made a declaration of homestead. That the actual cash value of said property I estimate to be

“In witness whereof I have hereunto set my hand and seal this 24th day of November, A. D. 1900.

“Witness to mark: J. T. Casey.

HER

“MARY X McCAFFERY (SEAL.)

MARK

“STATE OF MONTANA,
“COUNTY OF DEER LODGE. } ss.

“On this 24th day of November, A. D. 1900, before me, John T. Casey, a Notary Public, in and for the County and State aforesaid, personally appeared Mary McCaffery, known to me to be the person whose name is subscribed to the within instrument, and acknowledged to me that she executed the same.

“In witness whereof I have hereunto set my hand and affixed my notarial seal the day and year first above written.

“(NOTARIAL SEAL)

JOHN T. CASEY,

“*Notary Public in and for Deer Lodge County, Montana.*”

The plaintiff admits that on the 26th day of November, 1900, defendant Mary McCaffery filed this instrument and had the same recorded in the office of the said County Clerk, and that this is the identical instrument described in the answer as a declaration of homestead, but that the same is not a declaration of homestead for the reason that it contained no estimate of the value of said premises, and was at the time of such filing and at all subsequent times void.

Said reply further alleges, "That at the time of the filing of the alleged declaration of homestead, and long prior thereto, and ever since the time of said filing, the said Mary McCaffery and her husband, or either of them, did not reside on that part of said lot," which the reply proceeds to describe by metes and bounds, (Tr. 16, l. 9 ff.), "but that the same was occupied by and rented to tenants of defendant Mary McCaffery; and that the same was not, and could not have been, a homestead, or any part of a homestead of said defendant, Mary McCaffery, and her husband or either of them. That said tenant premises, at the time of the filing of said alleged declaration, and long prior thereto, and ever since said filing, have been entirely separate and distinct from the premises used by defendants, or either of them as a home," etc. (Tr. p. 16 f.)

To prove her title to the premises in controversy, plaintiff introduced in evidence exemplified copies of the judgment roll, order of sale, and judgment docket showing a deficiency judgment in the case of Mrs. M. A. Sackett vs. Mary McCaffery and Joseph McCaffery. This case had been brought in the District Court of the Third Judicial District of Montana in and for said County of Deer Lodge to foreclose a mortgage upon other property belonging to defendants. After the sale of said mortgaged property, judgment for a deficiency of \$1,119.68 was docketed against said defendants.

Plaintiff also introduced in evidence an exemplified copy of an execution on said deficiency, the Sheriff's return on which showed the sale of the premises in controversy

in this action in two tracts, the first being described by metes and bounds, and being the tract described by metes and bounds in the reply as tenant property (Tr. 16, l. 9 ff.), and shown on the map of the premises (Tr. 36) as the portion of Lot 11 lying to the south and right on said map, with a brick house thereon, and including the ground directly in front of said house, and the yard in the rear thereof (enclosed by fence), said back yard extending back to and including the portion of the double woodshed on the rear end of said back yard as indicated on the map, together with other outbuildings; and the other tract being described generally as all the rest and residue of said Lot 11 not included in the portion of said lot last above described.

Plaintiff also introduced in evidence exemplified copies of the Sheriff's certificate of sale and deed issued in pursuance of said sale under execution; also of the deed of Mrs. M. A. Sackett, widow, of Westfield, N. Y., conveying all of said Lot 11 to Clara E. Sackett, her daughter, residing at Buffalo, N. Y.

It was proved and uncontradicted that the property exceeded in value \$2,000.

As part of their defense, the defendants offered in evidence (Tr. 26, l. 26) an alleged declaration of homestead, it being in all respects the same as the instrument set forth in the plaintiff's reply, except that there was inserted the figures "\$2,000.00" after the words "I estimate to be." (Tr. 14, line 16; Cf. p. 27, line 19.) Said instrument contained the endorsement of the County Recorder of Deer

Lodge County, showing that the same had been filed for record on November 26th, 1900.

To the introduction of this instrument, counsel for plaintiff objected (Tr. 28, line 23) on the grounds (1) that the instrument was not stamped, as required by the laws of the United States in force at the date of its execution, (2) that the notarial certificate of acknowledgment was not stamped as required by said laws, and (3) that the recording of the same in its unstamped condition was in violation of said laws, and the record thereof was void and of no effect as against the rights of the plaintiff. But the Court overruled said objection and permitted said instrument to be introduced in evidence.

In rebuttal, the plaintiff offered in evidence an exemplified copy of the records of the land office at Missoula, Montana, showing that on July 15th, 1896, the defendant Joseph McCaffery made homestead entry of a quarter section of government land in Montana, on which a final certificate was issued to him on December 16th, 1901, and patent, October 11th, 1902. This offer was refused by the Court unless plaintiff should follow up said evidence with proof that defendant Joseph McCaffery had at some time actually resided upon said homestead tract, which counsel for plaintiff declared themselves unable to do. Thereupon said evidence was excluded. (Tr. 29.)

Plaintiff introduced evidence tending to show that the portion of the premises in controversy hereinabove referred to as tenant property, and being the brick house and premises to the right on the map of said Lot 11 (Tr. 36), had always been let to tenants and wholly occupied by them,

that at the rear of the tenant house the two portions of the lot had been separated by a fence, and (Tr. 35, line 10) that the said map (Tr. 36) correctly shows the condition of said lot and its improvements on March 16th, 1901. Plaintiff also showed by the testimony of one David Boyd (Tr. 32, line 6) that he had rented the said premises in 1898; that the frame addition or lean-to next to the kitchen had been used by his children as a play-room and by his wife as a storeroom; that there was a fence between the premises occupied by said witness and the north part of the lot, running from the house occupied by him to the woodshed. J. T. Dulin (Tr. 33), who looked at the building in June, 1900, with a view to renting it, found it entirely vacant, and that there was nothing in the frame addition next to the kitchen "except perhaps some old rags or something of that kind lying on the floor." He also testified to a fence dividing the rear portion of the lot. One J. H. Collins, who occupied the building at a later period, to-wit, in May, 1901, testified (Tr. 30, line 36) that he rented the premises described in the reply with the exception of the frame lean-to to the kitchen, and that defendant Joseph McCaffery told witness that "he reserved said frame lean-to or addition because he wanted to sleep there on account of holding possession." Witness testified that he did not know whether anyone slept in the frame addition while he was there. He saw a folding bed in it, but did not notice anything else. There was an uncurtained window from his pantry looking into the frame addition. He saw Mr. McCaffery there two or three times, but only in the day time.

The defendants sought to meet this testimony by evidence tending to show a much more extensive use of the frame addition as a sleeping apartment by Joseph McCaffery. But upon the supposition of the correctness of her own testimony, the plaintiff asked the Court to give the following instructions (Tr. pp. 38-40) :

“Instruction No. 2: Section 1670 of the Civil Code of Montana provides :

“The homestead consists of the dwelling-house in which the claimant resides and the land on which the same is situated, selected as in this title provided.

“Under the provisions of this section, the claimant cannot hold two dwelling houses, one of which he occupies as a residence and the other he lets to tenants. It is the principal use which is made of a house which determines whether it is to be regarded as the residence of the claimant or not. Thus, if the principal use of a house is as the permanent home of the claimant’s family, it does not destroy its character as a homestead if one or more rooms are used as a shop in which the claimant carries on his trade or business. In the same manner, if the principal use of a house is as a tenement building, it does not make it the homestead or part of the homestead because some member of the claimant’s family may occasionally use one of its rooms as a sleeping apartment.

“The above section 1670 also requires that the homestead must be selected in the manner required by law. The requirements of the law are defined to you in these instructions.”

“Instruction No. 6: A homestead cannot include two

dwelling-houses, one of which is occupied by the claimant and the other let to tenants.

“You are instructed that if you find from the evidence that at the time of filing the homestead declaration in question there were two dwelling-houses upon the premises in controversy, the principal use of one of which was as a residence for defendants and the principal use of the other was as a tenement, then the latter house with the land appurtenant thereto was not properly included in the alleged homestead declaration. Whatever the effect of said declaration as to the building in which the defendants lived, the tenement building, if you find it to have been such as herein defined, remained subject to the lien of plaintiff’s deficiency judgment, and in that event plaintiff is entitled to recover such tenement building with its appurtenant land regardless of the question as to whether said alleged homestead declaration was valid or not.”

The Court refused both of these instructions.

The jury found generally for the defendants. Upon this verdict the Court entered judgment in favor of the defendants and against the plaintiff for costs of the action. The cause is brought to this Court on Writ of Error.

SPECIFICATION OF ERRORS RELIED ON.

1. The Court erred in admitting in evidence the alleged homestead declaration of defendant Mary McCaffery (Tr. p. 27 f.) for the reasons (1) that said instrument was in all essential respects “a certificate required by law” and the same was required to be stamped according to the pro-

visions of Act of Congress of June 13th, 1898, entitled "An Act to provide Ways and means to Meet War Expenditure and for other purposes," and in its unstamped condition said instrument was not entitled to be recorded or to be admitted in evidence; (2) the notarial certificate of acknowledgment attached to said instrument was a certificate required by law and was required to be stamped by the provisions of the said Act of Congress, and being unstamped, the instrument to which it was attached was not entitled to record or to admission in evidence, and (3) the filing for record of said instrument in its unstamped condition was in violation of said laws, and the record thereof was void and of no effect as against the rights of the plaintiff.

2. The Court erred in refusing to permit plaintiff to introduce in evidence the exemplified copy of the records of the United States land office at Missoula, Montana, showing that on July 15th, 1896, defendant Joseph McCaffery made a homestead entry of the S. $\frac{1}{2}$ NE. $\frac{1}{4}$, SE. $\frac{1}{4}$ NW. $\frac{1}{4}$, and the NW. $\frac{1}{4}$ SW. $\frac{1}{4}$ of Sec. 31, T. 1 S., R. 15 W., Montana Base and Principal Meridian, and that on December 16th, 1901, final certificate No. 999 was issued to said Joseph McCaffery for said tract, and that on October 11th, 1902, a United States patent was issued to said Joseph McCaffery for said tract, unless plaintiff should follow up said evidence with proof that the said Joseph McCaffery had at some time actually resided upon said tract (Tr. p. 29), for the reasons (1) that said evidence showed that at the date of the filing of the declaration of homestead by Mrs. McCaffery, to-wit, November 26th, 1900, Joseph Mc-

Caffery, her husband, had a valid and subsisting unpatented (government) homestead, which was, in the contemplation of the Federal law, his homestead, and therefore neither he nor his wife could acquire an additional homestead under the state law; (2) that said evidence showed that her said husband at the time she made such declaration was himself precluded from making such a declaration because he was at said time engaged in acquiring title to a homestead under the laws of the United States, and she could not, therefore, make such a declaration for their "joint benefit;" (3) that said evidence showed that her husband had initiated his homestead right in government lands by what was in effect a declaration of homestead; and she therefore could not, under the law, make a declaration of homestead; (4) that said evidence showed that her husband had "selected" a (government) homestead, which, under the law, precluded her from selecting a state homestead; (5) that said evidence tended to impair the good faith of the claim of Mary McCaffery to a homestead in her Anaconda property; (6) that the fact of the residence or non-residence of said Joseph McCaffery upon the tract entered by him as a homestead was one peculiarly within the knowledge of the defendants, and plaintiff should not have been required to show affirmatively his residence upon said tract before being permitted to introduce proof of the entry and patenting of such homestead.

3. The Court erred in refusing to give to the jury the following instruction requested by the plaintiff:

“Instruction No. 2: Section 1670 of the Civil Code provides:

“The homestead consists of the dwelling-house in which the claimant resides and the land on which the same is situated, selected as in this title provided.’

“Under the provisions of this section, the claimant cannot hold two dwelling-houses, one of which he occupies as a residence and the other he lets to tenants. It is the principal use which is made of a house which determines whether it is to be regarded as the residence of the claimant or not. Thus, if the principal use of a house is as the permanent home of the claimant’s family, it does not destroy its character as a homestead if one or more rooms are used as a shop in which the claimant carries on his trade or business. In the same manner, if the principal use of a house is as a tenement building, it does not make it the homestead or part of the homestead because some member of the claimant’s family may occasionally use one of its rooms as a sleeping apartment.

“The above section 1670 also requires that the homestead must be selected in the manner required by law. The requirements of the law are defined to you in these instructions.”

4. The Court erred in refusing to give the following instruction requested by the plaintiff:

“Instruction No. 6: A homestead cannot include two dwelling-houses, one of which is occupied by the claimant and the other let to tenants.

“You are instructed that if you find from the evidence that at the time of filing the homestead declaration in

question, there were two dwelling-houses upon the premises in controversy, the principal use of one of which was as a residence for defendants, and the principal use of the other was as a tenement, then the latter house with the land appurtenant thereto was not properly included in the alleged homestead declaration. Whatever the effect of said declaration as to the building in which the defendants lived, the tenement building, if you find it to have been such as herein defined, remained subject to the lien of plaintiff's deficiency judgment, and in that event plaintiff is entitled to recover such tenement building with its appurtenant land, regardless of the question as to whether said alleged homestead declaration was valid or not."

ARGUMENT.

I.

THE STAMP QUESTION.

(Tr. p. 28, l. 22, et seq.)

The most important question involved in this appeal is the extent to which the validity of the alleged homestead declaration of Mary McCaffery is affected by its failure to bear the revenue stamp required by the laws of the United States that were in effect at the date of the execution of said instrument.

Schedule A of the Revenue Law of June 13th, 1898, provides that a "certificate of any description required by law not otherwise specified in this Act" shall bear a revenue stamp of ten cents. It might fairly be contended that the

homestead declaration itself is a "certificate required by law." The fact that it is termed a homestead declaration instead of a homestead certificate does not affect its essential character as a certificate nor preclude a court from pronouncing it to be a certificate required by law within the meaning of said act. This, however, is not an important question since the certificate of acknowledgment attached to said declaration is also unstamped, and this is not only expressly required by the laws of Montana, but is also expressly termed a certificate by said laws.

Sec. 1700 of the Civil Code of the State of Montana provides:

"In order to select a homestead, the husband or other head of a family, or in case the husband has not made such selection, the wife, must execute and acknowledge in the same manner as a grant of real property is acknowledged, a declaration of homestead, and file the same for record."

The same Code has the following provisions relating to the method of acknowledging a grant of real property:

"Sec. 1573. Before an instrument can be recorded, *
* * * its execution must be acknowledged by the person executing it.

"Sec. 1608. An officer taking the acknowledgment of an instrument must endorse thereon, or attach thereto, a certificate substantially in the forms hereinafter prescribed.

"Sec. 1609. The certificate of acknowledgement * *
* * must be substantially in the following form: * *

* ** (Then follows the form of notarial certificate used in the instrument in question.)

No clearer instance could be cited of a "certificate required by law" than this, and it has been the ruling of the Treasury Department that such a certificate requires a ten-cent stamp. The only exceptions to this ruling are those cases where the stamping of the main instrument is specifically provided for in said act, and that in such cases the department holds that the law did not contemplate that both the main instrument and the certificate attached thereto should be stamped.

"The notary's certificate of acknowledgment on bills of sale is subject to a tax of ten cents if such a certificate is required by law to make the instrument valid. The notary's certificate to a mortgage is part of an instrument upon which a rate of taxation is imposed and is covered therein. It is not subject to a tax for itself when appended to an instrument for which a rate of taxation is provided."

Ruling No. 20,387, Vol. 1, p. 84, Dec. Com. Int. Rev.

"A notarial certificate of acknowledgment to a satisfaction of mortgage requires a ten-cent stamp."

Second Revision of Circular No. 503, Ruling 53. Vol. 2 p. 290, Dec. Com. Int. Rev.

It is plain that under these rulings a certificate of acknowledgment to a homestead declaration would require a stamp since it is (a) a certificate required by law and (b) it is not appended to an instrument for which a rate of taxation is otherwise provided.

ALTHOUGH THE PROVISION OF LAW IMPOSING SUCH TAX IS REPEALED, THE TAX IS STILL DUE AND PAYABLE TO THE GOVERNMENT.

Said provision of Schedule A was omitted from the Act of March 2d, 1901 (taking effect July 1st, 1901), amending the War Revenue Act. And by the Act approved April 12th, 1902 (taking effect July 1st, 1902), being "An Act to repeal War Revenue taxation and for other purposes," Schedule A was entirely repealed, although other portions of the War Revenue Act were retained.

But the repeal of the provision requiring the tax was not a remission of the tax as to unstamped instruments already executed. Where a tax has become due, the repeal of the law imposing it is not a remission of the tax unless such intention clearly appears.

The general rule of law is stated in *State vs. Sloss* (Ala.), 3 Southern, 745, as follows:

"Where taxes are levied under a law that is repealed by a subsequent act, unless it clearly appears that the Legislature intended the repeal to work retrospectively, it will be assumed that it intended the taxes to be collected according to the law in force when they were levied."

To the same effect are:

Cyc. of Law, 1st ed. vol. 25, pp. 129-193.

Harrington vs. Galveston County, 1 Tex. App. 437-438.

Smith vs. Humphrey, 20 Mich. 398.

Appeal Tax Court of Baltimore City vs. R. R., 50 Md. 275.

State of Maine vs. Waterville Savings Bank, 68 Me. 515.

State ex rel. Marion Co. vs. Certain Lands, 40 Ark. 35-38.

State ex rel. City Water Co. vs. City of Kearney et al. (Nebraska), 70 N. W. 255.

The City of Oakland vs. Whipple and Chambers, 44 Cal. 303.

United States vs. Dutcher, 2 Biss. 51 (Fed. Cas. 15014).

Town of Belvidere vs. The Warren R. R. Co., 34 N. J. L. 193.

That Congress "intended the tax to be collected according to the law in force when it was levied," appears affirmatively from the retention by Congress of the exclusive governmental machinery for the collection of such taxes.

The act of April 12th, 1902, repealed the following sections of the War Revenue Act relating to documentary stamp taxes:

Sec. 6. (As amended by Sec. 5. of the Act of 1901), imposing stamp taxes on documents enumerated in Schedule A.

Sec. 12. Providing additional facilities for the distribution and sale of adhesive stamps.

Sec. 18. Requiring stamps on telegraphic messages with penalty for violation.

Schedule A. (As amended by Sec. 8 of the law of 1901), specifying what amounts of stamps must be affixed to the documents enumerated therein respectively.

Sec. 25. Providing for the manufacture, distribution and sale of all the stamps provided for in the Act.

Sec. 28. Requiring stamps on parlor and sleeping car tickets.

And the following provisions relating to documentary stamps were left unrepealed:

Sec. 7. Declaring failure to affix documentary stamps a misdemeanor, and excluding unstamped instruments from evidence.

Sec. 8. Imposing penalties for fraudulently stamping documents or for removing stamps from documents or forging or mutilating any stamps, etc., provided for in the Act.

Sec. 9. (As amended by Sec. 6 of the Act of 1901), requiring cancellation of stamps, and imposing penalty for failure to cancel.

Sec. 10. Imposing penalty for issuing or receiving unstamped paper, with fraudulent intent.

Sec. 11. Requiring an acceptor of a bill of exchange, drawn abroad and payable in the United States, to stamp the same, and imposing penalty for failure.

Sec. 13. Imposing penalty for issuing documents unstamped, with intent to defraud; and providing for the post-stamping by the Collector, of instruments which, innocently or otherwise, had been executed unstamped.

Sec. 14. Prohibiting the recording or admission in evidence of unstamped documents and providing that the record thereof shall not be admitted in evidence.

Sec. 16. Making any legal documentary stamp, of the proper amount, sufficient on any document.

Sec. 17. Providing that documents issued by officers in the exercise of their governmental functions, should be exempt from stamp tax.

The foregoing are all of the provisions of the War Revenue Act relating to documentary stamp taxes; and they all relate *exclusively* to documentary stamp taxes, except Sec. 6 (the latter part of which contains a paragraph relating to Schedule B, referring to stamps on merchandise), and Secs. 8, 9 and 25, which refer to all the stamps provided for in the Act.

..These unrepealed provisions consist of (1) penalties for the misuse or non-cancellation of adhesive stamps generally; (2) certain penalties to enforce the payment of documentary stamp taxes, and applying exclusively to them (Secs. 7, 11, 13, 14 and 15); (3) a qualification or mitigation of the strictness of the documentary stamp law, by making any legal documentary stamp, of the proper amount, sufficient (Sec. 16), by excepting from the operation of the law documents issued in the exercise of governmental functions (Sec. 17), and by providing in Sec. 13 a method for removing the disabilities of such instruments by post-stamping.

Although all of the provisions imposing documentary stamp taxes have been repealed, yet none of the penalties provided by the War Revenue Act to enforce the collection of such taxes, and which exist exclusively for that purpose, have been repealed, except Sec. 18, requiring stamps on telegraphic messages and imposing a penalty for violating the requirement.

The retention in the law of these penalties, of the ex-

emptions from taxation, and of the provision for post-stamping, shows it to have been the intention or understanding of Congress that stamp taxes already due were to be collected. Especially would the provision in Sec. 13, for the post-stamping of instruments from which the stamps had been omitted, be useless if the tax had been remitted.

Said tax is still due and payable, also, despite the repeal of that part of the revenue law imposing it, by virtue of Sec. 13 of the Revised Statutes of the United States, which reads as follows:

“The repeal of any statute shall not have the effect to release or extinguish any penalty, forfeiture or liability incurred under such statute, unless the repealing Act shall so expressly provide * * * *.”

The defendant Mary McCaffery became “liable” or “incurred a liability” for the payment of this stamp tax immediately upon the execution of this declaration of homestead; and said Sec. 13 of the Revised Statutes perpetuates this liability, despite the repeal of the provision imposing the tax. And Congress, therefore, naturally, retains unrepealed the government’s remedies for the enforcement of this liability, the qualifications and exceptions thereto, and the opportunity to escape this liability by post-stamping.

In the Decisions of the Commissioner of Internal Revenue, Vol. 4, page 155, the Treasury Department ruled, that where the amount of stamps required on a deed was reduced by the amendment of 1901, an instrument executed before the amendment must be stamped according

to the original law, and cannot be recorded if stamped according to the amended law. The ruling is as follows:

“If a deed conveying realty and executed prior to July 1st, 1901 (when the amendment of the Revenue Law, reducing the stamp tax on deeds, took effect), is presented for record after said date, it will require a revenue stamp to be attached according to the law now in force (that is, on June 21st, 1901, the date of the ruling), before the same can be recorded.”

Now that the later amendment of 1902 has reduced the tax to nothing, the same principle must apply, and the deed or other instrument must be stamped according to the law in force when the instrument was executed.

In *Foster vs. Holley's Administrators*, 49 Ala. 593, the Court says, referring to the repeal of a Federal stamp tax:

“It is contended by the learned counsel for the appellant, that the repeal of so much of the law as affects the case releases such a contract from the law in force before the repeal. It does not seem to be so intended. The repeal is special, and looks wholly to the future, and does not seem to be intended to operate on contracts previously entered into. It is not a repeal of the whole law, but only a repeal of so much as imposes taxes on certain instruments. It does not, therefore, affect this case.”

The same language would aptly apply to the present case.

NEITHER THE HOMESTEAD DECLARATION
NOR THE ALLEGED RECORD THEREOF WERE
ADMISSIBLE IN EVIDENCE AT THE TRIAL.

Section 7 (unrepealed) of the War Revenue Act, provides:

“That if any person or persons shall make, sign, or issue, or cause to be made, signed, or issued, any instrument, document, or paper, of any kind or description whatsoever, without the same being duly stamped for denoting the tax hereby imposed thereon, or without having thereupon an adhesive stamp to denote said tax, * * * * such instrument, document or paper, as aforesaid, shall not be competent evidence in any Court.”

Section 14 provides:

“That hereafter no instrument, paper or document required by law to be stamped, which has been signed or issued without being duly stamped, or with a deficient stamp, nor any copy thereof, shall be recorded or admitted, or used as evidence in any Court until a legal stamp or stamps, denoting the amount of the tax, shall have been affixed thereto, as prescribed by law * * * *.”

And section 15 provides:

“That it shall not be lawful to record or register any instrument, paper or document required by law to be stamped, unless a stamp or stamps of the proper amount shall have been affixed and canceled in the manner prescribed by law; and the record, registry or transfer of any such instruments, upon which the proper stamp or stamps aforesaid shall not have been affixed and canceled as aforesaid *shall not be used in evidence.*”

These provisions were in force at the time of the trial and are still operative: (1) Because they have never been repealed; (2) because, together with other unrepealed

penalties for non-stamping, they are necessary to the collection of the documentary stamp taxes which, at the time of the repeal of the part of the law imposing them, were due and unpaid; and (3) under Sec. 13 of the Revised Statutes of the United States, above quoted.

There is nothing in the Acts of 1901 and 1902 to indicate that Congress, in repealing the provisions imposing documentary stamp taxes, intended the repeal to operate retrospectively, so as to remit stamp taxes which had been evaded or innocently left unpaid; on the contrary, it clearly appears, from the retention unrepealed of the foregoing sections excluding unstamped instruments from evidence and record, and of Sec. 13 of the War Revenue Act, providing for post-stamping unstamped instruments on payment of a penalty, that Congress intended these provisions to be used to enforce the payment of taxes due and unpaid at the time of the repeal.

The retention of these provisions has the effect of a general proviso that, despite the repeal of the tax, unpaid taxes should still be collected. "An express saving clause is not required to save the right to collect." *State vs. Sloss* (Ala.) 3 Southern, 745.

Even if the stamp tax on the homestead declaration had been remitted, the penalties of exclusion from evidence and from record (Secs. 7, 14 and 15 of the War Revenue Act) would still remain enforceable, not only because these penal sections are still unrepealed, but also under Sec. 13 of the Revised Statutes, which provides:

"The repeal of any statute shall not have the effect to release or extinguish any penalty, forfeiture or liability

incurred under such statute, unless the repealing act shall so expressly provide * * * *.”

The word “liability” in said section is construed in *United States vs. Ulrici*, 3 Dillon 532, as “intended to cover every form of punishment to which a man subjects himself by violating the common laws of the country.” The Court further says: “Moreover, any man using common language might say, and very properly, that Congress had subjected a party to a liability, and if asked what liability, might reply, a liability to be imprisoned.”

One might say, even more appropriately, in the present case, that Congress had subjected a party to a liability to have his homestead declaration excluded from evidence and record, if not stamped.

The foregoing construction of the statute is quoted with approval in *United States vs. Reisinger*, 128 U. S. 402, where the Court says that Congress intended Sec. 13 to apply to all offenses.

In 23 Fed. 74, the Court says, construing Sec. 13, R. S. : “Penalty is the punishment inflicted by law for its violation. The term is mostly applied to pecuniary punishment, but it is not exclusively so. The case of *U. S. vs. Ulrici* (supra) is in point on all of the propositions urged on behalf of the defendant. In that case Mr. Justice Miller * * * * held that Sec. 13 R. S. contains a general provision changing the rule of the common law * * * * and he says that the section was intended to repeal the rule.”

In 32 Fed. 24, *Eastman vs. Clackamus Co.*, the Court says: “It is admitted in the case of what are called penal

statutes that there has been a more marked disposition on the part of the Courts to hold that repeal thereof destroys or takes away all existing rights of action thereunder without express declaration to that effect. But the rule is an arbitrary one, and never had anything to commend it, except in the United States an undue sympathy for wrongdoers, and in England an early prejudice among common law judges against "statute made law." By the Act of Feb'y 25, 1871 (Sec. 13 R. S.), Congress abrogated it."

In *United States vs. Barr*, 4 Saw. 254, the Court says:

"The 'liability' of the defendant for the act charged in the indictment, consisted in his being bound or subject to punishment for it * * * * and this liability was 'incurred,' met with or run against, when such act was committed. Sec. 13 declares that the substitution or repeal of Sec. 5457 shall not have the effect to 'extinguish' this liability, which is equivalent to declaring * * * * that said Sec. 5457 shall, for the purposes of this prosecution, be considered still in force." The Court goes on to say that Sec. 13 is a salutary provision.

There are some decisions by State Courts construing Sec. 14 (supra) of the Revenue Law, imposing on Courts the duty of excluding unstamped instruments from evidence, which hold that said statute is not binding on State Courts, on the ground that Congress has no power to impose a rule of evidence on State Courts. But these same decisions concede that said section is binding on Federal Courts. While the duty of State Courts in the matter does not necessarily arise in this case, yet it may be fairly con-

tended that the law of Congress is binding upon State as well as Federal Courts, and that the abrogation of this law in any respect by a State Court is a modern form of nullification.

Congress was warranted in excluding from evidence and record even those instruments which had been innocently left unstamped, by reason of the method provided in Sec. 13 of the War. Rev. Act (amended by Sec. 7 of the Act of March 2, 1901), for removing the disability from the instrument by post-stamping the same before the Collector, who is authorized to remit all penalties if he deems the omission to stamp to have been innocent.

THE RECORD OF THE HOMESTEAD DECLARATION, BEING FORBIDDEN, WAS A NULLITY.

The following authorities hold that an unauthorized record of an instrument is a nullity.

Cyclopedia of Law, 2d Ed. Vol. 24, page 142:

“If an instrument * * * * though within the contemplation of the (recording) statute, be not entitled to record because of * * * * a failure to comply with some of the pre-requisites to recordation, the record thereof will be a mere nullity.”

And on page 101: “Under the statutes of most of the states a valid acknowledgment, or proof of execution, is made a prerequisite to registration of an instrument; and the recording of an unacknowledged or defectively acknowledged instrument has no effect whatever.”

And in volume 1, page 490, under the head of “Acknowledgments,” it is stated: “In most of the states it is held

that registration of an unacknowledged or defectively acknowledged instrument, without due proof of execution, is a mere nullity.”

Such a record is expressly held to be a “nullity” in the following cases:

Hill vs. Gordon (Fla.) 45 Fed. 279.

Townsend vs. Edwards (Fla.) 6 So. 212-213.

In Sigourney vs. Larned, 27 Mass., 72-74, the transcript of such an instrument on the records is said to be “not a record.”

In Work vs. Harper, 24 Miss. 517, it is said to be “a nullity as to all the benefits conferred by statute upon a properly registered instrument.”

In De Witt vs. Moulton, 17 Me. 418, it is said that the registry of a deed without acknowledgment is “illegal and gives no rights.”

In McMinn vs. O’Connor, 27 Cal. 239-245, it is said that “Deeds not properly acknowledged or proved, but filed for record or recorded in the proper book of the proper county, are not duly filed for record nor duly recorded.”

In 24 Mich. 145, Buell vs. Irwin, it is said to be “not evidence.”

In 4 Fla. 465, Sanders vs. Papoon, it is said that an instrument so transcribed on the records “is not entitled to be regarded as a registered instrument.”

In Stallings vs. Newton (Ga.) 36 S. E. 227, it is said that if a deed be not attested or acknowledged, “its registration is wholly ineffective and accomplishes no purpose.” And the record of such an instrument was “ineffectual to

give it more incidents than it would have if it had not been recorded at all.”

In *Gardner vs. Grannis*, 57 Ga. 539-554, the Court intimates that where a deed, which is insufficiently proved, is recorded, the record is not an official record.

In *Budd vs. Brooks* (Md.) 43 Am. Dec. 321-333, it is said that such a pretended record is no more evidence of the existence of a deed than would be a copy of the deed certified by a private individual.

An instrument not entitled to record because not acknowledged, or with a defective acknowledgment, is the most obvious example of the class of instruments described above as being not entitled to record, though within the contemplation of the recording statutes, because of a failure to comply with some of the pre-requisites to recordation, and the record of which is therefore a mere nullity.

But lack of other pre-requisites to recordation has the same effect.

Thus, in *Pfaff vs. Jones*, 50 Md. 263, it is said: “The clerical act of registering a mortgage after the time allowed by law is null and void.”

In *Hall vs. Redson*, 10 Mich. 21, where a deed was required to have two witnesses in order to be recorded, but it had only one witness, the record of it was held entirely inoperative either as notice or evidence.

In *Gill vs. Strozier*, 32 Ga. 688, it is stated that “If a paper recorded is not one authorized to be recorded, *nor is recorded in the terms of the law*, it is in neither case a record, and a copy of such paper found in the Clerk’s books

is entitled to no more credit or weight than one found on the books of a private person.”

In *Choteau vs. Jones*, 11 Ill. 300, it is said: “Registration of an unacknowledged deed gives it no additional validity nor effect.”

In *Richardson vs. Shelby* (Okla) 41 Pac. 378, where a chattel mortgage was required to be registered in order to be valid, it was held that the registry, is unauthorized, or if made otherwise than in compliance with the law, would be treated as a mere nullity.

And in *Parrett vs. Shaubut*, 5 Minn. 323, it was held that a record, if for any reason unauthorized, is a mere nullity.

In section 14 of the War Revenue Act (unrepealed), it is provided:

“That hereafter no instrument, paper or document required by law to be stamped, which has been signed or issued without being stamped, or with a deficient stamp, nor any copy thereof, *shall be recorded* or admitted, or used as evidence in any Court until a legal stamp or stamps, denoting the amount of the tax, shall have been affixed thereto as prescribed by law * * * *.”

And Sec. 15 of the same act provides:

“That it shall not be lawful to *record or register* any instrument, paper or document required by law to be stamped unless a stamp or stamps of the proper amount shall have been affixed and canceled in the manner prescribed by law; and the record, registry or transfer of any such instruments upon which the proper stamp or

stamps aforesaid shall not have been affixed and canceled as aforesaid shall not be used as evidence.”

The due stamping of an instrument is, therefore, a “pre-requisite to recordation” as fully as an acknowledgment. Under the foregoing decisions, accordingly, the record of an unstamped instrument is a “nullity,” and whatever effect the repeal of the stamp tax may have, it can have no effect to make a record valid which, when made, is a nullity. The homestead declaration in question was recorded in its unstamped condition. The record there thereof has at all times been a nullity and no record, and therefore there has never been any homestead in the premises in question.

It is provided in the Civil Code of Montana, Sec. 1702 (Cal. Sec. 1264) :

“The declaration must be recorded in the office of the county in which the land is situated.”

And Sec. 1703 (Cal. Sec. 1265) provides:

“From and after the time the declaration is filed for record, the premises therein described constitute a homestead.”

As is said in 63 Mo. 394, “The object of fixing the date of filing as the date of constituting the homestead, is to establish an unalterable criterion to govern all cases where disputes might arise as to the period when the homestead is acquired.” It is not thereby intended to dispense with the necessity of recording as an essential to the homestead. It is said in 110 Cal. 198, “The mode of creating a homestead in lands as prescribed by Secs. 1262-1264 (Mont. Secs. 1700-1702) is exclusive.”

It is said in 35 Pacific 646 (Cal.), under a statute providing that an instrument is deemed to be recorded when deposited with the proper officer for record, that the instrument must be recorded, and the recording, when completed, relates back to the date of the deposit for record.

Here, also, the recording is necessary, and when completed relates back to the date of the deposit for record, which is the date of the creation of the homestead, other conditions being fulfilled. In contemplation of law, the filing and recording take place at the same moment of time. Both are necessary. The paper is filed only in order that it may be recorded. If for any reason the paper filed cannot be recorded, as, where it lacks an acknowledgment or a stamp, then the paper is not "duly filed" and does not contribute to or fix the date of the creation of the homestead.

The "filing for record" of an instrument not allowed by law to be recorded is a nullity.

It has been held in some state cases that the prohibition against recording unstamped instruments was either beyond the power of Congress, or was designed to apply only to Federal recording offices.

In *Chartiers vs. Robinson & Turnpike Co.*, 72 Penna. 278, however, it is said:

"The word 'recorded' in the statute refers to state offices of record, as the United States have no offices for recording deeds, mortgages, powers of attorney and other documents forbidden to be recorded until the proper stamp tax is paid;" and the Court says that Congress has the constitutional power to impose such a prohibition.

Sec. 15 of the War Revenue Act (*supra*), prohibiting the recording of unstamped instruments, is construed in the case of *Farmers' Loan & Trust Co. vs. Electric Light Co.*, 90 Fed. 806, where, a Master's deed having been presented to the County Recorder to be recorded, he refused to receive or record it because it bore no revenue stamps, and claimed that Schedule A of the War Revenue Act required the deed to be stamped. A rule was issued requiring him to show cause why he should not file and record the same unstamped. The Court held that the deed must be stamped in order to be recorded.

And in the case of *Dowell vs. Appelgate*, 7 Fed. 881, the Court, in construing a similar provision, says: "It is plain that this section in no wise affects the validity of the original conveyance, but is confined to excluding it from the privilege of record."

CONCLUSIONS IN RESPECT TO OMISSION OF STAMP.

(1) The certificate of acknowledgment to the homestead declaration in question required a stamp, as a "certificate required by law, not otherwise specified in this Act."

(2) The subsequent repeal of the tax on such certificate in the amendatory Act taking effect July 1st, 1901, did not relieve the defendants from the necessity of paying it.

(3) Secs. 7 and 14 of the War Revenue Act, prohibiting the admission in evidence of an unstamped instrument, and Secs. 14 and 15 prohibiting the recording

thereof, are still in force, unrepealed, and therefore the admission in evidence of the homestead declaration and of the pretended record thereof, was error.

(4) Said record, being forbidden, was a nullity when made, and void, as was the "filing for record" of the unstamped instrument. These are both pre-requisites to the creation of a homestead, and therefore no homestead ever came into existence. The judgment should therefore be reversed.

II.

THE FEDERAL HOMESTEAD QUESTION.

(Transcript p. 29, l. 16 et seq.)

The defendant Joseph McCaffery made homestead entry of 160 acres of government land in Montana on July 15th, 1896. On November 26th, 1900, the defendant Mary McCaffery, the wife of Joseph, declared a state homestead on property in Anaconda, Montana. On December 16th, 1901, final certificate was issued to Joseph McCaffery on his government homestead entry; and a patent therefor was issued to him on October 11th, 1902.

It is provided in Montana C. C. Secs. 1676 and 1677 that "a homestead can be abandoned only by a declaration of abandonment, or a grant thereof, executed and acknowledged by the husband and wife, if the claimants are married;" and "the abandonment is effectual only from the time it is recorded." The same provisions are found in the Civil Code of California (C. C. Secs. 1243-1244), and

in the statutes of Arizona (Sec. 2075), and Idaho (Sec. 3041).

Under this provision said method of abandonment is exclusive. The homestead cannot be abandoned by removal from the premises with the intent of not returning, or by establishing a home elsewhere.

Porter vs. Chapman, 65 Cal 365.

Tipton vs. Martin, 71 Cal. 325.

Waggle vs. Worthy, 74 Cal. 266.

Lubbock vs. McMann, 82 Cal. 226.

Simonson vs. Burr (Cal.) 54 Pac. 87.

In Tipton vs. Martin, 71 Cal. 325, on injunction against execution sale of property claimed as a homestead, the defendant alleged:

“That in the month of —, 1878, the plaintiff removed from said premises and from this state, and freely and voluntarily removed into the Territory of Montana with the intent of remaining there and residing there permanently, and without any intention of returning again to this state or upon said premises, and have since said month of —, 1878, continuously resided in said Territory of Montana, and do now reside therein, and since they moved into said Territory of Montana the said John C. Tipton has taken the initiatory steps to acquire title therein to United States land under and by virtue of the U. S. Homestead Laws, and the said application for said land under the U. S. Homestead Laws is still pending.”

The plaintiff demurred to the sufficiency of the facts

thus pleaded and the demurrer was sustained, from which ruling an appeal was taken and the ruling affirmed.

Under this decision, if the plaintiff, instead of filing on a government homestead in Montana, had declared on a state homestead there, the conclusion of the California Court would have been the same; the California homestead would not have been affected. But would the second state homestead in Montana have been valid? Unquestionably not. For, if such a second homestead would be good, then the second homestead would be good against a third homestead thereafter established in Idaho; and a fourth, fifth and sixth homestead would all be valid in still other states, and so on, until homesteads might be established in every state having this provision as to abandonment, all exempt from the claimant's creditors.

It is accordingly held that a man cannot have two homesteads; and that if he attempts to acquire a second while the first is in force, the second is void.

Cyc. of Law, 2d Ed., Vol. 15, p. 602.

Freeman on Executions, Sec. 204 (3d Ed., p. 1299).

Waggle vs. Worthy, 74 Cal. 266.

First Nat'l Bank vs. Massengill, (Ga.) 5 S. E. 100.

Archibald vs. Jacobs, 69 Tex. 249.

Cornish vs. Fries, 43 N. W. 507.

In the case above discussed, the plaintiff's California property was held to be his homestead, although for more than ten years it had ceased to be his home or residence, and although he had established his home elsewhere, and

taken formal steps to establish a *homestead* outside of California.

It is universally held that a man cannot have two homesteads at the same time.

(See citations immediately foregoing.)

Also:

Estate of Phelan, 16 Wis. 77.

Palmer vs. Hawes (Wis.) 50 N. W. 341.

Beard vs. Johnson (Ala.) 6 So. 383.

Rouse vs. Caton (Mo.) 67 S. W. 578.

Achilles vs. Willis (Tex.) 16 S. W. 746.

Tourville vs. Pierson, 39 Ill. 446.

Wright vs. Dunning, 46 Ill. 271.

Goodale vs. Boardman, 53 Vt. 92.

Horn vs. Tufts, 39 N. H. 478.

Kaes vs. Gross, 92 Mo. 647.

Gerrish vs. Hill, 66 N. H. 171.

Sarahas vs. Fenton, 5 Kans. 592.

Freeman on Executions, Secs. 241 and 248 (3d Ed. pp. 1305, 1351).

Waples on Homesteads, p. 146.

As the Court says in *Kaes vs. Gross*, 92 Mo. 647, "The whole theory of the law is repugnant to the idea of two homesteads being in existence at the same time * * * * She could not lawfully have two homesteads at the same time, any more than she could lawfully have two husbands at the same time."

It is also true that there cannot be two separate homesteads, one declared by the husband and the other by the wife, upon separate parcels of land.

Cyc. of Law (2d Ed.) Vol. 15, p. 566.

Thompson on Homesteads, Sec. 225.

Beard vs. Johnson (Ala.) 6 So. 383.

Rosenburg vs. Jett, 72 Fed. 90.

Gambette vs. Brock, 41 Cal. 83.

Rouse vs. Caton (Mo.) 67 S. W. 578.

Nor can a man and his wife hold two government homesteads.

Dec. of the Int. Dept. relating to public lands:

Vol. 9, p. 426, L. A. Tavener.

Vol. 13, p. 734, William A. Parker.

Vol. 21, p. 430, Thompson vs. Talbot.

We believe, after careful investigation, that there is not a single authority holding that a man (or a man and his wife, while they are living as husband and wife), can hold two homesteads, whether in the same or in different states, whether state or Federal homesteads.

In the case now before the Court, the two alleged homesteads are not in different states, but are both in Montana, though created under different laws, and the Court has jurisdiction over both.

In Hesnard vs. Plunkett (S. D.) 60 N. W. 159, the plaintiff, while living on his state homestead of 160 acres, took up an adjoining 160 acres of government land as a federal homestead. His buildings were situated on 19

acres of his state homestead; he sold this 19 acres and moved his buildings and his residence upon a part of the federal claim, adjoining the state homestead. He then made claim to the 141 acres of the original state homestead and the adjoining 19 acres of the Federal claim, to which his buildings had been moved, as a state homestead. His state homestead claim and his government homestead claim, therefore, overlapped each other to the extent of the 19 acres to which his buildings had been moved, said 19 acres being claimed as a part of each homestead.

The court held that, although he actually lived on both claims at the same time, that, nevertheless, in the contemplation of law, he could not be considered as living on both at the same time; that he was in contemplation of law occupying the government homestead claim and nothing else; that while he resided on a government claim for the purpose of getting title to the same, he could not at the same time claim to reside on land outside of the government claim, within the meaning of the state homestead law, and claim the latter as exempt under the state law; that by claiming 141 acres of his state claim under the state law he asserted that he was claiming from the government only 19 acres of the government homestead, or only enough to make up 160 acres, which was untrue.

The syllabus by the Court reads:

“One who claims a government homestead under the laws of the United States, and is settled upon and occupying the same for the purpose of acquiring title thereto, cannot, before he is entitled to a patent therefor, hold a

homestead under the state law embracing 19 acres of such government homestead claim and 141 acres of such pre-emption claim for which a patent has been issued to him and from which he removed to the land embraced in his government homestead claim.”

The phrase, “before he is entitled to patent therefor,” indicates that after obtaining a patent for the government homestead claim he *could* so hold both because he would not then be required to live on the government homestead. But the Court says: “He cannot be permitted, when dealing with the government, to say he claimed 160 acres as his government homestead and when dealing with his creditors to say that he only claimed 19 acres of the same.”

The Court might say with even more emphasis that, if he had first entered the government land as a government homestead, but never lived on the same (though subsequently submitting false proofs and thereby securing a patent thereto), but took up his residence, after making said government filing, on adjoining land owned by him, and asserted a state homestead right in the land that he owned and resided on, that he would not be allowed to say (nor would his wife be allowed to say for him), when dealing with the government, that he claimed the government land as his government homestead, but, when dealing with his creditors, to say that he didn't claim any of it.

Undoubtedly, in the sense that a man is said to live or make his residence on a farm, the plaintiff in that case did reside on the entire 301 acres; and such residence would not be inconsistent with his claiming a portion of the 301 acres as either a state or a federal homestead. He might

have legally claimed a state homestead in the same 160 acres which he claimed as a government homestead, as was held in *Watterson vs. Bonner*, 19 Mont. 554, or in a part thereof, provided his state claim did not extend beyond the borders of his government claim. It is equally true, as his house was on the overlapping parts of the two claims, that he actually did live on each claim, in strict compliance with both the state and federal law as far as appears. The fact of residence, therefore, may be left out of account in the consideration of the case, although the Court lays considerable stress thereon, because he did comply with the letter of the law as regards residence; actual residence, under the circumstances, was a false quantity. It was the spirit of the law which he violated, in claiming a double exemption, in trying to hold as exempt more land than either the state or the federal law contemplated he should, in trying to hold a separate homestead under each law, all exempt from his creditors.

It may be that, after obtaining a patent to a government homestead, a man may acquire a state homestead; but, while he is required to reside on the government homestead, or while he is holding the same as exempt by virtue of his supposed residence thereon, the government not having declared any forfeiture against him for failure to comply with the requirements as to residence, and the claimant showing by his procurement of a patent from the government at the end of five years from his original entry that he never intended to abandon his claim of homestead therein, such government land is in the contemplation of

the federal law his homestead, and neither he nor his wife can acquire an additional homestead under the state law.

It follows from the foregoing principles that a man cannot hold a government homestead (at least before patent), and his wife at the same time hold a state homestead.

A government homestead differs from a state homestead in this state principally in the following respects:

1. The husband can alienate the government homestead without the consent of his wife.

2. A person who is not the head of a family may acquire a government homestead.

3. The government homestead is exempt only from debts incurred before patent.

But practically the same differences exist between the state homesteads of the various states; and yet it could not be claimed that one could acquire a second homestead while the first was still subsisting, in another state, merely because these differences existed between the homestead laws of the two states.

Thus, there are many states where the husband can alienate the homestead without the consent of the wife, though this rule has been abrogated in some states where it formerly existed.

Wright vs. Whittick, 31 Pac. 490 (Colo.).

Cook vs. Higley, 37 Pac. 336 (Utah).

Shields vs. Horbach, 68 N. W. 527 (Nebr.).

Rector vs. Rotton, 3 Nebr. 171.

State Bank vs. Carson, 4 Nebr. 498.

Massay vs. Womble, 69 Miss. 347.

Lindsay vs. Norrill, 36 Ark. 545.

Lewis vs. Curry, 74 Mo. 49.

Riecke vs. Westenhoff, 85 Mo. 642.

Hemphill vs. Haas, 11 S. W. 510 (Ky.).

Kennedy vs. Stacey, 1 Baxt. 220 (Tenn.).

There are also several states in which a person who is not the head of a family can acquire a homestead.

Cal. C. C. Sec. 1260.

Greenwood vs. Maddox, 27 Ark. 648.

Meyers vs. Ford, 22 Wis. 139.

Hesnard vs. Plunkett, 60 N. W. (S. D.) 159.

As to the extent and range of the exemption, the exceptions thereto, and the length and period of time it covers, there is the greatest diversity between the different states.

It might be claimed that a federal homestead before patent is a very different thing from a state homestead, because the title to the former is in the government. But the homestead claimant in Montana is not required to own the land; if he has a right to live on the ground, he has also a right to declare a homestead thereon, which will protect his right in the land from execution, however slight that right may be. Title in homestead is, therefore, said to be a "false quantity."

Watterson vs. Bonner, 19 Mont. 554.

Brooks vs. Hyde, 37 Cal. 373.

King vs. Gotz, 70 Cal. 241.

Alexander vs. Jackson, 92 Cal. 514.

Moreover, it is held that the government homestead claimant does have, before patent or final proof, an inchoate title and a vested right. Land vs. Morey, 42 N. W. 88 (Minn.).

He has an interest which he can mortgage.

Dickerson vs. Cuthburth, 56 Mo. App. 652.

Watson vs. Voorhees, 14 Kan. 330.

Weber vs. Laidler (Wash.) 66 Pac. 400.

Mudgett vs. R. R. Co., Dec. In. Dept. relating to
Pub. Lands, Vol. 8, p. 243.

A Montana state homestead, therefore, differs from government or federal homesteads only as it does from state homesteads in other states.

In a federal homestead the government policy has three objects:

First. To provide homes for settlers and to protect such homes by exemptions from execution.

Second. To promote the growth and development of the country by inducing settlers to accept such homes.

Third. To derive revenue from the sale of public lands.

But the last named purpose is really subordinate and incidental, as the government holds the public lands merely for its citizens, and the theory of the homestead law is that the government devotes these lands most effectually to the service of its citizens by providing and protecting

homes for them thereon. The price exacted therefor is nominal. The paramount purpose is to provide and protect homes for citizens. Essentially the same purpose is the basis of any state homestead law. A state, to be sure, does not provide the ground for the citizen to establish his home on, but it seeks by the homestead law to induce him to provide one for himself, and then protects him in the enjoyment of it.

The following conclusions are deduced from the foregoing authorities and argument:

1. A man, or a man and his wife, cannot have two state homesteads, whether in the same or in different states, whether in the same or in different jurisdictions, whether created or sought to be created under the same or differing laws.

2. So long as he has a state homestead in one state, recognized and held exempt as such by the laws thereof, neither he nor his wife can establish a state homestead in another state in which they may have taken up their residence. And if they attempt to do so, the second homestead is void.

3. Government homesteads have the essential characteristics of the state homesteads of the various states; and differ from state homesteads in Montana only as the latter differ from state homesteads in other states.

4. It must follow that, while a man has a subsisting government homestead, upon which he is acquiring title under the laws of the United States, which is recognized and held exempt as such by said laws, neither he nor his wife can establish a state homestead on other lands on

which they may have taken up their residence; and if they attempt to do so, the second homestead is void.

The Land Office records offered in evidence and refused sufficed to show that Joseph McCaffery, at the time his wife filed her homestead declaration on her Anaconda property, had a subsisting unpatented government homestead. This being so, his wife could not acquire a second homestead under the state law. Whether he was living on said government land during the five years between his original filing and his patent or not, is a question between himself and the federal government; it did not affect the existence of his federal homestead right until, in case of non-residence or insufficient residence, the government elected to declare the homestead forfeited, which they did not do, as shown by the issuance of a patent to Mr. McCaffery at the end of the five years.

Sec. 2297 of the Revised Statutes provides:

“If at any time after the filing of the affidavit, as required by Sec. 2290, and before the expiration of the five years mentioned in Sec. 2291, it is proved, after due notice to the settler, to the satisfaction of the Register of the Land Office, that the person having filed such affidavit has actually changed his residence, or abandoned the land for more than six months at any time, *then and in that event the land so entered shall revert to the government.*”

His homestead right continues until, after due notice to him, certain proofs are made before the land office; this was not done, as shown by the issuance of patent. Therefore he had a subsisting homestead right at the time his wife made her declaration. The case is thus brought

within the rule of the cases heretofore cited, holding that where the homestead right has once been initiated, mere subsequent non-residence does not forfeit the claimant's homestead right therein, and the attempt of the claimant or of his wife to acquire a second homestead is void.

In some states, the claimant's removal from the homestead without the intention of returning, and his establishment of a permanent residence elsewhere, are held to forfeit his homestead right. But in case of a government homestead, non-compliance with the requirements as to residence does not *ipso facto* forfeit the claimant's homestead right; the government can waive its right to take the homestead away from him for such non-compliance; and until the government declares a forfeiture he still has a subsisting homestead right in the land. A government homestead, therefore, belongs to the class of homesteads which are not forfeited by non-residence.

Joseph McCaffery legally "entered" said land as required by law by making formal application for the land, and filing the preliminary affidavit and paying the fees required by Sec. 2290, Rev. Stats. U. S.

Hastings, etc., Ry. vs. Whitney, 132 U. S. 357-363.

By such entry the land became segregated from the public domain and appropriated to private use; his homestead right thereby attached to and became fastened to the land, and he acquired an inchoate title which by future residence and cultivation could ripen into a perfect title.

Kansas Pac. Ry. Co. vs. Dunmeyer, 113 U. S. 629-644.

Nelson vs. Big Blackfoot M. Co. 17 Mont. 553-554.

Graham vs. Hastings & Dakota Ry. Co. 1 Land Off.
Dec. 362.

Such homestead right was unassailable until some failure to comply with the law. Upon failure to comply with the requirements as to residence, the homestead right became, not void, but voidable.

Sec. 2297, Rev. Stats. U. S., quoted supra.

Whitney vs. Taylor, 158 U. S. 85.

Hastings Ry. Co. vs. Whitney, 132 U. S. 357-363.

Graham vs. Hastings & Dakota Ry. Co. 1 Land Off.
Dec. 362-364.

Schrottberger vs. Arnold, 6 Land Off. Dec. 425.

St. Paul & Co. Ry. Co. vs. Forseth, 3 Land Off. Dec.
446.

Hastings & Dakota Ry. Co. vs. United States, 3
Land Off. Dec. 479.

United States vs. Turner, 54 Fed. 228.

In the present case no proceeding under Sec. 2297, Rev. Stats., quoted supra, was ever decided against Joseph McCaffery, as shown by the issuance of a patent to him. Whether he had lived on his homestead claim or not therefore his homestead right was subsisting and intact at the time of the filing of his wife's declaration of homestead; and such attempt by her to establish a second homestead was void.

In the homestead law of every state, it is an implied

or express condition to the establishment of a homestead that the claimant does not already possess one, either in the same or in another state.

Sec. 1700 of the Montana Civil Code provides:

“In order to select a homestead, the husband or other head of a family, *or in case the husband has not made such selection*, the wife must execute and acknowledge in the same manner as a grant of real property is acknowledged, a declaration of homestead, and file the same for record.”——

Under this section, the wife cannot select a homestead if the husband has selected one. There is no reason why the words “in case the husband has not made such selection” should be construed to apply only to a selection by the husband in Montana; it is fair to presume, in view of its being the policy of the law not to allow the husband to have a homestead in one state, and the wife to have a homestead at the same time in another state, that the words “such selection” were intended to apply to a selection by the husband either in Montana or in any other state, and either under the Montana state law or the law of some other jurisdiction, as, for, instance, a selection by him of a government homestead. Such would be the literal interpretation of the words in question. Applying the words “such selection” in the statute to the selection by the husband of a government homestead, it would follow that the only condition under which the wife could select a homestead did not exist, and that the homestead sought to be established by her was void.

Montana C. C., Sec. 1701, provides:

“The declaration of homestead must contain :

“1. A statement that the person making it is the head of a family; or when the declaration is made by the wife, showing that her husband has not made such declaration, and that she therefore makes the declaration for their joint benefit * * * *.”

While Joseph McCaffrey, in the affidavit required by Sec. 2290 of the Revised Statutes of the United States (as amended by the Act of March 13th, 1891, c. 561, Sec. 5), by which he initiated his government homestead claim, did not make a declaration of homestead which would have been sufficient to initiate a state homestead in Montana, yet he did in such affidavit make a formal written statement that he “was the head of a family;” “that such application was honestly and in good faith made for the purpose of actual settlement and cultivation” * * * * and that he “would faithfully and honestly endeavor to comply with all the requirements of law as to settlement, residence and cultivation necessary to acquire title to the land applied for” * * * * and that he “does not apply to enter the same for the purpose of speculation, but in good faith to obtain a home for himself.” These averments bear a close resemblance, generally speaking, to a homestead declaration. For the reasons above given, the requirement that the wife’s declaration contain a statement showing “that her husband has not made such declaration,” must be held to mean that she must show that he has not made a declaration of homestead in Montana or in any other state, or on government land; and if he has already made a declaration of home-

stead securing him a homestead exemption elsewhere, whether made according to the requirements of the Montana law, or those of some other state or of the United States, then her averment in her declaration that her husband "has not made such declaration" is false, and her declaration therefore void.

Her declaration must also contain a statement that she "makes the declaration for their joint benefit." But she is not entitled to make the declaration for their joint benefit if he is not entitled to such benefit; and he is not entitled to the benefit of a homestead declared by her, when he is making claim to and enjoying a government homestead exemption.

The homestead filing on public lands should have been admitted in evidence, as tending to show whether or not the claim of homestead in the Anaconda property by Mrs. McCaffrey was made in good faith.

Power vs. Burd, 18 Montana 22.

The ruling of the Court that the plaintiff in error could not introduce the record evidence of Mr. McCaffery's filings, proof and patent, without showing that he had lived on his government homestead claim, was something that should not have been required of the plaintiff, inasmuch as it was something peculiarly within the knowledge of the opposite party. And as shown above, also, his non-residence upon his homestead claim was a defect of which the government alone could take advantage.

III.

THE TWO-HOUSE QUESTION.

(Transcript, pp. 30-40, incl.)

A HOMESTEAD CANNOT INCLUDE TWO DWELLING HOUSES, ONE OF WHICH IS OCCUPIED BY THE CLAIMANT AND THE OTHER LET TO TENANTS.

Mont. C. C. 1670 (Cal. 1237) provides:

“The homestead consists of the dwelling-house in which the claimant resides, and the land on which the same is situated, selected as in this title provided.”

Sec. 1693 (not in California) provides:

“Homesteads may be selected and claimed:

“Consisting of * * * * a quantity of land not exceeding in amount one-fourth of an acre, being within a town plot, city or village, and the dwelling-house thereon and its appurtenances. Such homestead * * * * shall not exceed in value the sum of Two Thousand Five Hundred Dollars.”

The California section, corresponding to Mont. C. C. 1693, provides:

“Sec. 1260. Homesteads may be selected and claimed:

“(1) Of not exceeding Five Thousand Dollars in value, by any head of a family.”

In the case of Vincent vs. Vineyard, 24 Mont. 207, the Court, by Mr. Justice Pigott, says: “The Legislative As-

sembly of Montana adopted Secs. 1670-1703 of the Civil Code of 1895 from California, in whose Civil Code they appear as Secs. 1237-1265. In transplanting the homestead law from California to Montana the value of the homestead exemption was reduced to \$2,500.00 and a limit upon area fixed.”

In the case of Yerrick vs. Higgins, 22 Mont. 502, the Court, by Chief Justice Brantly, says: “The former of these provisions (referring to the two Montana sections above quoted), defines the homestead in general terms; the latter limits this general definition and specifies particularly the subject matter to which the selection and claim may apply. Standing alone, the general definition would leave no limit to the amount or value of the property selected and claimed, provided that the claimant resided in his dwelling upon it. The sections of our code providing for the selection of a homestead by the head of a family were all adopted into the Code of 1895 from the California Code, except Sec. 1693, which fixes the limitations; this section was brought forward from the First Division of the Compiled Statutes of 1887 and is substantially the same as Sec. 322 of that Code. * * *

* In this state the homestead is purely a statutory right.”

Sec. 322 Comp. Stats. of 1887, from which Mr. Justice Brantly says Sec. 1693 was taken, and which appears from the above-quoted remark of Mr. Justice Pigott in Vincent vs. Vineyard, to have been taken originally from California, reads as follows:

“Sec. 322. A homestead, consisting of * * * a quantity of land not exceeding in amount one-fourth of an

acre, being within a town plot, city or village, and the dwelling-house thereon and its appurtenances, *owned and occupied by any resident of this territory*, shall not be subject to forced sale on execution or any other final process from a Court. Provided, such homestead shall not exceed in value the sum of Two Thousand Five Hundred Dollars.”

The homestead law has never been construed by the Montana Supreme Court as applied to the rental of property claimed as homestead. We therefore look to the California decisions construing the sections of the Montana Civil Code above quoted.

In *Gregg vs. Bostwick*, 33 Cal. 220 (which was decided under the California Statute of 1851, which is the same as Sec. 322 above quoted, except that there is no limitation of area, and the limitation of value is \$5,000 instead of \$2,500), referred to in *Thompson on Homesteads*, Sec. 130, as declaring a rule on this point, “at once *reasonable* and easy of application,” the facts were that a portion of the property claimed as homestead under the declaration was rented to tenants. It was asserted on behalf of the homestead claimant that he was entitled to an exemption of \$5,000 worth of real estate, providing only that he had his residence thereon, and that the portion not occupied by himself and family could be used for any purpose he chose, either for carrying on his own business or for rental to tenants. But the Court held: “The homestead law is founded upon the idea that it is good for the general welfare that every family should have a home, a place to abide in, a castle where it can find shelter from

financial disasters and protection against the pursuit of creditors who have given credit with full knowledge that they cannot cross its threshold. But it is not founded upon the idea that every family ought for the sake of the general good, to be allowed to hold \$5000 worth of land free from the touch of honest creditors, provided they reside upon and use some portion of it as a homestead. *

* * * The written declaration for which the statute provides does not of itself alone impress upon the land the quality of a homestead. * * * * The premises to be described in the declaration are such and such only as the parties are residing on and using as a homestead at the time their declaration is made. If more is included, it will not for that reason become a part of the homestead, and therefore exempt from execution, notwithstanding the whole may be less than \$5,000 in value. * * * *

The primary object of all legislation in the subject of homestead is, not to exempt from forced sale a certain amount of real estate of the head of a family, including the homestead, whether estimated by quantity or value, but to exempt the homestead, including the quantity or value, within the limits specified. In some states the exemption does not exceed a certain quantity of land, while in others, as here, the exemption is limited to a certain value. But in neither case is quantity or value the primary object. They come into account merely as restrictions or limitations upon the privilege. Neither quantity nor value can be taken into account as tests as to what the homestead is in a given case, for they in no just sense enter into the definition of a homestead, either

in the abstract or within the meaning of the statute. They do not come into account until the homestead has been ascertained by other tests, and then they operate as limitations. The statute does not provide that "a quantity of land, not exceeding in value \$5,000, including within its boundaries the dwelling-house and its appurtenances, shall be exempt." On the contrary, the language is, "*The homestead* consisting of a quantity of land, together with the dwelling-house thereon and its appurtenances, not exceeding in value the sum of \$5,000, shall be exempt." The difference between the two forms is too obvious for explanation. The former makes the exemption of \$5,000 worth of land the primary object, and the homestead merely a necessary incident. The latter makes the homestead the primary and the sole object of the exemption, with a limitation as to value. * * * * The legal meaning of the word "homestead" is also the popular meaning. It represents the dwelling-house with the usual and customary appurtenances, including outbuildings of every kind necessary and convenient for family use, and land used for the purposes thereof." The Court accordingly held that the part rented to tenants was not part of the homestead, though claimed as such.

This case is quoted from at length because it covers all the points we raise in regard to the tenant house, and because it shows the scope and meaning of Secs. 322 and 1693 above quoted, and because the definition of homestead there given was subsequently enacted in statutory form, appearing in Mont. C. C., Sec. 1670, *supra*.

In the case of *Tiernan vs. His Creditors*, 62 Cal. 286, a

double house on a 35-foot lot was occupied, one-half by the homestead claimant and the other half by his tenant. The Court held the tenant portion of the premises not included in the homestead. The Court distinguishes the case from that of a person residing in a building and keeping lodgers. A double house is practically two houses and easily divided; it is often the case that one side of such a house is owned by one person and the other side by another person. The Court, therefore, practically decides that a separate and additional house, rented to tenants, is not exempt, especially if built and designed for an independent family. In the case now before the Court the tenant house was complete in itself, with its own kitchen, parlor and bedrooms, a complete house, with its own independent out-buildings, and with its rear yard separated by a fence from the rear yard of the homestead claimant; so that the entire tenant premises were evidently built and designed for the use of an independent family. (Tr. 36.)

In the case of *King vs. Goetz*, 70 Cal. 236, there was a single lot, 25 feet wide. The owner resided in a house on the rear of the lot, and on the front part of the lot was a house rented to tenants; the latter premises were held not part of the owner's homestead. But the Court held that the fact of the owner's claiming the entire lot under his declaration did not invalidate his claim as to the part that was really homestead, which was held not subject to execution.

In the case of *In re Crowley*, 71 Cal. 300, the owner resided on five acres of ground, the remainder of the farm being rented. He nevertheless filed a declaration of home-

stead on all. The Court held that the owner could not file a homestead declaration on the whole so as to include the portion that had never been occupied by him, and which at the time of the declaration was in the exclusive possession and occupancy of his tenant. The Court says: "When part only of the land described in the declaration is actually used and appropriated as the home of the family, the remainder not so used and appropriated, constitutes no part of the homestead claim." In the case now before the Court, although the owner claims to have made some use of a portion of the tenant premises, yet it is undisputed that a portion thereof was, at the time of and long before and ever since the filing of the declaration, in the exclusive possession of the owner's tenant. (Tr. 30-33, and Tr. 37, l. 29.)

In the case of *Malony vs. Hefer*, 75 Cal. 422, there were two houses on one lot, the front house rented to tenants and the rear house occupied by the owner's family. A homestead declaration was filed on the entire property. The Court held that the front part of the lot never became part of the homestead and was subject to execution. The Court says: "The benign object of the statute was to protect the home of the owner from forced sale, and not to withdraw from the reach of creditors property of the debtor used by the debtor as a source of revenue for "the support of himself and family." In that case, as in the case now before the Court, the two premises were separated by a fence. (Tr. 36.) The Court held that the tenant part did not and could not become a part of the homestead because (as in the case before the Court) not used as a

home for many years prior to the declaration. (Tr. p. 37, l. 19.)

In the case of *In Re Allen*, first decided in 16 Pacific 319, and that decision reversed in 78 Cal. 293, there were two adjoining lots, the owner's residence on one, and the rear part of the adjoining lot separately enclosed and containing his well, cowhouse and other outbuildings. These portions of the premises were admitted to be homestead. On the front 89 feet of said adjoining lot was a building, a portion of which was rented for a wagon-shop, and the building was also used in part for the owner's business of blacksmithing, said 89 feet of ground being used in connection with these occupations. This 89 feet was held to be not a part of the homestead.

In the case of *Lubbock vs. McMann*, 82 Cal. 226, a declaration was filed on the owner's homestead lot, on which the owner subsequently built a second house which he rented to tenants. The Court held that the homestead character having once legally attached to the entire property, and it being provided by Cal. C. C. Sec. 1243 (Mont. C. C. Sec. 1676), that, "A homestead can be abandoned only by a declaration of abandonment or a grant thereof, executed and acknowledged by the husband and wife,"—neither the homestead nor any part of it could be abandoned except in the manner provided by statute, and that after the homestead character had once attached, the use of the homestead, or any part of it by the owner, for renting or in any other way, did not make it any the less homestead, and therefore the entire premises, including the tenant premises, were exempt. But the Court said:

“But if at the time of filing the declaration for record, the houses now standing upon this lot had been standing there as they do now, and occupied as they now are, only the one occupied as a dwelling by the owner with the addition of the lot used in connection therewith, would have been impressed with the homestead character. As to the other and the land used in connection therewith, the attempt to dedicate it as a homestead would have been inoperative.”

In the case before the Court the tenant premises were such at the time the declaration was filed, and actually occupied by a tenant. (Tr. 37, l. 14.)

In the case of *Heathman vs. Holmes*, 94 Cal. 291, the Court held, as it had held in *Tiernan vs. His Creditors*, supra, that using a part of the owner's residence for lodging-house purposes does not deprive the owner of the benefit of a homestead, if he continues to reside therein. But the Court distinguishes the case of *Malony vs. Hefer*, supra, saying: “In said case there were two houses entirely separate and distinct; the family lived in one and rented the other.”

In the case of *Huelmantel vs. Huelmantel*, 49 Pac. 574, there were two houses on a lot, the rear house occupied by the owner as a home and the front house generally leased to tenants. The owner filed a declaration on all. Held, that only the rear part was homestead.

In the case of *In re Ligget*, 49 Pac. 211, there were several lots all claimed as homestead under a declaration. On a portion of one lot, separated from the remainder by a fence, was a dwelling-house and appurtenances; it had been rented by the owner at eight dollars a month, but

had not been rented since the filing of the declaration. The Court held that in view of the statutory definition of a homestead, this portion never became part of the homestead.

There are no cases in California opposed to the doctrine of the preceding cases. These cases are all based upon and are practically constructions of the statutory definition of homestead which was adopted in Montana from California in 1895, with the California construction thereof. The Supreme Court of Montana has frequently held that where this state has borrowed a statute from another state, it borrows at the same time the construction placed thereon by the Courts of the latter state, and that such construction is not only to be treated with respect, but is binding on the Courts of this state.

Sharman vs. Enkes, 20 Mont. 557.

Stadler vs. First Nat'l Bank, 22 Mont. 190-203.

B. & B. Co. vs. M. O. P. Co. 25 Mont. 41-73.

State vs. Fortune, 24 Mont. 154-157.

Therefore the dictum in the case of Yerrick vs. Higgins. 22 Mont. 502, supra, where the Court says: "Standing alone the general definition would leave no limit to the amount or value of the property selected and claimed, providing that the claimant resided in his dwelling-house upon it," must be regarded as inadvertent and too broad and general to be an exact statement of the law, because the words of the Court, taken literally, would mean that a man could hold as exempt property within the limit of area

and value, provided he resided on it, though the greater part of it were devoted to business purposes or residence, in separate buildings, by the owner's tenants. The Court's words, if taken literally, put a construction on a statute adopted from California exactly contrary to the obvious meaning of the statute, and also contrary to the uniform construction of the statute by the California Courts, adopted from California with the statute. If, instead of the phrase "providing that the claimant resided in his dwelling upon it," the Court had said, "Providing he occupied it all for residence," or "providing he used it all for homestead purposes," the meaning of the statute as taken from California would have been correctly stated, and it is certainly not a violent assumption to assume that the Court intended by its language to express the latter meaning. Anyhow the expression is a dictum. The Court below decided, on the strength of this phrase, that tenant houses may be properly included in a homestead declaration, although the phrase had been cited by neither side in argument.

The foregoing cases, therefore, construing the statutory definition of homestead as found in Sec. 1670, state the law for Montana on the subject of tenant houses, at least unless Sec. 1693 be given a construction opposed thereto.

As stated in *Yerrick vs. Higgins*, supra, Sec. 1693 "fixes the limitations" and "limits the general definition;" if it had the effect of allowing tenant house as a part of the homestead, it would enlarge rather than "limit" the general definition. It is stated in *Yerrick vs. Higgins*, supra, that Sec. 1693 was taken from Sec. 322 of the Montana

Compiled Statutes of 1887. Montana C. C., Sec. 4653, provides:

“The provisions of this Code, so far as they are the same as existing statutes, must be considered as continuations thereof, and not as new enactments.”

Therefore Sec. 1693, as taken from Sec. 322 Comp. Stats., would be a continuation thereof and not a new enactment. But Sec. 1670, adopted from California in 1895, would be a new enactment, and would, with the California construction thereof contemporaneously adopted, control Sec. 1693 and constitute a repeal or an amendment thereof insofar as they could not be reconciled. This argument is made because a statute almost identical with Sec. 322, Comp. Sts., from which Sec. 1693 was taken, and precisely identical with the statute construed in *Gregg vs. Bostwick*, supra, was given a contrary construction in Nevada.

But it appears from *Vincent vs. Vineyard*, supra (24 Mont. 207), that the entire homestead law of Montana was originally taken from California; therefore the construction governing Sec. 1693 would be that given to the almost identical California statute in *Gregg vs. Bostwick*, supra.

Statutes of the same general form and phraseology as Sec. 322 or Sec. 1693, supra, are found, not only in the California homestead law of 1851, which was construed in *Gregg vs. Bostwick*, supra, but also in the old Iowa homestead law and in the homestead laws of Michigan and Wisconsin. These statutes, however, differ from each other and from the Montana law in regard to the limitations, Iowa and Michigan, like Montana, having limitations both

as to value and area, California having a limitation only as to value, and Wisconsin having a limitation of area only. We will consider the decisions of these states:

IN MICHIGAN, in the case of *Dyson vs. Sheley*, 11 Mich. 527, as in the case of *Tiernan vs. His Creditors*, 62 Cal. 286, there was a double house on a lot, one side leased to tenants and the other side occupied by the owner. The rear yards were not separated by any fence. The tenant side was held subject to execution.

In the case of *Gene vs. Maynard*, 44 Mich. 578, the homestead claimant having erected a business block to rent, on a portion of his homestead lot, the Court held that he thereby abandoned that portion of the lot as a part of his homestead.

IN WISCONSIN, in the case of *Casselman vs. Packard*, 16 Wis. 114, there were on the ground claimed as homestead, the residence of the owner and also tenement buildings. The Court held that only the owner's dwelling-house and the land appurtenant thereto were exempt.

In the case of *Schoffen vs. Landauer*, 19 N. W. 95, the owner lived in a house on one end of his lot; he moved to a house on the other end of the lot, renting the first house, which, together with that portion of the lot pertaining thereto, was held not exempt. The Court said that the ground exempt as a homestead must be occupied solely for the purpose of a homestead; that the owner had a homestead right in the part where he lived by actual possession and dwelling, and he could not have the same right in the other end of the lot by construction and claim.

IN IOWA, in the case of *Kurz vs. Brusck*, 13 Ia. 371,

it is held that a tenant house cannot be exempt; this conclusion is reached both under the then existing statute and under the former statute found in 1 Ia. 435 and which is of the same general phraseology and character as Sec. 1693. The later Iowa Code expressly provided that the homestead should not embrace more than one dwelling-house

Also in the case of *Kelley vs. Williams*, 81 N. W. 230, a lot claimed as part of the homestead, on which was a barn which the owner had rented for many years, was held not exempt.

IN NEVADA AND IDAHO the statute is of the same general character under discussion, but those states furnish no case allowing a second dwelling-house, rented to tenants, to be part of the owner's homestead.

It has been held in certain Nevada cases, where the owner used a portion of the premises claimed by him as homestead, for the carrying on of his own business, although he did not rent any portion, that the intent of the Legislature was to exempt \$5,000 worth of real estate, and that the owner, residing thereon, could use it for any purpose he chose. It is a question, however, whether even in that state, the renting of a part or all of the homestead premises would not be deemed an abandonment of the portion rented. The Court is careful to say that the claimant used the entire premises himself, and did not rent any portion thereof. It does not follow, because the owner is allowed to use the property in any way he sees fit, that he can turn it over to another man for the latter's dominion and use, without thereby abandoning it. As will be seen, a similar construction was placed on the

early Texas constitutions by the early Texas cases, but this construction was subsequently repudiated as unwarranted by the wording of said constitutions. These Nevada cases are scathingly criticised, as giving an obviously false and absurd construction of the statute, in Waples on Homesteads, pp. 235 et seq., where the legal profession are advised not to give them any extra-territorial influence outside of the state where rendered.

We will now briefly call attention to the rulings of the Courts on this point in states where the homestead law differs from both Sec. 1670 and Sec. 1693.

IN KANSAS, under a provision in the Constitution that the "homestead, to the extent of one acre * * * * (without regard to value), occupied as a residence by the family of the owner, together with all the improvements on the same, shall be exempt,"—It was held in the case of Ashton vs. Ingle, 20 Kan. 670, that land, not a part of the homestead, though claimed as such, is subject to execution, and that a lot adjacent to the owner's residence, with tenant houses thereon leased to and occupied by tenants as their residences, is not part of the owner's homestead, though claimed as such. The Court says: "The words *homestead* and *residence* cannot be intended to include some other and independent family's home and residence. The owner cannot claim that such houses and lots are a part of his own home and residence, although they may adjoin the same." It is to be noted that, under the Montana or California law, a tenant may claim his residence as a homestead. But, under the rule stated in Cyc. of Law, 2d Ed. Vol. 15, p. 602, "Two separates es-

tates of homestead cannot exist in the same land at the same time.” Therefore the landlord cannot claim the tenant property as part of his own homestead.

In the case of *Poncelor vs. Campbell*, 63 Pac. 606, tenant houses and premises adjoining the owner’s residence, but separated therefrom by a fence, were held not part of the owner’s homestead.

IN KENTUCKY, the homestead law as given in 4 Bush 47, provides that “So much land shall be exempt as a homestead, including the dwelling-house and appurtenances, as shall not exceed in value \$1,000.” In the case of *Garrison vs. Penn.*, 66 S. W. 14, a tenant house on the same lot as the owner’s residence, but separated therefrom by a fence, was held not exempt.

IN TENNESSEE, in the case of *Wade vs. Wade*, 9 Baxt. 612, the statute provided that a homestead “In the possession of the head of a family to the value of \$1,000 shall be exempt.” It was held that ground adjoining the owner’s residence, rented out on shares, was not exempt, because it was not in the owner’s possession.

IN TEXAS, the constitution of 1845 provided for the exemption of “The Homestead of the family, not exceeding 200 acres of land, not included, in a town or city, or any town or city lot or lots in value not to exceed \$2,000.” This was substantially re-enacted in the Constitution of 1869, the amount \$2,000 being increased to \$5,000.

In the case of *Moore vs. Whitis*, 30 Tex. 440, on the lot claimed as homestead were the owner’s residence and also his store building. The Court held them all exempt.

This case and other cases of a similar purport were over-

ruled in *Iken vs. Olenick*, 44 Tex. 195, decided in 1875. The Court held that value was a mere limitation, that a homestead is confined to the residence of the owner, and does not include property used merely for business or profit. The Court said: "It is not the purpose of the Constitution to exempt a definite quantity of land in the country or lots of a designated value in the city, irrespective of the uses to which such property had been applied, so as to include property that from its nature and character or use did not form part of the homestead. The leading idea of the homestead exemption is to furnish a home and shelter to the family, limited, not to property of a specific value irrespective of its uses, but to the residence of the family."

In 1876 a new Constitution was adopted with the following homestead provision: "The homestead in a city, town or village, of lot or lots not to exceed in value \$5,000 at the time of their designation as the homestead, without reference to any improvements thereon shall be exempt, provided that the same shall be used for the purpose of a home or as a place to exercise the calling or business of the head of the family; provided also, that any temporary renting of the homestead shall not change the character of the same when no other homestead has been acquired." (The foregoing provision is found in 57 Tex. 429.)

In this connection the Supreme Court of Texas, in the case of *Anderson vs. Sessions*, 51 S. W. 874, says that by the Constitutional provision of 1876, *supra*, the people of Texas made for themselves a definition of homestead,

controlling on the Courts, though different from any pre-existing definitions.

Under this Constitutional provision the Courts hold that the permanent habitual renting of the homestead, or a part thereof, is an abandonment of the portion so rented, mere temporary renting being protected by the Constitution.

In the case of *Evans vs. Womack*, 48 Tex. 232, it was held that a piece of ground which would have been a part of the homestead if used merely for a horse-lot or domestic garden, was not part of the homestead if cultivated or rented for the support of the owner's family.

In the case of *Peregov vs. Kottwitz*, 54 Tex. 500, it was held that a second house, with additional appurtenances, rented to tenants, was not exempt.

In the case of *Andrews vs. Hagadon*, 54 Tex. 575, it was held that a tenant house on a lot adjoining the owner's residence was not part of the owner's homestead.

In the case of *Keith vs. Hyndman*, 57 Tex. 425, it was held that ground used for income to raise produce to sell, was not exempt as part of the owner's homestead, and that the burden is upon the defendant to establish by evidence the facts necessary to protect his claim of homestead.

In the case of *Medlenka vs. Downing*, 59 Tex. 32, it was held that erecting a tenant house on part of the homestead was an abandonment of that part.

In the case of *Stringer vs. Swenson*, 63 Tex. 7, it was held that fencing off part of the homestead lot and renting it, made it lose its homestead character.

In the case of *Wynne vs. Hudson*, 66 Tex. 1, it was

held that renting to tenants was not a homestead use of property, and that such renting, unless temporary, as allowed by the Constitution, was an abandonment of the portion of the homestead rented.

In the case of *Milburn Wagon Co. vs. Kennedy*, 13 S. W. 28, the homestead claimant built and rented a tenant house on the homestead premises, separated from his residence by a fence. The day before the attachment was issued against the leased premises, he persuaded the tenant to surrender possession, removed the fence, and resumed possession. Held, that while tenant property it was not part of the homestead; and that if the owner resumed possession merely as a pretext to protect such portion from his creditors, he could not hold it.

In the case now before the Court, the uncontradicted evidence shows that the defendants took down the intervening fence after filing the declaration; and the evidence of the plaintiff tends to show (Tr. 31, l. 4) that the alleged occupancy of the frame shed at the rear of the tenant house by the defendants was a mere pretext to protect the tenant premises from their creditors, if indeed there was any such occupancy at the time the declaration was filed, and the jury should have been allowed to consider this evidence.

In the case of *Oppenheimer vs. Fritter*, 14 S. W. 1051. it was held that ground and building permanently leased were not exempt; if temporarily leased, they were exempt under the permission given in the Constitution.

In the case of *Blume vs. Rogers*, 15 S. W. 115, tenant premises were held not exempt.

So in the following cases:

Achilles vs. Willis, 16 S. W. 746.

Blackburn vs. Knight, 16 S. W. 1075.

Allen vs. Whitacre, 18 S. W. 160.

Pfeiffer vs. McNatt, 12 S. W. 821.

Hill vs. Hill's Estate, 19 S. W. 1016.

Ford vs. Fosgard, 25 S. W. 445.

Charles vs. Chaney, 26 S. W. 169

Hendrick vs. Hendrick, 34 S. W. 804.

Waggener vs. Haskell, 35 S. W. 711.

Jones vs. Lee, 41 S. W. 195.

Heatherly vs. Little, 52 S. W. 980.

Wursbach vs. Menger, 65 S. W. 679.

IN ALABAMA, in the case of Kaster vs. McWilliams, 41 Ala. 302, held, that the homestead, when rented, is not exempt; that it is absurd to say that the land is in the use of the family because the rent goes to maintain it.

In the case of Garland vs. Bostwick, 23 So. 698, held, that a tenant house was not part of the homestead, and that whether a building is homestead is determined by the character of the building and the use of it. In the case now before the Court, the character of the building shows that it was intended as the home of an independent family, and not as a mere annex to the adjoining residence of the owner.

IN FLORIDA, in the case of Greeley vs. Scott, 2 Woods 657 (Fed. Case No. 5746), it was held that tenant houses

are not part of a rural homestead, under the Constitutional provision allowing a homestead to the extent of 160 acres and the improvements on the real estate. Nor would a sawmill be a part of it.

In the case of *Smith vs. Guckenheimer*, 27 So. 900, the Court decided that a business building, used in part for the owner's residence, and in part rented to tenants, should be divided between the owner and his creditors. The Court said that a separate tenant building and the ground used in connection therewith would not be exempt.

IN MISSISSIPPI, in 67 Miss. 139, it was held that tenant premises were not part of the owner's homestead; so in 6 So. 736 and 7 So. 430. In these cases the tenant premises claimed as part of the homestead were not contiguous to the owner's residence, the law allowing non-contiguous lots to constitute one homestead.

IN SOUTH CAROLINA, in the case of *Harrell vs. Crea*, 16 S. E. 42, it was held, under the Constitution exempting "family homestead consisting of the dwelling-house, outbuildings and lands appurtenant," that land rented by the owner and not used in connection with his family homestead was not exempt. The Court held that the land in question was not appurtenant, but "on the contrary" rented out to another person.

IN NEW HAMPSHIRE, in the case of *Hoit vs. Webb*, 36 N. H. 158, held, that a tenant house is not exempt, and that value is a mere limitation.

The principle urged is asserted as a rule also in *Waples*

on Homesteads, pp. 146, 186, 188, and in Thompson on Homesteads, Sec. 130.

In the Encyclopedia of Law, 2d Ed., Vol. 15, page 586, it is stated: "A tract adjoining the premises occupied as a homestead, but leased to others and used only as a source of revenue, is held in most states to form no part of the homestead and not to be exempt."

IN ILLINOIS, where the statute expressly allows an exemption of \$1,000 of real property, providing only that the debtor resides thereon, it is held that he can use such portion of his exempt real estate as he does not need for residence purposes, for any purpose he wishes, including rental to tenants. There the statute makes the exemption the primary thing, and the homestead and residence feature merely incidental.

CONCLUSION.

Illinois appears to be the only state where it is expressly held that a homestead may be created so as to include property rented to tenants. Any theory that this can be done in Montana must needs be based on decisions founded on statutes or Constitutional provisions allowing temporary renting of the homestead or part thereof, as in Texas and Oklahoma; or on cases where, instead of there being a separate tenant building, there is but one building, which is occupied by the claimant as his residence, a part of it being rented, in which case the Courts are inclined to be more liberal as shown under the following head; or on occasional dicta to the effect that a homesteader may use

his homestead in any way he sees fit, provided he has his residence thereon, but these dicta almost invariably refer to the use of the homestead premises by the claimant for carrying on his trade or business and not for rental, or to cases where there is only one building, in which the claimant resides, and a part of which he uses either for his own business or for rental to tenants. The exceptional ruling in *Lubbock vs. McMann*, 82 Cal. 226, *supra*, may also be noted, where, after the establishment of the homestead in the premises, a tenement building subsequently erected thereon and rented was held exempt, on the ground that the homestead, once established, could not be abandoned, save by an instrument in writing; but in the case before the Court the tenant property was such when the homestead was sought to be established.

WHERE THERE IS A SINGLE BUILDING IN WHICH THE OWNER RESIDES, CLAIMING THE ENTIRE BUILDING AS HOMESTEAD, BUT A PART OF THE BUILDING IS DEVOTED TO NON-HOMESTEAD USES, AS TO THE OWNER'S BUSINESS, OR FOR RENTAL TO TENANTS FOR RESIDENCE OR BUSINESS, OR IS DEVOTED TO HOTEL PURPOSES, THEN, UNLESS IT IS PRACTICABLE TO DIVIDE THE BUILDING, ITS CHARACTER AS HOMESTEAD OR NON-HOMESTEAD IS DETERMINED BY ITS PRINCIPAL USE.

Here the Courts are in a dilemma which did not exist when the premises claimed as homestead but rented to

tenants consisted of a separate building and separate premises, or one-half of a double house. In that case a division could easily be made between the bona fide homestead premises and the tenant premises. But a hotel or business block, or any single building, is usually considered not divisible, and the Courts therefore feel compelled either to allow the whole building to be exempt as homestead, or none of it; and the test usually adopted to determine which it shall be, is that of principal use. Yet the Courts are much more liberal toward the homestead claimant under this state of facts than where there are separate buildings, because they are undisposed to take away the only home a man has, even though his use of it is in a large degree an evasion of the statute. For this reason Courts have not infrequently asserted that a homestead claimant may use the building in which he resides for any purpose he sees fit; and to bolster up that position, have put a strained construction on the homestead statutes to the effect that the homestead claimant may use the entire premises claimed as homestead for any purpose so long as he lives there. But it is to be noted that the same Courts which have held a single building exempt when resided in by the claimant, though principally used for non-homestead purposes, have uniformly held, where the case has been presented of two buildings, one resided in by the claimant and the other rented to tenants, that such tenant building with the ground appurtenant thereto was not exempt.

The Supreme Court of Montana has not passed upon this question.

The Supreme Court of California, in dealing with such a state of facts has adopted the doctrine of principal use in its decisions with practical uniformity. The following cases from that state may be cited on this point:

In the case of *Ackley vs. Chamberlain*, 16 Cal. 181, where a farm-house located on a mountain road was enlarged so that it might be, and was used as an inn for the entertainment of passing travelers, it was held by Mr. Justice Field that its principal use was as a farmhouse, and it was therefore held exempt. This case was decided in 1860, under the statute set forth in *Gregg vs. Bostwick*, almost identical with *Montana C. C.*, Sec. 1693.

Other cases in California decided on the same principal are:

In *re Noah*, 73 Cal. 590, where the Court held that a business block devoted principally to business was not susceptible of being made a homestead by the owner taking up his residence therein and filing a declaration.

In *re McDowell*, 35 Pacific 1031, where the owner of a hotel residing therein to carry on the business was held not entitled to claim the hotel as his homestead because principally used as a hotel.

In *re Ogburn's estate*, 38 Pac. 498, where a subsidiary use of the owner's residence for the owner's business was held not to destroy its homestead character.

Beronimo vs. Lumber Co. 61 Pac. 958, where a building erected for the purpose of carrying on a general merchandise store and hotel, the owner residing therein for the purpose of carrying on these enterprises, was held not exempt as his homestead.

The only case which does not fully harmonize with the foregoing is that of *Heathman vs. Holmes*, 94 Cal. 291, where the owner of a residence, reserving a small part of it for the residence of himself and family, rented the greater part for lodging-house purposes, and the entire building was held exempt. The question of principal use is not mentioned. The case could have been decided in the way it was on the theory laid down in *Lubbock vs. McMann*, 82 Cal. 226, that, the homestead character having once attached to the property, any use to which the owner might choose to put it would not constitute an abandonment of it, or destroy his homestead right in any part of it.

IN MICHIGAN, where the statute is more nearly like Sec. 1693 than that of any other state except the old Iowa statute on account of having the limitations both of value and area, the Court, having decided in *Dyson vs. Sheley*, 11 Mich. 527, that where a double house, one side of which was rented was claimed as a homestead, the tenant side was subject to execution, held in *Orr vs. Shraft*, 22 Mich. 260, where a two-story building was used, the upper story for the owner's residence and the lower story for the owner's business, that it was like the case of a lawyer having his law office in his house, and therefore, the principal use being the home use, the entire building was exempt as a homestead.

Subsequently, in the case of *King vs. Welborn*, 47 N. W. 106, where the owner of a two-story hotel resided therein for the purpose of conducting it, the doctrine of principal use was not followed, but the whole building was held

exempt as a homestead, the Court saying that to hold otherwise would render the statute nugatory as to those engaged in the business of hotel keeping; that the benefits of the statute are to be secured to all owners of land which they occupy with their families and who have no other home; that there is no apparent intent anywhere to exclude the families of hotel keepers from the benefit of the act.

IN WISCONSIN, where the phraseology of the statute is about the same as Sec. 1693, though there is no limitation of value, the same Court and the same Judge who delivered the opinion in *Casselman vs. Packard*, 16 Wis. 114, that a separate tenant house was not exempt, held, in *Phelps vs. Rooney*, 9 Wis. 70, that a large and valuable business block in which the owner resided, the remainder of the block being rented for business purposes, was all exempt.

In the case of *Harriman vs. Insurance Co.* 5 N. W. 12, where a large building, built and always used by the owner or his lessees for a hotel, was claimed as a homestead, the Court follows *Phelps vs. Rooney* on the principle of *stare decisis*, but says a better rule would have been that the property is not exempt unless it is principally used as the residence of the owner. The same Court thereafter decided in the case of *Schoffen vs. Landauer*, 19 N. W. 95, that a separate tenant house was not exempt.

In the case of *Binzel vs. Grogan*, 29 N. W. 895, the Court held that the homestead law was enacted in pursuance of a Constitutional provision requiring the Legislature to recognize by law the privilege of the debtor to enjoy the necessary comforts of life, by exempting a reas-

onable amount of property, and that a home was one of the necessary comforts of life in the enjoyment of which the Legislature was required to protect the debtor, and that the homestead exemption was enacted pursuant to this mandate of the Constitution. The Court therefore held that in view of the Constitution the Legislature must be deemed to have intended to exempt to every debtor the home which he owns and occupies, with the specified quantity of land appurtenant thereto, without regard to the uses to which he puts such land or the business he pursues upon it. Held, accordingly, that a hotel in the country, with the land connected therewith, was all exempt.

It is to be noted in this connection that the Supreme Court of Montana, in the case of *Yerrick vs. Higgins*, 22 Mont. 502, says that in Montana the homestead is a purely statutory right.

In the case of *In re Lammer*, 7 Biss. 269 (Fed. Cas. 8031), and the case of *In re Wright*, 3 Biss. 359 (Fed. Cas. 18067) (Wis), it was held that a building that by character and construction was a business block and not designed for residence, could not be the owner's homestead, although he resided therein.

IN MINNESOTA, under a statute very similar to Sec. 1693, though without any limitation of value, in the case of *Tillotson vs. Millard*, 7 Minn. 513, the Court held that the homestead was restricted to the home, and that the object of the statute was to provide a home and not to give the use of a certain quantity of land and dwelling-house for any other purpose, and that to call premises

homestead when the debtor resides elsewhere or rents would be a misnomer.

Yet, in the case of *Kelly vs. Baker*, 10 Minn. 154, the homestead was claimed in a business block in which the owner resided, but the greater part of which was rented out for various purposes. The creditor attempted to sell under execution the portion of the building not used by the family for residence, but the Court held the entire block exempt. The Court remarks that the homestead property can be put to any use the owner desires, there being no restriction in the statute. This case is followed, in cases involving the homestead character of business blocks, in *Winland vs. Holcomb*, 3 N. W. 341, and *Jacoby vs. Distilling Co.* 43 N. W. 52.

IN IOWA, the Court which held in *Kurz vs. Brusck*, 13 Ia. 371, that separate tenant houses are not exempt, held in *Rhodes vs. McCormick*, 4 Ia. 368, that a business block in which the owner resided on the 2d and 3d floors, but the first floor and the basement of which were rented for business, should be divided and the floors rented for business sold under execution. This case was followed in *Mayfield vs. Maasdom*, 13 N. W. 652, and in the case of *Johnson vs. Moser*, 24 N. W. 32, under similar states of fact.

IN KANSAS, the Court, having decided in *Ashton vs. Ingle*, 20 Kan. 670, that tenant houses were not part of a homestead, held in the case of *Hogan vs. Manners*, 23 Kan. 551, that where the owner used a room or two of his residence for his business, it was all exempt under the doctrine of principal use.

In the case of *Rush vs. Gordon*, 16 Pac. 700, where a brick block was used entirely for the owner's residence and business, the owner residing in the 2d and 3d stories, the first story being occupied by his store, the entire building was held exempt.

In the case of *Bebb vs. Crowe*, 18 Pac. 223, a building, the second story of which was used for the owner's residence, and the first story used in part for the owner's business and in part rented for business, the Court held that the entire building was exempt. The Court stated, however, that if a building should practically become a business house rather than a home, it would not be exempt,—thus recognizing the doctrine of principal use.

IN ALABAMA, in the case of *Garrett vs. Jones*, 10 So. 702, the owner of a business block resided therein, but the principal use of the building was for business, and it was therefore held not exempt. (The owner was a single man, but in Alabama a single man may have a homestead.)

And in *Turner vs. Turner*, 18 So. 210, a hotel was held not exempt because the principal use governed. The Court held that, while the rental of the homestead may contribute to the support of the family, yet that is not the sort of use intended by the statute, which contemplates the use of a thing and not of an income derived from it, and the Court declared this ruling to be in accord with the general run of authorities elsewhere.

IN FLORIDA, in the case of *Smith vs. Guckenheimer*, 27 So. 900, it was held that a business block occupied by the owner for residence, but used mainly for his business and the business of tenants, should be divided and the

part not used for residence sold under execution. The Court reviews the cases on the homestead status of such buildings.

IN TENNESSEE, in the case of *Flannagan vs. Stifel*, 3 Tenn. Ch. 465, the owner occupied the second story of his house as his residence and rented the first story. Held, all exempt.

IN TEXAS, in the case of *Hargadine vs. Whitfield*, 9 S. W. 475, the front part of a store was rented and the rear part was used by the owner as a warehouse, the two parts being separated by a frame partition. Held, that the portion used by the owner alone constituted his business homestead, and that the building should be divided and the rented portion sold under execution.

In the case of *Pfeiffer vs. McNatt*, 12 S. W. 821, where the owner of two adjoining stores which were connected by two arches, made some business use of both, but partly rented the first, and conducted his own business principally in the second, the second alone was held exempt as his business homestead. The Court said that a man could not expect to protect a block of business houses by doing conveyancing in one corner of them.

In *Freeman on Execution*, Third Edition, Sec. 244, it is said on page 1324, "Generally the Courts have considered all the uses and purposes for which the buildings have been constructed and used. If upon the whole it appears that the chief use or purpose of the building was that of homestead, they have not condemned the whole or any part to forced sale because some of the rooms or parts have been rented out or used for business pur-

poses. But if, on the other hand, the primary use of the building is for business purposes, they have held it subject to execution though occupied by the debtor and his family as a home;" and on page 1327, "The use of a residence for hotel purposes will not forfeit the debtor's claim to hold it as his exempt homestead; and the use of a hotel for residence purposes will not enable the owner to maintain a claim for its exemption as homestead;" and on page 1329: "If homestead laws are to be interpreted with reference to the well-known purpose of their enactment (to secure the debtor's home), they must be confined in their operation to that portion of the premises claimed which constitute the claimant's home, and so not to embrace building separated from the family residence and rented to tenants. * * * * If there are several distinct tenements, whether united into one structure or not, one tenement may be used as the home of the debtor, while the others may be used for rental or business purposes. In such case the former is clearly exempt because it is the homestead in fact, and the latter as certainly not exempt, for they are no more a part of the homestead in fact than if they were situated in remote parts of the town."

IN MASSACHUSETTS, in the case of *Mercier vs. Chace*, 11 Allen, 194, it is held that merely renting rooms in the homestead, the principal use being the as home of the owner, does not make any part of the building subject to execution.

And on the same principle of principal use, in *Lazell vs. Lazell*, 8 Allen 576, a country hotel was held exempt.

And in the case of Pratt vs. Pratt, 37 N. E. 435, where there was a tenant in a part of a single house built for one family and also occupied as the residence of the owner, the entire building was likewise held exempt.

CONCLUSIONS.

1. While the Courts are strict in denying to the homestead claimant the right to include in his homestead a separate tenant house adjoining his residence, yet they are liberal in the use they allow the claimant to make of his house when he has only one house; some courts holding that if he uses it principally for his home that is sufficient to protect it; other courts going to the extent of holding that, though his homestead use of it be secondary, yet it must be protected because otherwise he would be entirely deprived of a home; still other Courts holding that the building must be divided.

2. Leaving out of account a division of such a building (which has usually been deemed impracticable, and which has never been done in California, whence Montana derived her homestead statutes), we submit that the only method of treating such a building, which is just both to the debtor and his creditor, is to apply the test of its principal use to determine its homestead character, as is done in California.

3. In the case before the Court we have, not one, but two dwelling-houses, one entirely occupied by the claimant, the other rented to a tenant, but used by the claimant (so he claims) to some extent. Assuming that the

second building cannot be divided, it must go all to the claimant or all to his creditor. As the claimant has another house, he will not be entirely deprived of a home by losing this, and he is therefore not entitled to the extreme liberality sometimes shown when there is only a single house, in holding it all homestead though principally used for non-homestead purposes. Yet he makes some homestead use of it, and therefore has a claim on it; so has the creditor, because it is in part used for non-homestead purposes. The principal use of this second building and its appurtenant ground, we submit, is the proper test in determining its homestead character.

IF A HOMESTEAD DECLARATION IS FILED ON A LOT ON WHICH THERE ARE TWO DWELLING HOUSES, IN ONE OF WHICH THE CLAIMANT RESIDES, AND THE PRINCIPAL USE OF THE OTHER HOUSE IS AS A TENEMENT, THEN THE LATTER HOUSE WITH THE LAND APPURTENANT THERETO IS NOT PROPERLY INCLUDED IN THE HOMESTEAD DECLARATION AND DOES NOT BECOME A PART OF THE HOMESTEAD. AND IT DOES NOT MAKE SUCH ADDITIONAL HOUSE A PART OF THE CLAIMANT'S HOMESTEAD, BECAUSE MEMBERS OF HIS FAMILY MAY OCCASIONALLY, OR EVEN HABITUALLY, USE ONE OF ITS ROOMS AS A SLEEPING APARTMENT.

PREMISES CONSISTING OF SUCH A TENEMENT HOUSE, WITH ITS OWN REAR YARD ENCLOSED

BY FENCE, AND ITS OWN SEPARATE OUTBUILDINGS THEREON, FORM NO PART OF THE HOMESTEAD OF THE OWNER OF THE LOT, WHO HAS ON THE SAME LOT A SEPARATE DWELLING-HOUSE IN WHICH HE RESIDES, HAVING ITS OWN SEPARATE REAR YARD WITH THE CUSTOMARY OUTBUILDINGS THEREON APPURTENANT TO SAID DWELLING, EVEN THOUGH SAID CLAIMANT MAKE SOME USE OF THE TENEMENT HOUSE OR ITS YARD OR BOTH, AT LEAST IF HIS USE OF THE TENEMENT HOUSE AND ITS YARD BE NOT SO EXTENSIVE AND EXCLUSIVE AS TO CONSTITUTE THE PREDOMINANT AND PRINCIPAL USE THEREOF. BUT IF THE PRINCIPAL USE OF SUCH TENEMENT HOUSE AND ITS YARD AND OUTBUILDINGS IS FOR TENEMENT PURPOSES, OR IF IT IS THE OWNER'S HABIT AND PRACTICE TO ALLOW THEM TO BE USED PRINCIPALLY BY A TENANT WHEN ONE CAN BE SECURED, THEN SUCH PREMISES ARE SUBJECT TO EXECUTION AND FORM NO PART OF THE CLAIMANT'S HOMESTEAD.

There is only one case in California, we believe, that directly bears upon this point, as distinguished from the two points last discussed.

In the case of *In re Allen*, first decided in 16 Pac. 319, said decision being reversed in 78 Cal. 293, there were two adjoining lots, both claimed as the owner's homestead.

On one of these lots the owner resided with his family. The rear portion of the adjoining lot was fenced off and

contained the owner's chicken-house and outhouses. These two portions of the ground were admitted to be homestead. But the front 89 feet of said adjoining lot had on it a building in which were a wagon-shop rented to a tenant and a blacksmith shop used by the homestead claimant, the portion of the said 89 feet not occupied by the building being used in connection with these occupations. In the unfinished second story of said building, part of the homestead claimant's family slept. The Court in its first decision held that this 89 feet should be considered part of the homestead unless the family use thereof was merely incidental and the principal use of it was for business or renting. In the second decision the Court, ascertaining that it was established that the principal use of the 89 feet was for the business occupations pursued thereon, and not for family purposes, decided that said 89 feet was no part of the homestead.

IN MICHIGAN, in the case of *Dyson vs. Sheley*, 11 Mich. 527, where there was a double house on a lot, intended for two families, one side occupied by the owner as a residence and the other side leased to tenants, and where the Court held the tenant side of the premises to be not part of the homestead, but subject to execution, the facts were: The rear yards of the two houses were not separated by a fence, as they were according to the testimony in the case now before the Court; on the tenant side of the premises was a double privy used by both families. Also, as in the case now before the Court, the tenant side had been leased for several years.

This subsidiary use of the tenant premises by the home-

stead claimant was held not to operate to make it, or any portion of it, part of his homestead. The Court said: "The rights of the owner in the tenant side, whatever they are, do not predominate over those of the tenant, and do not show that the tenant had a mere easement." Here the Court decided that, the principal use of the tenant being for tenement purposes, said premises were subject to execution.

IN WISCONSIN, in the case of *In re Lammer*, 7 Biss. 269 (Fed. Cas. 8031), the owner's residence was on the rear of his lot; he built a business block on the front of the lot containing several stores. He partitioned off one of these stores and moved in with his wife, leaving part of his family in the old house. The Court held that he could not hold the block as his homestead.

IN IOWA, in the case of *Mayfield vs. Maasdom*, 13 N. W. 652, there was a two-story brick building, the second story of which was occupied by the owner as his residence; and the first story was used for business—except the stairway leading to the second story. In Iowa, as heretofore shown, it is the policy of the Courts, where certain stories of a building are used for the owner's residence, and other stories for business, to allow the stories devoted to business to be sold on execution as not part of the homestead. That policy was followed in this case. But in the first story were two small rooms separated from the store by partitions and used by the family to some extent for storage. The Court held that these rooms were essentially part of the storeroom and not exempt. Here the Court applied the doctrine of principal use to a portion of the

premises claimed as homestead and used therefor to some extent, but principally devoted to non-homestead uses. The storeroom being principally devoted to business, though a part of it was used for family purposes, was all held subject to execution.

IN KANSAS, in the case of *Ashton vs. Ingle*, 20 Kan. 670, on a piece of ground claimed as homestead were the owner's residence and appurtenant outbuildings on one end of the lot; on the other end, with no fences intervening, were two tenant houses. A clothesline was stretched from one of the tenant houses across the tenant ground on to the owner's part of the ground, and used jointly by the owner and his tenants. A walk also extended across the tenant ground, used by the tenants, and occasionally used by the homestead claimant. A cistern on the tenant ground was used by the tenants, and occasionally by the homestead claimant when his own cistern gave out. The Court held that these uses of the tenant part by the owner did not make such premises or any part thereof part of his homestead.

IN TEXAS, in the case of *Peregov vs. Kottwitz*, 54 Tex. 500, a tenant house and grounds with separate appurtenances was held not exempt, though the owner claimed to use the cistern thereon, and to use the ground for his garden.

In the case of *Nix vs. Mayer*, 2 S. W. 819, it was held that land not used for homestead purposes, except to supply the owner's family with water from a spring, is none of it homestead.

In the case of *Blum vs. Rogers*, 15 S. W. 115, the owner

of ten tenement houses, all claimed as belonging to his homestead, reserved the ground around the houses and used it for garden and other purposes. Held, that neither the houses nor the ground connected with them were homestead; that though the ground was used by the owner in connection with his own home, yet the principal use governed which was for tenement purposes.

In the case of *Achilles vs. Willis*, 16 S. W. 746, the lot adjoining the owner's residence was partly rented and partly used for stabling the owner's cow and for purposes of family washing. Held, that the lot was not so connected in use with the family homestead as to constitute part of it.

In the case of *Allen vs. Whitacre*, 18 S. W. 160, the Court held that pasturing a cow on land rented to tenants, not being the principal use of the land, does not make it part of the homestead.

In the case of *Pfeiffer vs. McNatt*, 12 S. W. 821, the owner of two adjoining business buildings, which were connected by arches, claimed them both as his business homestead, under the Constitutional provision protecting a man's place of business as part of his homestead. The owner, as Mayor, held Court sometimes in the rear part of the East building, sometimes in the rear part of the west building, according to the weather, there being a stove in the west building. The front of the east building was occupied by the postoffice without rent, and he was deputy postmaster. The front of the west building was rented to his brother for a store, and the owner of the buildings was clerk in the store. Held, that his claim to

the west building (which was in the main rented for a store), should not be upheld merely because he had a desk in the back end of it and did conveyancing and notary work there. The Court held that it would be unreasonable to protect his claim to both buildings.

In the case of *Ford vs. Fosgard*, 25 S. W. 445, the owner's residence was on the rear of the lots claimed by him as his homestead. On the front of the lots was a one-story brick house, usually rented to a shoemaker, the owner also using it for storage. Held, not exempt. Adjoining this one-story building was a two-story brick house, the second story of which was used by the owner's family and servants for sleeping rooms. The rear room of the first story was rented to two men lodgers and also used by the owner for storage, and he also kept his workbench there. The two front rooms on this floor were rented respectively for a barber shop and fruit stand, the owner keeping a key to each, not allowing his tenants exclusive use, but keeping a writing desk in the barber shop, where he did his writing, and storing articles in the fruit stand. The cellar under the two-story building was used as the family cellar. Held, that the building should be divided, and the fruit stand and barber shop sold under execution. Here the doctrine of principal use was applied to the shoe-shop, barber-shop and fruit-stand.

In the case of *Hendrick vs. Hendrick*, 34 S. W. 804, in addition to the owner's residence there were several tenements, the whole property being claimed as homestead. There was a common well. The owner used the tenant lots for pasture. The tenants had no exclusive right ex-

cept to the houses they lived in, and the tenant lots were used in common by the tenants and the owner. The tenant houses and the tenant lots were held no part of the homestead, and subject to execution.

In the case of *Jones vs. Lee*, 41 S. W. 195, there was, adjacent to the owner's residence an enclosed lot with a house thereon. The owner's cook had occupied the house, and the owner's calves fed on the lot, but there was evidence that for a year prior to the levy the house and lot were rented to a tenant. Finding of abandonment not disturbed.

In the case of *Henry vs. Nat'l Bank*, 44 S. W. 568, an instruction was approved to the effect that a subsidiary use such as occasionally sleeping on the premises by a part of the family was not sufficient to make property otherwise used and occupied part of the homestead.

In the case of *Heatherly vs. Little*, 52 S. W. 980, it was held that the principal use governs, and that casual or temporary use by the owner does not. And where adjacent land was bought and a house erected thereon for the purpose of renting the same, held, that a subsidiary use for homestead purposes does not make it part of the homestead.

In the case of *Phillips vs. Loan Agency*, 63 S. W. 1080, it was held that the owner of a vacant lot adjacent to his residence could not hold it as a part of his homestead, though he used it for the subsidiary purposes of cleaning carpets, piling wood and grazing his horse and cow. It appeared also that he had represented that it was not part of his homestead.

In the case of Wurzbach vs. Menger, 65 N. W. 679, the homestead claimant owned two lots adjacent to his residence. There were tenant houses on each, rented. The owner used the tenant lots for drying clothes, and his children and chickens had free access to the lots. Held, that the tenant premises were no longer part of the owner's homestead, and that the fact of their having been rented for ten years, and being necessary for the support of the owner's family, was conclusive evidence of permanent abandonment.

There are cases in Texas apparently in conflict with the foregoing, because they hold that a tenant house and grounds of which the homestead claimant makes some subsidiary homestead use, is part of his homestead. There are two classes of such cases :

1. The renting is shown to be temporary as a matter of fact, and therefore the tenant premises are protected as a part of the homestead under the express provision of the Constitution, even though the homestead claimant make no use of the tenant premises at all.

2. Where the claimant continues to make some use of the tenant premises, it is held evidence that he intends the renting to be merely temporary. The burden is placed on the creditor to prove that the renting is permanent, which he may be unable to do, though it may be a fact. Permanent renting constitutes an abandonment.

In the present case our claim is, not that the tenant premises were abandoned, but that they never became part of the homestead. And the burden is on the claimant to show that said premises were of such a character, and so

used, that they became part of the homestead when the declaration was filed. We show that they were rented for years, both before and after and at the time of the filing of the declaration; this being so they could not become a part of the homestead, unless the principal use of the tenant house and premises was by the homestead claimant for homestead purposes. To show that the renting was intended to be temporary would not avail the claimant in this state, because no distinction is made by statute between permanent and temporary renting.

Most of these Texas cases and some others that have been cited turn on the question of abandonment. In Montana and California a homestead once established cannot be abandoned except by a declaration in writing duly acknowledged and filed. But these cases are nevertheless in point, because the same facts which would constitute an abandonment in Texas would, either in Montana or in California, if existing at the time the homestead is attempted to be created, prevent its creation, or prevent the inclusion therein of that portion of the premises to which the facts apply. Thus, rental to tenants, if existing when the homestead right is sought to be initiated, excludes the rented portion, though claimed, from the homestead.

CONCLUSION.

In conclusion we would say:

(1) That in all the states which have statutes precisely or substantially the same as Sec. 1670 or Sec. 1693 of the Montana Civil Code, it is uniformly held, where the ques-

tion has been raised, that a tenant house, separate and apart from the owner's residence, though upon the same or an adjoining lot, is no part of the owner's homestead, though claimed as such, and is subject to execution.

(2) That in the other states, except in Illinois (where the statute makes the exemption the primary object and the residence thereon merely incidental), and in Texas (where the Constitution allows temporary renting), the decisions are so nearly uniform in holding the same way that the rare exceptions are not worthy of consideration.

(3) That where the rented part, instead of being a separate building, is in the single building occupied by the claimant as a residence, the Court decides as follows:

(a) Where it is a double house, they hold the building divisible.

(b) Where it is not a double house, the building is nevertheless divided in Iowa, Florida and Texas; but other Courts hold division impracticable.

(c) Where the building is held not divisible, the Courts usually decide that the entire building is, or is not, the claimant's homestead according as the building is found to be used principally as the residence and home of the claimant, or, is used principally for rental or business, giving to the claimant the benefit of the doubt where the uses seem to be about evenly balanced.

(d) Quite a number of decisions reject the doctrine of principal use under such a state of facts, and protect the entire building as the homestead of the claimant, though his use of it as a home is subordinate to other uses, on the principle that to hold otherwise would be to take

away the entire building from the claimant, thus depriving him of the only home he has.

But the Courts that so hold, uniformly hold, where the question has arisen, that a separate building, rented to tenants, is not part of the homestead.

4. Where there is a separate tenement, and some subordinate use is made by the homestead claimant of the tenement house and grounds, these are held, nevertheless, to form no part of his homestead.

In bringing to a close this brief, which has been long because we have deemed the homestead question to be essentially a matter of the construction of homestead statutes, we have one observation to make.

We have presented the effort of a single family to hold exempt as its family homestead three potential homesteads. There is, first, the federal homestead of Mr. McCaffery; second, the house where Mrs. McCaffery resided when she filed the declaration, with its appurtenant ground; third, the tenement house adjoining, with its appurtenant ground.

To allow the defendants to retain these three distinct properties, secure from their creditors, as homestead, would be a perversion of the spirit and intent of any and all homestead laws. It is the settled public policy that every debtor shall be allowed to select a home and hold it as a refuge for himself and family, free from his debts. If he fails to make such a selection, it is his own fault. If he does make such selection he should be limited to that; a family needs only one home; a man who owes more than he can pay is not entitled to the luxury of several resi-

dences. If he has several residences, or potential residences, and chooses one, so that it is legally exempt as his homestead, he should be held to that choice until it is definitely relinquished, so that the creditor may know where he stands. As is said in *Wright vs. Dunning*, 46 Ill. 271, and *Tourville vs. Pierson*, 39 Ill. 446, he cannot have two homesteads, either of which at his election will be exempt. We therefore submit that the first selection made by this family, the federal homestead, which was never relinquished or forfeited, was, at the date of plaintiff's deficiency judgment, the family homestead, and the only one they had or to which they were entitled.

We believe that, by reason of the errors shown, in the admission and rejection of evidence, and the refusal of instructions, the judgment should be reversed.

But for two reasons we also think it proper to suggest that the cause should be remanded to the lower Court with directions to enter judgment in favor of the plaintiff:

First. Because the record of the unstamped homestead declaration was void and therefore no state homestead was created.

Second. Because neither said declaration nor the record thereof could be made available as evidence on a new trial by post-stamping said instrument, for the reason that Sec. 13 of the War Revenue Act provides for post-stamping only certain instruments specified therein, not including such a certificate as the one in question; and said section as amended in the Act of March 2nd, 1901, provides for poststamping only instruments mentioned in

said amendatory act, from which the provision in regard to such certificates is entirely omitted.

And said instrument, if post-stamped, and its record, would not be available as evidence in a new trial, on account of the final provision of said Sec. 13, that "No right acquired in good faith before the stamping of such instrument, or copy thereof, as herein provided, if such record is required by law, shall in any manner be affected by such stamping as aforesaid." The plaintiff's intervening rights would not be affected by such post-stamping.

For the foregoing reasons the plaintiff in error respectfully submits that the judgment should be reversed, and the cause remanded to the lower Court with directions to enter judgment in her favor.

Respectfully submitted,

E. B. HOWELL,
CHARLES E. SACKETT,
Counsel for Plaintiff in Error.

NO. 957.

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

CLARA E. SACKETT,

Plaintiff in Error,

vs.

MARY McCAFFERY AND JOSEPH McCAFFERY,

Defendants in Error.

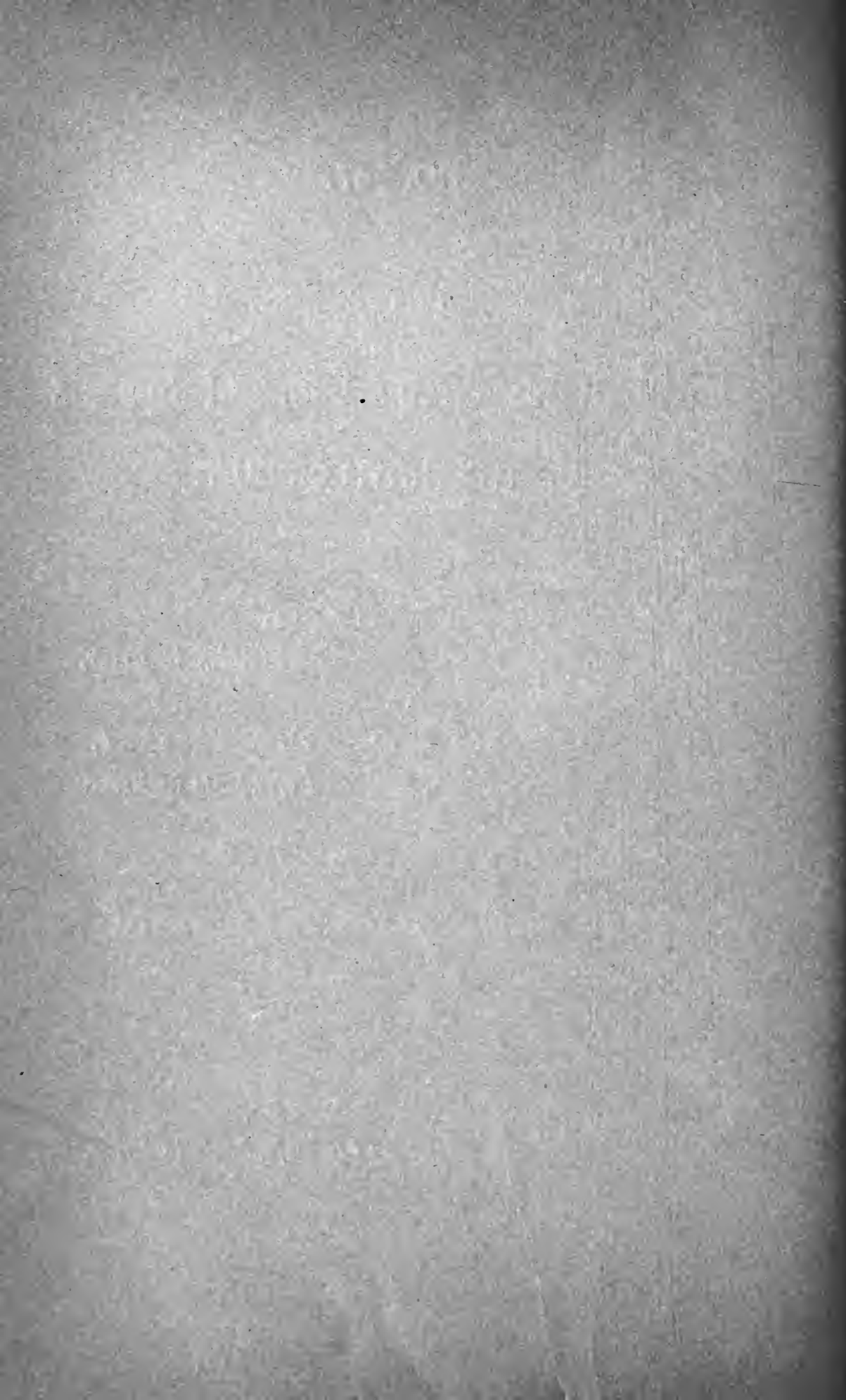
**BRIEF AND ARGUMENT FOR THE DEFENDANTS
IN ERROR.**

WILLIAM B. RODGERS,

Attorney for Defendants in Error.

FILED

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BRIEF AND ARGUMENT FOR THE DEFENDANTS
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ARGUMENT.

I.

THE STAMP QUESTION.

The plaintiff in error insists that the ruling of the court overruling her objection to the introduction of the homestead declaration was erroneous. Plaintiff in error objected to the introduction of said homestead declaration for the reasons:

First. That the said instrument offered in evidence was not stamped as required by the laws of the United States, in force at the date of its execution.

Second. That the notarial certificate of acknowledgment to said instrument offered in evidence, was not stamped as required by the laws of the United States, in force at the date of its execution.

Third. That the filing for record of the same in its unstamped condition was in violation of said laws, and that

The record thereof was void and of no effect against the rights of plaintiff. (Transcript, pages 28 and 29.)

This objection was overruled by the court and the homestead declaration admitted in evidence.

Plaintiff in error does not insist upon the first ground of her objection, but contents herself with claiming that the homestead declaration should not have been admitted in evidence, because the certificate of acknowledgment attached to said declaration is unstamped.

This contention of plaintiff in error might very properly be disposed of with the single observation that there is nothing whatever in the bill of exceptions showing that either the declaration of homestead or the certificate of acknowledgment was not stamped as required by the laws of the United States, and also that the objection urged upon the trial was not sufficiently specific to enable the trial court to know what the specific objection was that was urged against the admission of the declaration in evidence. The only thing which appears in the record indicating that the declaration of homestead or the certificate of acknowledgment was unstamped, is the statement of counsel in making the objection thereto, that neither said instrument nor the notarial certificate of acknowledgment was stamped as required by the laws of the United States, in force at the date

of its execution. This statement is not proof of the facts stated therein, and may have been, so far as the bill of exceptions advises us, absolutely untrue, and said objection may have been overruled by the court for the reason that the same was untrue. There is no evidence in the bill of exception affirmatively showing that the declaration of homestead or certificate of acknowledgment did not bear the proper internal revenue stamps. (Transcript, pages 26, 27, 28 and 29.)

It is true that a copy of said homestead declaration is contained in the bill of exceptions. (Transcript, pages 27 and 28.)

An inspection of this copy as it appears in the transcript, does not show it to have been stamped, but this is not sufficient to show that said declaration or the certificate of acknowledgment were unstamped, for in contemplation of law, the stamp is no part of either the homestead declaration or of the certificate of acknowledgment.

In an extended note to the case of *Knox vs. Rossi*, Lawyers' Reports Annotated, Book 48, page 319, it is said:

“The revenue stamp is not part of the instrument, and the fact that what appears to be a copy of the instrument in the paper book or settled case as prepared does not show that the instrument was stamped, is immaterial.”

The following cases are cited by the author in support of this statement:

Hallock vs. Jaudin, 34 Cal. 167.

Trull vs. Moulton, 12 Allen, 396.

Cabbott vs. Radford, 17 Minn. 320.

Owsley vs. Greenwood, 18 Minn. 429.

Kiefer vs. Rodgers, 19 Minn. 32.

In *Hallock vs. Jaudin*, *supra*, the Supreme Court of California, on page 175, said:

“The point that the complaint fails to show a cause of

action because the copy of the note therein contained is without a copy of any internal revenue stamp, is not tenable.

“In *Trull vs. Moulton*, 12 Allen, 396, and *Hitchcock vs. Sawyer*, 39 Vermont, 412, a copy of the note declared on is annexed to the declaration. No copy, however, of a revenue stamp was given. The defendant demurred, but the court held that the stamp was no part of the note, and that therefore a copy of it was not necessary.”

Every presumption is in favor of the regularity of the court's proceedings, and the correctness of its ruling. Therefore, in the absence of any affirmative showing in the bill of exceptions, that the certificate of acknowledgement did not bear an internal revenue stamp, it must be presumed, if the law requires that it should be stamped, that such was the case.

The objection of counsel was not sufficiently specific. It cannot be told therefrom whether the admission of the declaration was objected to, because the stamp was not of large enough denomination, or because the stamp was uncanceled, or because there was no stamp of any denomination upon the declaration or upon the certificate of acknowledgment, or because the stamps had been put on after the filing of said declaration for record without the formalities required by law in obtaining permission of the internal revenue collector for the district, and having the same cancelled by him. The language of the objection is that the declaration and the notarial certificate of acknowledgment to said declaration was not stamped as required by the laws of the United States, in force at the date of its execution. The court was not further enlightened and was left to determine without any aid from objecting counsel, what specific objection they desired to urge. This the court was not required to do, but might very properly overrule the objection without making an independent investigation of its own.

The objection which is now urged not having been specifically suggested to the court, and no ruling having been made upon such specific objection, the same cannot now be reviewed.

Ohio & Mississippi Railway Co. vs. Walker, 3 Am. St. Rep. 641.

Noonan vs. Caledonia Mining Co., 121 U. S. Rep. 400.

Railroad Co. vs. O'Reilly, 158 U. S. 334.

U. S. vs. McMasters, 4 Wallace, 680.

Burton vs. Driggs, 20 Wallace, 125.

Wood vs. Weimar, 104 U. S. 786.

Faber vs. Commercial National Bank, 62 Fed. Rep. 387.

In the case of Ohio & Mississippi Railway Company vs. Walker, *supra*, page 641, the court said:

“Objections to evidence to be of any avail must be reasonably specific. The particular objection must be fairly stated. It is not enough to state that the evidence is incompetent or that it is immaterial and irrelevant. This much is implied in the bare fact of objecting; if it be unnecessary to state the particular objection, counsel might as well say, ‘we object,’ and done with it, since a mere general objection amounts to nothing more, for it is simply tantamount to an expression of the fact that counsel do object. It is no answer to the proposition asserted by the authorities to say that the evidence itself may reveal the objection, for this may be said of all incompetent and irrelevant evidence when carefully scrutinized, and if this be true, then there would be no reason for requiring a specific objection in any case. But there is reason for requiring the particular objection to be stated with reasonable certainty, for in the hurry of the trial it cannot be expected

that particular objections will occur to the judge, although if stated he would readily perceive their force. Counsel who are presumed to have studied the case ought to be able to state the particular objections, and if none are stated, it is fair to presume that none exist, since an objection which cannot be particularly stated is not worth the making. The rule is a reasonable one, just to the court, and not burdensome to the parties, and it has been accepted as the law at least since 1846.”

It is insisted that the proof of acknowledgment is required to be stamped under the provisions of Schedule “A” of the War Revenue Act of June, 1898, which provides that “certificates of any description required by law, not otherwise specified in this act, ten cents.” And the question is presented for consideration, whether the words, “certificates of any description required by law,” includes the proof of acknowledgment of a homestead declaration, which proof is necessarily furnished by the notary public before whom the instrument is acknowledged. We do not think that it does.

In *United States vs. Ishan*, 17 Wallace, 503, the Supreme Court laid down the following rules to be applied in determining whether an instrument is subject to a stamp tax:

“First. Instruments described in technical language or in terms especially descriptive of their own character are classed under that head, and are not to be included in the general words of the statute.

“Second. The words of the statute are to be taken in the sense in which they will be understood by that public in which they are to take effect. Science and skill are not required in their interpretation, except where scientific or technical terms are used.

“Third. The liability of an instrument to a stamp duty,

as well as the amount of such duty, is determined by the form and face of the instrument, and cannot be affected by proof of facts outside of the instrument itself.

“Fourth. If there is a doubt as to the liability of an instrument as to taxation, the construction is in favor of the exemption, because in the language of Pollock, C. B., in *Girr vs. Scudds*, a tax cannot be imposed without clear and express words for that purpose.”

What plaintiff in error is pleased to call a certificate of acknowledgment, is universally referred to both in legal and ordinary nomenclature as “proof of acknowledgment” of an instrument. It is so termed in Sections 1600, 1601, 1602 and 1603 of the Code of Civil Procedure of the State of Montana, and is the only apt term by which the Congress of the United States could have specifically provided that the so-called “certificate of acknowledgment” of a notary should bear a ten cent stamp. Not having used the term “proof of acknowledgment” or the term “certificate of acknowledgment,” the law necessarily raises a doubt as to its applicability to certificates of acknowledgment, and under the rules hereinbefore enumerated, the construction must be in favor of the exemption, because “a tax cannot be imposed without clear and express words for that purpose.”

If, however, it should be considered that the language of the statute is specific enough and broad enough to include certificates of acknowledgment to an instrument of this character, then we apprehend that the Congress of the United States has exceeded its powers in imposing a tax upon the duties of officers of the state of Montana. The proof of acknowledgment of an instrument in the state of Montana may be taken before any justice of the supreme court, or any judge of the district court. It may be taken before clerk of a court of record, a county clerk, a notary public, or a justice of the peace. The taking of the

proof of acknowledgment and certifying thereto, is one of the functions of the state government, which is exercised through or by any or either of these several officials, and if the act of certification by the notary public of an acknowledgment can be taxed by the general government, then the same act performed by a justice of the supreme court or a judge of the district court must necessarily be taxed, and we do not believe that it would be seriously maintained that the Congress of the United States has the power to compel a judge of the supreme or district courts to pay a tax upon acts performed by him, either of a judicial or quasi-judicial character.

In *United States vs. Railroad Company*, 17 Wallace, 327, the Supreme Court said:

“There are, however, certain departments which are excepted from the general power. The right of the states to administer their own affairs through their legislative, executive and judicial departments, in their own manner, through their own agencies, is conceded by the uniform decisions of this court and by the practice of the federal government from its organization. This carries with it an exemption of those agencies and instruments from the taxing power of the federal government. * * * Their operation may be impeded and may be destroyed if any interference is permitted.”

In *Veazie Bank vs. Fenno*, 8th Wallace, page 547, the court said:

“It may be admitted that the reserved rights of the states, such as the right to pass laws to give effect to laws through executive action, to administer justice through the courts, and to employ all necessary agencies for legitimate purposes of state government, are not proper subjects of the taxing power of congress.”

In the *Collector vs. Day*, 11th Wallace, page 113, it was held that congress could not impose a tax upon the salary of a judicial officer of a state, and the supreme court in that case said:

“The means and instrumentalities employed for carrying on the operations of their government (referring to the state government), for preserving their existence and fulfilling the high and responsible duties assigned to them in the Constitution, should be left free and unimpaired; should not be liable to be crippled, much less defeated by the taxing power of another government, which power acknowledges no limit, but the will of the legislative body imposing the tax. And more especially those means and instrumentalities which are the creation of their sovereign and reserved rights, one of which is the establishment of the judicial department and the appointment of officers to administer their laws.”

In *State ex rel. Lakey, Appellant, vs. Garton*, Second American Reports, page 315, it was held that congress had no power to levy a stamp tax upon the official bond of a sheriff.

Such a requirement would also be beyond the power of congress, for the reason that a notary public acts judicially in taking acknowledgments and certifying to the same, and congress has no power to levy a stamp tax upon judicial acts performed in pursuance of the laws of one of the states.

That a notary public acts judicially in taking and certifying an acknowledgment to a deed or other instrument affecting real estate, the attention of the court is respectfully invited to the following cases:

Wedel vs. Herman, 59 Cal. 514.

Griffith vs. Ventress, 24 Am. St. Rep. 918.

Grider vs. American Freehold Land Mortgage Co.,
99 Ala. 281.

American Freehold Land Mortgage Co. vs. James,
16 So. Rep. 887.

Thompson vs. New England Mortgage Security Co.,
18 So. Rep. 315.

Wilson vs. Traer, 20 Ia. 231.

Stevens vs. Hampton, 46 Mo. 404.

Paul vs. Carpenter, 70 N. Car. 502.

Piland vs. Taylor, 113 N. Car. 1.

Lam vs. Crews, 113 N. Car. 256.

Jamison vs. Jamison, 31 Am. Dec. 536.

Withers vs. Baird, 32 Am. Dec. 754.

Louden vs. Blythe, 55 Am. Dec. 527.

Singer Mfg. Co. vs. Rook, 24 Am. Rep. 204.

Cover vs. Manaway, 115 Pa. St. 338.

Shields vs. Netherland, 5 Lea. 193.

Harkins vs. Forsyth, 11 Leigh, 307.

Bowden vs. Parish, 86 Va. 67.

Taverner vs. Barrett, 21 W. Va. 658.

Henderson vs. Smith, 53 Am. Rep. 139.

Harris vs. Burton, 4 Harr. 66.

Johnson vs. Wallace, 53 Miss. 331, 24 Am. Rep.
699.

Morris vs. Wadsworth, 17 Wend. 103.

Romanes vs. Frazer, 17 Grant's Ch. 267 (Canada).

Hetter vs. Glasgow, 21 Am. Rep. 46.

Heilman vs. Kroh, 155 Pa. St. 1.

White vs. Conley, 105 N. Car. 65.

In *Wedell vs. Herman*, 59 Cal. 514, the court said:

“In taking the acknowledgment, the officer acts judicially and if he blunders in certifying to an acknowledgment duly made, or makes a defective or false certificate, he cannot alter or amend it, because after taking the acknowledgment

and delivering the return, his functions cease, and he is discharged from all further authority.”

In *Mason vs. Connor*, 54 Miss. 531, the court said:

“It is evident that the taking of an acknowledgment of a grantor is a *quasi-judicial* act. The officer who takes an acknowledgment acts in a judicial character in determining whether the person representing himself to be or represented by some one else to be the grantor named in the conveyance, actually is the grantor. He determines further whether the person thus adjudged to be the grantor, does actually and truly acknowledge before him that he executed the instrument.”

That congress has no power to impose a tax upon judicial acts of state officers or the processes of the courts, the attention of the court is respectfully invited to the following cases:

Greig vs. Dimock, 9 Int. Rev. Rec. 129.

Warren vs. Paul, 22 Ind. 276.

Fifield vs. Close, 15 Mich. 505.

Jones vs. Keep, 19 Wis. 369.

Lewis vs. Randall, 30 How. Pr. 378.

Walton vs. Bryenth, 24 How. Pr. 357.

Mussleman vs. Mank, 18 Ia. 239.

Botkins vs. Spurgeon, 20 Ia. 598.

Ford vs. Clinton, 25 Ia. 157.

Harper vs. Clark, 17 Ohio, 190.

Said provision would also be unconstitutional for the reason that it diminishes the income of an official appointed by the state to execute and carry out the laws of the state, and subjects him to a penalty for a failure to comply with the requirements of a United States law, which requirement is an additional burden to that imposed upon him by the laws of the state.

Under the laws of the state of Montana, a notary is compen-

sated by the fees which he receives for his services in taking an acknowledgment which are fixed at a certain sum.

It seems clear under the war revenue act, that if the notary's certificate of acknowledgment must be stamped, he is required to stamp the same, and if he should fail to do so, he would be subject to the penalties provided in said revenue act. Section 7 of said act provides as follows:

“That if any person or persons shall make, sign or issue, or cause to be made, signed or issued any instrument, document, or paper of any kind or description whatsoever without the same being duly stamped for denoting the tax hereby imposed thereon, or without having thereupon an adhesive stamp to denote said tax, such person or persons shall be guilty of a misdemeanor, and upon conviction thereof, shall pay a fine, etc., etc.”

Section 9 provides as follows:

“That in any and all cases where an adhesive stamp shall be used for denoting any tax imposed by this act, except as hereinafter provided, the person using or affixing same shall write or stamp thereupon the initials of his name and the date upon which the same shall be attached or used, so that the same may not again be used.”

The notary public being the person who takes the acknowledgment and the only person who signs and executes the proof thereof, in order to avoid the penalty provided for by statute would necessarily be compelled to see that the same was stamped, thus reducing his income and imposing new burdens upon him. That this cannot be done, see

Collector vs. Day, 11 Wall. p. 113.

Although it should be held that the proof of acknowledgment by the notary of a homestead declaration requires a ten cent stamp, it does not necessarily follow that because this is true

that the failure to affix said stamp to said proof of acknowledgment would exclude the homestead declaration from evidence, or prevent it from being recorded in the office of the county recorder. The provision of the internal revenue law excluding instruments from record and from being used in evidence, is highly penal in its nature and must be strictly construed. No words can be read into the statute and if any doubt exists from the language of the statute, such doubt must be resolved in favor of the parties seeking to introduce the instrument.

Section 14 of the War Revenue Act is invoked by the plaintiff in error to prevent the introduction of a homestead declaration in evidence. Such portion of said section as is material, reads as follows:

“That hereafter no instrument, paper or document required by law to be stamped, which has been signed or issued without being duly stamped or with a deficient stamp, nor any copy thereof shall be recorded or admitted or used as evidence in any court until a legal stamp or stamps denoting the amount of tax, shall have been affixed thereto, as prescribed by law.”

Clearly the words, “instrument, paper or document” refer to the principal thing, that is, the thing which is to be used in evidence. In this particular case, the principal thing is the homestead declaration. The proof of acknowledgment or certificate of acknowledgment is not the instrument, nor the paper, nor the document which was sought to be introduced in evidence. It was simply an incident to the principal thing. The proof of acknowledgment cannot by any proper construction of this statute be denominated an instrument or a paper or a document required by law to be stamped, and it was clearly the intention of this section of the statute to only prevent the introduction in evidence and the recording of such instruments,

papers or documents as are required, independent of the certificate of acknowledgment, to be stamped.

Congress evidently had in view the well established rule of law that where a party has done all he is required to do, he shall not be required to suffer for the neglect or failure of a public official to perform the duties imposed upon him by law, and it was not the intention of congress that if a notary public or a judge of the court should take an acknowledgment and certify to the same and fail to annex the ten cent stamp to the acknowledgment, that that should deprive the party of any of the legal benefits to be obtained from the instrument which he may have prepared and executed in proper form and acknowledged according to the laws of the state.

When the defendants in error had prepared their homestead declaration and executed the same, gone before a notary public and acknowledged it in the form provided by the laws of the state, and filed it for record in the office of the county clerk and recorder, their homestead right had been secured, and although the county clerk and recorder might have failed entirely to record the instrument, this being a duty imposed upon him by law, this failure to record could not be imputed to the defendants in error, nor their homestead right impaired thereby. It is equally true that after they had prepared their declaration and acknowledged the same as provided by law and filed it for record, the neglect or failure of the notary public to affix the stamp, cannot be imputed to them nor their rights impaired thereby; neither did congress intend that this particular penalty should attach for such neglect of a person over whom defendants in error had no control, and therefore congress advisedly used the words, "instrument, paper or document, required by law to be stamped," referring undoubtedly to the principal thing, the thing which is required to be recorded and

necessary to be used in evidence, and not to the certificate of acknowledgment, which is neither an instrument, paper nor document in the sense in which these terms are used in the statute.

It is also insisted by plaintiff in error that because said acknowledgment did not bear the stamp, the declaration was not entitled to be recorded in the county clerk and recorder's office of the county of Deer Lodge.

The provision of Section 14 of the War Revenue Act, *supra*, clearly does not apply to instruments required to be recorded under the state laws, but applies only to such instruments as are required by federal legislation to be recorded and to officers under federal control.

In *Moore vs. Quirk*, 105 Mass. 49, 7th Am. Rep. 499, it was held under the revenue law of 1866, that a similar provision had no application to instruments required to be recorded by the state law in the state recording offices; the court said:

“The mortgage was recorded as required by the statutes of the commonwealth. The clause of the internal revenue act, which provides that instruments not stamped as therein required shall not be recorded, cannot be construed as prohibiting the performance by the officers of the commonwealth of the duties imposed upon them by its statute but must be limited in interpretation and effect to records required or authorized by acts of congress, for the same reasons upon which the prohibition in the same clause against giving unstamped instruments in evidence in any court, has been decided to be applicable to the federal courts only and not to extend to the state courts.”

In *Stewart vs. Hopkins*, 30 Ohio St. page 524, the supreme court, referring to Section 163 of the act of 1866, and construing the same, said:

“Section 163 declares that no instrument required by law to be stamped, which is not sufficiently stamped, shall be recorded or admitted or used as evidence in any court, until stamped as required by law. Without denying that it is within the power of taxation conferred upon courts to levy taxes and collect them by means of stamps placed on written instruments and to enforce the observance of the law by the imposition of penalties, yet the power of congress to prescribe as a penalty that which invaded the rules of evidence in the state courts, has been denied by the highest courts of many of the states, and in others so gravely doubted that at the present time it may be regarded as settled by the decided weight of authority that, whether the disputed power exists or not, since the act does not in express terms apply to the courts of the several states, and the provision excluding unstamped instruments from being given in evidence, can have full application and effect by confining it to the federal courts, its application must be regarded as limited to the courts over which congress has legislative control.

“Carpenter vs. Snelling, 97 Mass. 452.

“Greene vs. Holloway, 101 Mass. 243.

“People vs. Gates, 43 N. Y. 40.

“Clements vs. Conrad, 19 Mich. 170.

“Craig vs. Dimock, 47 Ill. 308.

“Bunker vs. Greene, 48 Ill. 243.

“Wallace vs. Cravens, 34 Ind. 534.

“Griffin vs. Ranney, 35 Conn. 239.

“Duffy vs. Hobson, 40 Cal. 240.

“Bumpass vs. Taggart, 29 Ark. 398.

“Davis vs. Richardson, 45 Miss. 499.

“Dailey vs. Croker, 33 Tex. 815.

“The same sections of the act, which prohibit unstamped instruments and documents from being used in evidence, forbid the recording of such instruments. For the same reason, therefore, that the clauses prescribing a rule of evidence must be regarded as applicable to the federal courts only, those relating to the recording of instruments not stamped as required by law, must be held to apply to such instruments as are required to be recorded by federal legislation and to officers under federal control.”

Moore vs. Moore, 47 N. Y. 467.

The same has been ruled under Section 14 of the War Revenue Act of 1898 in the case of People ex rel. Consumers' Brew. Co. vs. Fronne, 35 App. Div. 459, 54 N. Y. Supp. 833.

Loring vs. Chase, 50 N. Y. Supp. 312.

Gregory vs. Hitchcock Pub. Co., 63 N. Y. Supp. 975.

Cassidy vs. St. Germain, 46 Atl. 35.

In addition to the foregoing authorities, see the following:

Bennett vs. Morris, 37 Pac. 929.

Lathan vs. Smith, 45 Ill. 29.

Knox vs. Rossi, *Lra. Book* 48, page 305.

U. S. Express Co. vs. Haines, 48 Ill. 248.

Wilson vs. McKenna, 52 Ill. 43.

Hunter vs. Cobb, 1 Bush. 239.

Pargoud vs. Richardson, 30 La. Ann. 1286.

Davis vs. Richardson, 45 Miss. 499, 7 Am. Rep. 732.

Moore vs. Climer, 12 Mo. App. 11.

Schultz vs. Herndon, 32 Tex. 390.

From these cases and numerous others which might be cited, it appears that the great weight of authority is that the inhibition against the introduction of unstamped instruments as evi-

dence, does not apply to state courts, and for the same reason and upon the same principle the inhibition against the recording of unstamped instruments is not applicable to the record of such instruments in the recording offices of the several states, as is very clearly pointed out in the Massachusetts and Ohio cases, from which we have heretofore quoted at length.

By the act of March 2, 1901, amending the war revenue act, the provision of schedule "A" in reference to the stamping of certificates under which it is claimed this certificate of acknowledgment should be stamped, was repealed. It is true that Section 14, which provides that unstamped instruments shall not be recorded or received in evidence, was not repealed, but was continued in force, so far as applicable. This section could not have any effect or be applicable to a repealed portion of Schedule "A." It was continued in force and remained applicable to such portions of Schedule "A" as was left in full force and effect and not repealed. Had the entire Schedule "A" been repealed, then Section 14 would not have been continued in force, for there would have been no subjects to which it could have applied. And so far as that part of Schedule "A" applicable to this controversy is concerned, Section 14 was no longer applicable because that part of Schedule "A" had been repealed.

We respectfully submit that there is no rule of law better settled or more uniformly maintained than that when the law imposing a penalty is repealed, the penalty cannot longer be exacted. Therefore, when the law requiring certificates of acknowledgment to be stamped, if any such law ever existed, was repealed, which was long prior to the trial of this suit, the penalty for a failure to stamp such certificates could not longer be imposed, and when said homestead declaration was offered in evidence, it was properly received by the court.

In *Yeaton vs. The United States*, 5th Cranch, 281, the court, by Marshall, Chief Justice, said:

“The court is therefore of opinion that this cause is to be considered as if no sentence had been pronounced, it has long been settled on general principles that after the expiration or repeal of a law, no penalty can be enforced, nor punishment inflicted, for violations of the law committed while it was in force, unless some special provision be made for that purpose by statute.”

The case of the *United States vs. The Ship Helen*, 6th Cranch, 203, was a case where the ship *Helen*, a vessel of the United States during the existence of the act of congress of the 28th of February, 1806, to suspend the commercial intercourse between the United States and certain ports of the island of St. Domingo, had traded with one of the prohibited ports contrary to that act. The act was suffered to expire on the 25th of April, 1808. Afterwards, to-wit, on the 20th of September, 1808, she was seized on account of that violation of the act by the collector of the port of New Orleans, but the libel was dismissed by the judge, on the ground that the law had expired. The United States appealed, but the Supreme Court of the United States affirmed the judgment.

In the case of the *Schooner Rachael vs. The United States*, 6th Cranch, 330, it was held

“that no sentence of condemnation can be affirmed, after the law under which the forfeiture occurred has expired, although a condemnation and sale had taken place and the money had been paid over to the United States, before the expiration of the law, and this court in reversing the sentence will not order the money to be repaid, but will award restitution of the property, as if no sale had been made.”

But it is useless to multiply authorities upon this point. It

has long since ceased to be a controverted one, and for this reason, if none other, the court did not err in admitting the declaration of homestead in evidence.

This rule as hereinbefore stated is particularly applicable to the penalties imposed by the war revenue act, and is consonant with sound public policy. Should any other rule be adhered to, or should the rule be announced as contended for by plaintiff in error, the titles to property would be indefinitely unsettled and these questions arising in the courts for many years. It would seem impossible in view of this well recognized principle of law to hold that when the law imposing the tax had been itself repealed, that the instrument which was the subject of the tax should be forever under the ban of judicial displeasure, as an instrument of evidence, because the tax was not paid.

It is plain that when the law imposing the tax has been repealed, all of the penalties, fines, forfeitures and disabilities assessed or imposed for its violation must necessarily go along with it and cease with it, unless the right to continue and enforce the same has been expressly retained and preserved by means of a proper saving clause contained within the repealed statute.

II.

THE FEDERAL HOMESTEAD QUESTION.

Plaintiff in error contends that the court erred in not admitting in evidence testimony tending to show that Joseph McCaffery, husband of Mary McCaffery, the person who made the homestead declaration, had made a homestead entry under the laws of the United States, to one hundred and sixty acres of government land, and that he afterwards obtained a patent thereto.

In the court below plaintiff in error did not pretend that the laws of the state of Montana were not complied with, or that Joseph McCaffery and Mary McCaffery, his wife, did not actually reside on the property described in their homestead declaration at the time said declaration was filed, but the contention was and is now made that although they actually resided and continued to reside upon said property in the City of Anaconda, that the fact that Joseph McCaffery entered land under the homestead act of the United States laws and obtained a patent thereto fraudulently without ever having resided upon the same, would defeat the homestead claim of Mary McCaffery to the property upon which they actually resided in the City of Anaconda.

The right to have a homestead exempt from execution for the debts of the homestead claimant, is a right arising under the laws of the state of Montana, and it is to them and to them alone that we must look for the requirements necessary to be fulfilled, before said homestead can be legally claimed.

The sections of the statute of the state of Montana which are material, are found in the Civil Code of said state, and are as follows:

Section 1670 provides: The homestead consists of the dwelling house in which the claimant resides and the land on which the same is situated, selected as in this title provided.

Section 1671 provides: If the claimant be married, the homestead may be selected from the property of the husband or with the consent of the wife from her separate property. When the claimant is not married, but is the head of a family within the meaning of Section 1694, the homestead may be selected from any of his or her property.

Section 1673 provides: The homestead is exempt from execution or forced sale, except as in this title provided.

Section 1675 provides: The homestead of a married person cannot be conveyed or incumbered, unless the instrument by which it is conveyed or incumbered is executed and acknowledged by both husband and wife.

Section 1676 provides: A homestead can be abandoned only by declaration of abandonment, or a grant thereof executed and acknowledged:

- 1st. By the husband and wife, if the claimant is married.
- 2d. By the claimant if unmarried.

Section 1700 provides: In order to select a homestead, the husband or other head of the family, or in case the husband has not made such selection, the wife must execute and acknowledge in the same manner as the grant of real property is acknowledged, a declaration of homestead and file the same for record.

Section 1701 provides: The declaration of homestead must contain:

- 1st. A statement showing that the person making it is the head of a family, or when the declaration is made by the wife, showing that her husband has not made such declaration, and that she therefore makes the declaration for their joint benefit.

- 2d. The statement that the person making it is residing on the premises, and claims them as a homestead.

- 3d. A description of the premises.

- 4th. An estimate of their actual cash value.

Section 1702 provides: The declaration must be recorded in the office of the clerk of the county in which the land is situated.

Section 1703 provides: From and after the time the declaration is filed for record, the premises therein described constitute a homestead. Upon the death of a person whose property was selected as a homestead, it shall go to his or her heirs

or devisees, subject to the use of the widow during her life, if the property selected as a homestead, before selection, belongs to the husband and subject to the use of the husband during his life, if the property selected as a homestead before selection belong to the wife, and in no case shall the homestead be held liable for the debts of the owner, except as provided in this title.

Section 1693 provides: Homesteads may be selected and claimed:

1st. Consisting of any quantity of land, not exceeding one hundred and sixty (160) acres, used for agricultural purposes, and the dwelling house thereon, and its appurtenances, and not included in any town plot, city or village.

2d. A quantity of land not exceeding in amount one-fourth of an acre, being within a town plot, city or village, and the dwelling house thereon and its appurtenances, such homestead in either case shall not exceed in value the sum of two thousand five hundred dollars (\$2,500.00).

It will be observed from the foregoing sections that something more than mere residence upon the land claimed as a homestead is required. That before homestead can be had under the state laws, a declaration of homestead must be prepared and filed, and that said declaration must contain the statement of numerous essential prerequisites to the claiming of a homestead right in land.

A federal homestead, so called, has none of the essential elements of a homestead under the state law, except the identity of names.

It is true that public lands are subject to a statutory homestead claim, but the selection of the same for a homestead must be made as in other cases.

Watterson vs. E. L. Bonner Co., 19 Mont. 554.

Gaylord vs. Place, 98 Cal. 472.

Plaintiff in error has pointed out the difference in the provisions of the homestead laws of the various states, and claims that there is as much difference in these provisions as there is in the provisions between a federal homestead and a homestead provided for under our statute.

The principal object of all statutory homesteads under the state law, is to preserve a home for the family, in case of adversity, for the widow and children, in case of the death of the husband, for the husband and children, in case of the death of the wife.

This object is not effected or this end attained by obtaining land under the provisions of the public land laws of the United States. The only exemption whatever which is given under those laws, is an exemption for debts contracted while the title to the land remained in the government of the United States. Such land, upon the issuance of patent therefor, immediately becomes subject to the payment of all debts thereafter incurred, and may be conveyed by the husband without the consent of the wife. They have none of the essential characteristics of the homestead provided for under the state law.

Section 1700, *supra*, gives to the wife the right to select the homestead, in case the husband has not made such selection.

By the words, "such selection," is meant the selection by filing a declaration duly executed and acknowledged, as provided for in said section. All the provisions of the state statute refer to and are applicable only to the statutory homestead provided for therein. This right is conferred absolutely upon the wife, and cannot be divested by the husband, or in any other manner, unless the husband has made or makes a selection of a homestead, in accordance with the laws of the state. This is not the case of the family or some member thereof having made and retained a valid homestead selection under the laws

of another state. The entry upon the public lands made by Joseph McCaffery was made under the federal law within the State of Montana, and if the entry of public lands under the federal homestead law would not be equivalent to the selection of a homestead under our statute, then it cannot be contended that the defendant Joseph McCaffery had ever made the selection of a homestead in the sense or in the manner provided for by the state law, or such a selection as would prevent the wife from availing herself of the provisions of Sections 1700 and 1701 of the Civil Code, *supra*.

In the case of *Thomas vs. Malhan*, 92 Cal. 1, the court on page 7 said:

“The obvious purpose of the statute in providing for the selection of a homestead was to thereby make a home for the family, which neither of the spouses could encumber or dispose of without the consent of the other, and which should at all times be protected against creditors.”

When we bear in mind the fundamental object of the law, it is impossible to maintain with any show of reason the proposition that the rights acquired by the homestead entry under the laws of the United States are equivalent to the rights acquired under the statutory homestead law.

See *American and English Ency. of Law*, Vol. 15, page 526.

After a person has made a homestead entry upon the public lands the paramount title to the lands still remains in the government, and when said person has represented to the government that he has complied with the law and the patent is issued thereto, the land can be taken under attachment or execution for a debt incurred, immediately thereafter, and can be sold or encumbered immediately thereafter without the consent of the wife. This would indeed be a strange sort of a homestead

in the sense in which a homestead is reserved by the statute of the state of Montana, which statute provides that the homestead shall be exempt for all time from execution or attachment for the debts of the homestead claimant.

The statutory homestead in the state of Montana can be abandoned only by the filing of a declaration of abandonment or by a grant executed in the manner prescribed by law. The homestead acquired by the homestead entry upon the public lands is abandoned, so far as any exemption is concerned, as against debts thereafter incurred immediately upon the issuance of a patent therefor, and the issuance of a patent destroys any protection which the family of the homestead claimant may have theretofore had, for the husband can sell it or otherwise dispose of it without the consent of his wife, and leave the family unprotected. Furthermore, prior to the time of the issuance of the patent, the inchoate title and such rights as the homestead claimant may have in the land, are under the control and subject to the action of the interior department of the United States government.

The United States law forbids the sale of the homestead for debts incurred before patent has issued, in pursuance of the policy announced in the statute, which prohibits the sale, assignment or incumbering of the land entered as a homestead, prior to the issuance of patent.

If the government issued the patent, and immediately allowed the land to be attached for a debt incurred prior to the time of the issuance of the patent, there would be no sound reason why the government should not allow the land included within the homestead entry to be levied upon prior to the issuance of the patent, and if such were the case, the interior department of the government would be embarrassed in the administration of the laws by conflicting claimants to the land

embraced within the homestead entry. The rights acquired by a person under the United States laws by homestead entry (and it may be said that the family virtually acquired no right in the sense of a homestead exemption), are not equivalent or even analogous in any way to the rights acquired by a person and his family in making a homestead selection under the laws of the state.

If the contention of plaintiff in error is correct, that acquiring title, although fraudulently, to a tract of land under the homestead laws of the United States, is sufficient to prevent him from obtaining a homestead under the laws of the state of Montana, then the converse of the proposition must be equally true, namely, that if a person has acquired a homestead under the laws of the state of Montana by residence and by filing the declaration required thereunder, although he remove therefrom, if he does not abandon the same, which he can not do except by a declaration of abandonment or grant duly acknowledged, he cannot make entry and obtain a patent to one hundred and sixty acres of land, under the homestead laws from the government of the United States; we do not believe that counsel for plaintiff in error, with all their ingenuity, would undertake to maintain this position before this court, yet one is equally tenable with the other.

Counsel have cited many cases which they claim bear out their contention. They are too numerous to separately examine in this brief. Suffice it to say that an examination of said cases by the court will show that they have no application whatever to the question here to be considered. The only case even remotely bearing upon the proposition is the case of Hesnard vs. Plunkett, 60 N. W. Reporter, 159, and the most casual examination of that case will show that it has no application whatever to the facts of this case.

In that case the homestead claimant was actually living within the boundaries of the one hundred and sixty acres which had been taken up under the homestead laws of the United States. He had removed from the one hundred and sixty acres upon which he had formerly lived, and which he had claimed as a homestead under the laws of the state of South Dakota.

In the case at bar there is no pretense that Joseph McCaffery ever lived upon his pretended homestead claim, or ever removed from the lot in the city of Anaconda claimed as his home.

The laws of the state of South Dakota required that the homestead claimant should reside upon the land claimed to be exempt.

The homestead claimant in this case attempted to carve one hundred and forty-one acres from his pre-emption claim, to which he had received a patent, and upon which he had formerly lived, and attach it to nineteen acres of his government homestead claim upon which he was then actually residing, and claim the whole as exempt under the statutes of the state of South Dakota. In deciding the case, the court uses the following language:

“At the time, then, that this one hundred and forty-one acres were sold by the respondents upon their judgment, appellant was living upon his government homestead upon which his entry was made for the purposes of actual settlement and cultivation. When appellant removed from his pre-emption claim and settled upon the government homestead, he in effect abandoned his homestead exemption right under the state law. He was in contemplation of law settled upon and occupying his whole quarter section of one hundred and sixty acres claimed by him as his government homestead. To hold, therefore, that appellant was settled upon and occupying his government homestead for

the purposes of acquiring title thereto, and yet that he was only occupying nineteen acres thereof, and one hundred and forty-one acres of his pre-emption claim, when claiming his said homestead exemption would involve an inconsistency, for if he lived upon and occupied his government homestead for one purpose, he must be held to be doing so for all purposes. The two quarter sections, though contiguous, were separate and distinct tracts of land. Section 2455, Com. Laws, provides that the homestead 'may contain one or more lots or tracts of land with the buildings thereon, * * * but must in no case embrace different lots and tracts, unless they are contiguous, or unless they are habitually and in good faith used as part of the same homestead.' It appears from the allegations in the complaint that the appellant claimed a specific tract of land, as his government homestead, embracing one hundred and sixty acres. He has no independent claim to nineteen acres thereof. His settlement or occupancy was either valid as to the whole quarter section, or was not valid to any part thereof. * * * But when he has settled upon and is occupying one hundred and sixty acres for the purpose of acquiring title thereto from the government, he cannot at the same time for another purpose claim that he is only occupying a small portion of the same."

The only effect of the testimony offered by plaintiff in error would have been to have shown that Joseph McCaffery, the husband of the homestead claimant, had fraudulently obtained title to one hundred and sixty acres of the public lands of the United States. This was not the question at issue in the case. The questions at issue were simply whether the defendants in error had complied with the state homestead law and were entitled to hold the land in controversy in the suit under the same.

The testimony showed that both Joseph McCaffery and Mary McCaffery, at the time they filed their declaration of homestead, actually resided upon the land in the city of Anaconda claimed as a homestead. That Joseph McCaffery had not theretofore made a selection of a homestead as provided by and in the form and manner authorized by the statutes of the state of Montana. That Mary McCaffery was his wife, and that she made the declaration for the joint benefit of herself and husband. That the premises claimed did not exceed one-fourth of an acre, and did not exceed the value of two thousand five hundred (\$2,500.00) dollars.

That the declaration of homestead required by Section 1701 had been made and executed in manner and form as provided for in said section, and filed for record in the county clerk and recorder's office of Deer Lodge county, and that all the facts stated therein were true.

Under these circumstances, it was wholly immaterial what other land or property might have been owned by Joseph McCaffery or how he may have obtained the title thereto, whether fraudulently or otherwise, unless the plaintiff in error could have shown, as the court required her to do, that at the time said declaration of homestead was made and filed for record, Joseph McCaffery, the husband of Mary McCaffery, was not residing upon the premises claimed as a homestead, and even then we do not believe this fact, if established, would have defeated the homestead rights of Mary McCaffery and her family, provided Joseph McCaffery had not made a selection and filed a declaration of homestead under the laws of the state of Montana.

The court will observe that Section 1700, *supra*, provides that the wife may make the declaration, if the husband has not done so, and Section 1701 provides that the homestead decla-

ration shall contain a statement that the *person* making it, which in this case was Mary McCaffery, the wife of Joseph McCaffery, is residing on the premises, and claims them as a homestead; evidently this section grants the right to the wife, if she be residing on the premises, to claim them as a homestead for herself and family, even though the husband might have theretofore abandoned his family and have been residing elsewhere.

It has been so expressly ruled in *Watterson vs. Bonner Co.*, 19th Mont. 554, in which case, on page 557, the court said:

“The authorities are so numerous to the effect that the abandoned wife may claim the homestead exemption, that we do not think it necessary to discuss the question here.”

See *Frazer vs. Syas*, 4 N. W. 934.

Collier vs. Latimer, 35 Am. Rep. 711.

Kennley vs. Hudelson, 39 Am. Rep. 31.

It was likewise so ruled in *Gambette vs. Brock*, 41 Cal. page 79, in which case, on page 84, the court said:

“But in the absence of any showing as to the causes of the absence of the husband from the homestead selected by his wife or any proof that he had a home or fixed residence elsewhere, or any other family than his wife, it appears to me to be entirely consistent with the spirit of the homestead act, that the wife, having a family of her own, should be allowed to select and establish a homestead by her own residence upon it with her family.”

Plaintiff in error cites the case of *Power vs. Burg*, 18 Mont., as authority that the testimony should have been admitted for the purpose of showing the good or bad faith of the homestead claimants. He does not insist upon this proposition, and evidently understands full well that the case is not applicable. The case of *Power vs. Burg* arose under a different statute from the one which we are now considering. A statute which

did not require the filing of a declaration of homestead, and made the right to claim a homestead dependent at all times upon use and occupancy. The question in the case was whether Burg could claim a tract of land as a homestead upon which he had never made any kind of improvements, and which was never occupied by him or his family for any purpose whatever, by simply claiming that he intended to improve the same and occupy the same for a home. Upon the question of his good faith in making the claim that he intended to occupy the same as a home, the court permitted the introduction of a homestead entry made upon the public lands of the United States by Burg. Had the testimony shown that Burg was actually occupying and living upon the land claimed as a homestead, there would have been no question of good faith in the case, and the court would not have admitted the testimony.

In the case at bar the question of good faith did not arise, the only question being whether the defendants in error complied with the law of the state of Montana, in selecting the homestead, which they claimed. If they did so comply with the law, their intentions for the future were wholly immaterial.

III.

THE TWO-HOUSE QUESTION.

Plaintiff in error contends that the defendants in error should have been allowed to hold but one of the houses which were situated upon the lot claimed by them as a homestead, and the assignments of error by which it is sought to raise this question are the exceptions taken to the refusal of the court to give certain offered instructions, which instructions are found on pages 38 and 39 of the transcript, which told the jury in effect that the character of the property, whether a homestead or not,

should be determined by the principal use to which it was placed.

The testimony shows without contradiction that the lot claimed as exempt was less than one-fourth of an acre in area; that upon the front part of said lot, facing the west, had been built what is termed in the testimony as two houses, but what we think the testimony shows in effect to be one house only.

The house which the McCaffery's used entirely was built before the other house, but the houses were joined together by a porch which was covered and passed from the original house to the new. The front yard of both houses was a common yard with no division fence, nor was there any division fence run between the two houses.

At the back of the houses there was a temporary fence built from the back end of what is termed in the testimony the "tenement house," which fence separated the back end of the lots to some extent. (See testimony, Pinegar, transcript, pages 34 and 35, and map, page 36.)

There is testimony showing that the house called the "tenement house" was rented off, and on both before and after the filing of the declaration of homestead, but there is no testimony in the record showing that any portion of the front yard or any definite portion of the back yard was ever exclusively occupied or leased to tenants.

If the court should take the view of the law suggested by the plaintiff in error, the material inquiry would be, what use the house called the "tenement house" and the land which has been arbitrarily allotted to it by the plaintiff in error was put to at the date of the filing for record of the declaration of homestead.

The only testimony upon this point, and it is absolutely uncontradicted, is the testimony of Lizzie McCaffery, who testified that at the date of the execution of, and filing for record of the declaration of homestead, the four rooms in the

brick portion of the southerly house were rented to one Moohr and his wife. Mary McCaffery and her husband were alternately occupying one of the rooms of said southerly or tenement house as a sleeping room.

Said witness also testified that for four or five years prior to said date said southerly building had been rented to tenants in a similar manner; that the fence built from the northeast corner of the southerly house was built of drygoods boxes and strips; was about three feet high, and was built to keep the McCaffery chickens out of the southerly yard because they were bothersome to the occupants of the southerly house; and also for the purpose of keeping the chickens out of the garden on the south side, which was kept by the occupants and the McCafferys jointly.

That the lot covered by McCafferys' homestead declaration contained less than one-fourth of an acre, which fact was uncontradicted. (See transcript, page 37.)

Mary McCaffery was the only witness who testified as to the occupancy of said southerly house at the date of filing of the declaration of homestead, and her testimony is uncontradicted, and must be taken as true. All other testimony in reference to its occupancy prior to the filing of this declaration, and its occupancy subsequent to the filing, is wholly immaterial.

In *Skinner vs. Hall*, 69th Cal. page 198, the court said:

“Conceding, as claimed by the appellants, that he went back to the house for the purpose of qualifying himself to file a new declaration, still it does not follow that his residence was not actual. He had taken up his abode in the house and had slept there one night. His wife and child did not go there with him, but it was not absolutely necessary that they should. One may have an actual residence in a house though his family be away and he take his

meals elsewhere. Nor is the fact that he slept there but one night decisive of the question.

“After making an actual residence upon property one may file and maintain a homestead upon it at the end of a day as well as at the end of a month or a year. So one may file and maintain a homestead upon property which is partially rented out or used for other purposes than his residence.”

We maintain that under the law of the State of Montana the entire lot upon which the claimant's residence is located is exempt, provided it does not exceed one-fourth of an acre in area or the value of \$2,500.00.

The sections of the Montana statute defining homesteads are as follows:

Section 1670, Code of Civil Procedure: The homestead consists of the dwelling house in which the claimant resides and the land on which the same is situated, selected as in this title provided.

Section 1693, Code of Civil Procedure: Homesteads may be selected and claimed: (1) Consisting of any quantity of land not exceeding one hundred and sixty acres used for agricultural purposes, and the dwelling house thereon and its appurtenances, and not included in any town plot, city or village; or (2) A quantity of land not exceeding in amount one-fourth of an acre being within a town plot, city or village, and the dwelling house thereon and its appurtenances. Such homestead in either case shall not exceed in value the sum of \$2,500.00.

Section 1670, *supra*, is identical with Section 1237, Civil Code of California.

Section 1693, *supra*, is not found in the code of California, nor has it ever been incorporated in the laws of that state so far as we are able to determine, but the section which corresponds to it is Section 1260, Civil Code of California, which

reads as follows: Homesteads may be selected and claimed, first, of not to exceed \$5,000.00 in value, by any head of a family; second, of not to exceed \$1,000.00 in value by any other person.

Section 1693, *supra*, of the Code of Montana, not having been borrowed from California, has never been construed by the courts of that state, and the decisions on the homestead law of that state are not controlling, under this section of the homestead law, in the State of Montana.

If Section 1670, *supra*, stood alone, the question now presented to the court would be one of much difficulty. The decisions under similar statutes are very conflicting, but the introduction into the laws of Montana of Section 1693, *supra*, has greatly simplified the decision of this case and the construction put upon this section by the Supreme Court of the State of Montana, which construction is controlling in the United States Court, has obviated any difficulty which might have been encountered in its determination.

The case of Yerrick vs. Higgins, 22d Montana, page 502, is a case where the homestead claimant had included in his declaration of homestead two lots, the total area of which exceeded by 2,100 square feet one-fourth of an acre. The excess in area could have been taken off the east side of lot 5 without disturbing the dwelling by cutting off a strip lengthwise of his lot 16.2 feet in width.

The question presented to the supreme court was whether this excess in the declaration of homestead rendered void said declaration and subjected the whole of the property to execution.

The supreme court, in discussing these two sections of the Code, said:

“The former of these provisions defines a homestead in general terms. The latter limits this general definition and *specifies particularly the subject-matter to which the selec-*

tion and claim may apply. Standing alone, the general definition would leave no limit to the amount or value of the property selected and claimed provided claimant resided in his dwelling upon it. Under this latter provision, then, if the property under which the homestead is to be selected is outside a town plot, city or village, the homestead may not exceed 160 acres in area nor \$2,500.00 in value. If it is included in a town plot, city or village, the homestead may not exceed one-fourth of an acre with the same limitations to value. This language is clear and explicit.

“The declaration must, therefore, be in conformity with both these limitations unless by some other provision or by just implication from all provisions on the subject there be some way by which the failure to conform can be excused.”

The court, after discussing the provisions stated, applicable to cases where the creditor is dissatisfied with the estimated value placed upon the homestead by the claimant and the way in which he may have the value judiciously ascertained and declared, proceeds to say :

“The policy of the area limit, however, is based upon a different principle. *The code contains no provision by which, after the homestead has once been selected, there can be a readjustment of the area and the surplus taken by the creditor.*

“If the selection is in compliance with the law, within the value limit, and remains there, the claimant is beyond the pursuit of his creditors and so far as they are concerned he may forever after retain the specific property selected except when the judgment has been obtained before the declaration is filed and when the judgment is actually made a lien upon the homestead. From and after

the declaration is filed for record the premises therein described constitute a homestead and in no case shall the homestead be held liable for the debts of the owner except as provided in this title. * * *

“The question, then, as to what is a compliance with the law in respect of the area to be claimed must necessarily be answered in the statement that the premises described in the declaration must fall within the statutory limit, otherwise, the declaration is ineffective to exempt the property claimed. We are confirmed in this conclusion when we remember that area is a matter of accurate measurement and easily ascertainable. It is not a matter about which men may differ. The claimant has it within his power to state it as a fact, and the policy of the statute is that he shall do so. If he can describe in his declaration premises containing greater area than the statute allows and still be held to have complied with the law, then he can by his own disregard of the actual fact and because *there is an absence of specific provisions of law* by which his creditors can contest his claim, secure a greater exemption than the law provides for him. The statute requires the claimant to describe the premises he claims, not the premises within which his homestead is included, or out of which it may be carved. And this requirement is neither harsh nor unjust. It simply demands of the claimant that he be honest and state the truth. The statute points out the way by which he may secure his exemption. He has but to follow and he is secure. If from his own carelessness or from fraudulent motives he fails to observe the law, he must suffer the penalty.”

No language can be plainer than this. It conclusively establishes the fact that the homestead claimant in a city or town is entitled to one-quarter of an acre without any restriction as

to its use, provided only that his residence is located thereon and the entire value of the lot and improvements does not exceed \$2,500.00.

In *Clark vs. Shannon*, 1st Nev. 568, a homestead was claimed by Shannon upon two adjoining lots, upon one of which he resided with his wife, and on the other lot he had a livery stable. Each lot was 50 feet by 100 feet, the two together making a square of 100 feet. One Clark attempted to foreclose a mortgage on the lot upon which the livery stable was situated, which mortgage was executed by Shannon without the concurrence of his wife, and Shannon resisted the decree for foreclosure on the ground that when he executed the mortgage the stable lot constituted a part of the homestead property, and was not bound by mortgage in which the wife did not join.

The court, by Beattie, J., says:

“The only question raised in the court below was whether, under the circumstances of this case, the stable lot did constitute a part of the homestead property. The court below held that the homestead was confined to the lot on which the dwelling was situated, and did not include a separate lot which was devoted to business purposes.”

The court, in reversing the judgment by Beattie, J., says:

“We think there is no more force in the other objection that a distinct portion of the property was devoted to business purposes. The only limitation of the right to select the homestead lands is that they shall not exceed five thousand (\$5,000.00) dollars in value. We do not think it was the policy of the law to preserve only a residence for the family of the insolvent debtor, but to secure also the means of making a living. To give an insolvent debtor a fine house to live in, without any means to support his family, would be an injury to his creditors, without a corresponding benefit to the debtor. But to protect him in

the enjoyment of a cheap and modest house for his family, together with such adjacent lands or business houses as will enable him to decently support his family, would be a wise and humane policy. We think such was the intention of the law. If a person is protected in the enjoyment of a homestead consisting of several hundred acres of land, not more, perhaps, than an acre is necessary to a house, garden, yard and all outbuildings necessary to the proper enjoyment of his residence. All the balance is devoted to the business of farming by which he makes his living. Yet it has never been questioned but that farms might be set aside as homesteads. Why then not a shop, a stable, a store house, or a hotel, be set apart with the homestead lands as readily as a farm, if the whole does not exceed in value the sum of five thousand (\$5,000.00) dollars? We can see no reason for the distinction. We think then this property, if so claimed, would be exempt from execution as a part of the homestead. If exempt from execution, is it not equally exempt from the operation of a mortgage, executed without the concurrence of a wife? It was a part of the identical land on which the residence was situated. The whole together was worth less than five thousand (\$5,000.00) dollars. Was not the building and occupancy of the house a dedication of the entire tract as a homestead, or rather did not the establishment of a homestead on that tract of land attach to the entire tract the privilege of exemption from forced sale, so long as the whole tract with its improvements was worth less than five thousand (\$5,000.00) dollars? If so, it appears to us, the husband could not by his own act, without the wife, mortgage a part of the tract, although he left a portion of it unincumbered."

In *Smith vs. Stewart*, 13 Nev. 65, the rule announced in *Clark vs. Shannon*, *supra*, was approved, notwithstanding the change in the statute laws of Nevada in the meantime, and the court, by Leonard, J., on pages 75 and 76, says:

“Shall it be said, then, unless the law compels the confession, that an industrious mechanic who owns a town lot upon which is his cheap dwelling, cannot invest his savings in a shop upon another portion of the lot, and call to his aid steam or water power, if he does not pass the five thousand dollar limit, without losing the law’s protection, not only as to the shop, but even the land upon which it stands? The shop is in fact a part of the home place, and as important a part as the house itself. The land upon which it is built is a part of the house lot, and a dedication of that to homestead uses carries with it the tenements and hereditaments thereon.”

Further on in the opinion the court says:

“The appellant’s construction would strip every ranchman of his land outside of that upon which his dwelling and its appurtenances are situated, because his farming lands are not more ‘necessary or convenient’ for home purposes than are the stores to respondents in this case. The farm lands and barns are surely convenient and necessary; they assist in the support of the family; but they are neither, in the sense of the word ‘homestead,’ as used by counsel for appellant; they are neither, for the purpose of affording a family shelter; but they are both, as we think, when used in the sense intended by the legislature, as interpreted in *Clark vs. Shannon*.”

In *Hubbell et al. vs. Canady*, 58 Ill. 425, Canady claimed a homestead upon a lot 60 by 120 feet. His dwelling house was mostly on the east half of the lot, about four feet of it, and seven feet of the smoke-house were on the west half, as

also the garden, fruit trees and well. There was a storehouse 20 by 45 feet on the west half, which set back six or eight feet from the end, which was in the occupancy of a tenant. The whole lot did not exceed in value one thousand (\$1,000.00) dollars. The plaintiffs in error claimed under an execution sale against the said Canady for that portion of the lot upon which the store in the occupancy of a tenant was situated. Canady filed a bill in equity to protect his rights to the whole of the homestead.

The court in deciding the case, by Sheldon, J., says:

“The points made by the plaintiffs in error are, that the storehouse was not part of the homestead; that Canady is bound by the judgment recovered against his tenant, and a delay in filing the bill shows such laches as will prevent the court from entertaining it.”

“Reinbach vs. Walter, 27 Ill. 393, is cited in support of the position that this storehouse was not part of the homestead. That was a case of two lots not exceeding, together, one thousand dollars in value; the homestead law was not held to apply, but the court said that if it did, they should be inclined to hold that the store and warehouse and the grounds used for the business done in that, did not constitute a part of the homestead. But here is only one lot of ground, sixty by one hundred and twenty feet. The homestead exemption as given by the statute embraces ‘the lot of ground and the buildings thereon occupied as a residence and owned by the debtor, being a householder and having a family, to the value of one thousand dollars.’ The whole lot of ground is covered by the exemption, not some part of it, and the lot included all the buildings upon it. We are not to regard the intention of the legislature as being only to save a mere shelter for the debtor and his family, but that it was the

purpose to give him the full enjoyment of the whole lot of ground, exempted to be used in whatever way he might think best for the occupancy and support of his family, whether in the way of cultivating it or by the erection and use of buildings upon it, either for the carrying on of his own business or for deriving an income in the way of rent. We cannot accede to that narrow construction of the statute, which would take away the storehouse as not being a part of the homestead.”

The above case, decided under a statute very much like the statute of Montana, with reference to the amount of land allowed to be claimed as a homestead, has certainly a great deal of weight upon this question, and we think the reasoning of the case commends itself as being sound and in accordance with the spirit and objects of the homestead laws. The facts in the above case could hardly be more like the facts in the case at bar. There the homestead claimant had rented the storehouse, a distinct portion of the premises. Surely a much stronger case of the segregation of a portion of the homestead premises than can be claimed in the case at bar. But yet the court held that the residence of the homestead claimant on the lot made his title good as to the whole of the homestead claim. The foregoing case was approved and quoted from at length, in the case of *Stevens vs. Hollingsworth et al.*, 74 Ill. 202, in which last mentioned case the court, by Schoffield, J., on page 208, said:

“While evidence has been received to show that two or more subdivisions of real estate constitute a lot, within the meaning of the homestead act, in no instance has the evidence been received to show the lot was less than a subdivision, simply because the debtor used a portion of it for prosecuting his business. It would be difficult to explain, upon any principle of correct reasoning, why the farmer shall have his farm of eighty acres adjoining his

dwelling house on a town lot, and yet the mill of the miller, or the shop of the mechanic, although on the same lot with his dwelling house, shall not be exempt. Or, narrowing the application, why the garden, stables, yards, orchard, etc., shall be exempt, and the shop, mill or business house, although indispensably necessary to earn a support for the family, and located on the same lot of ground with the residence, shall not be exempt. The homestead, however, is not limited to the ground occupied by the residence, but to the lot of ground and the buildings thereon, and each is presumably of the same importance to the debtor.”

In the case of *Bailey vs. Banknight*, 25 S. W. Rep. 56, where the homestead claimant built a house on a lot adjoining his homestead, and occupied it with his family, renting the old house, except one room which his family continued to use as a parlor and bedroom, the lessee also sometimes using it as a parlor; his family took their meals with the lessee in payment for rent, it was held, that both lots upon which were situated both the old and the new house, constituted the debtor's homestead.

In *Hancock vs. Morgan*, 17 Tex. 582, where the homestead claimant had rented a portion of the premises and built a fence separating himself from his tenant, it was held that such acts did not subject a homestead to forced sale.

In *Winland vs. Holcomb*, 3 N. W. Rep. 341, where the judgment debtor owned a three-story brick building, occupying the second story as a residence for himself and family, the first story being occupied by his tenant at will, the third by his tenant under a written lease for five years, and for the further term of five years, if the tenant should so choose, it was held that the entire building was exempt, and the court, by Gilfillan, J., said:

“The defendant could devote the third story of his build-

ing to any use he chose without affecting the exemption ; so that, even if there were no practicable difficulty in separating the third story from the remainder of the property, for the purpose of a levy and sale, it could not through an execution be appropriated to the satisfaction of the judgment ; and what cannot merely because of the exemption be so appropriated through an execution, cannot be so appropriated by any proceeding of a court. Now, the order under consideration is in effect an appropriation of this third story for a term of years until July 1st, 1881, certainly, and for five years longer if the lessee in the lease choose to continue the tenancy to the satisfaction of the judgment ; that story and the right to the use of it, is for that time taken from the defendant. If by an order a court may deprive him of the right to use it for two or seven years, it may for any longer time. The power of a court to so deprive him of its use is not affected by the fact that there is an outstanding lease ; if it were, then it would not be true, as held in *Kelly vs. Baker*, that the owner may devote the part of the property exempted, not actually used as a dwelling, to any use he chooses, without removing the exemption from that part.”

In *Layson vs. Grange*, 29 Pac. Rep. 585, where a debtor owned a house and three lots containing less than one acre within the limits of the city, upon which he resided with his family, and also had a carpenter shop which he afterwards converted into rooms, which he rented to a family, but did not lease any portion of the ground, but simply gave the tenant the right of ingress and egress to and from the premises, and reserved the basement of such building for his own use, as well as the lot upon which the building was situated, it was held that the whole property was a homestead and as such was exempt from forced sale upon execution.

In *Phillips vs. Rooney*, 9 Wis. 70, 76 Am. Dec. 244, under a statute, which reads as follows:

Section 51. "A homestead consisting of any quantity of land not exceeding forty acres, used for agricultural purposes, and the dwelling house thereon, and its appurtenances, to be selected by the owner thereof and not included in any town plat or city or village, or instead thereof, at the option of the owner, a quantity of land not exceeding the amount of one-quarter of an acre, being within a recorded town plat, or city, or village, and a dwelling house thereon, and its appurtenances, owned and occupied by any resident of the state, shall not be subject to forced sale on execution, or any other final process from a court, for any debt or liability contracted after the first day of January, in the year One Thousand Eight Hundred and Forty-nine."

It was held that the benefit of the exemption was not lost by the owner's neglect to use a portion of his dwelling house with his family, or by appropriating the same portion to some other use. In fact, the homestead claimant had leased the basement of the building and the first story, consisting of a room 20 feet front by 150 feet deep, and the same was occupied by tenants under him as a wholesale and retail store. The court, by Cole, Justice, says in its opinion:

"The language of the statute is so clear, precise and unambiguous that there can be but little difficulty in arriving at its real meaning. The counsel for appellant in a very able argument, which he addressed to the court upon this case, asked what was to be understood as a homestead, in an ordinary, familiar and popular sense of the word. I think I can substantially adopt the definition which he gave, and which I think the word must have as used in this statute, that is, a homestead is the land in a

city not exceeding the prescribed amount upon which is the dwelling house, or residence, or habitation, or abode of the owner thereof and of his family. Evidently the statute does not contemplate that this dwelling house, or habitation, or abode thereon shall be constructed in any particular style, or built in any particular prescribed manner. But it is to be in good faith, and truly, the dwelling house, or residence, or abode of the owner and of his family, in order to be exempt."

In *Kiesel vs. Clemmens*, 56 Pac. p. 84, the court, by Huston, C. J., said:

"The only question presented by this record for our consideration is: Was the property described in the declaration of homestead, at the time the same was made and recorded, subject to be declared upon as a homestead under the statutes of Idaho? The district court held that, by reason of said premises being occupied by defendant and his family as a hotel at the time the declaration of homestead was filed, the same was not subject to homestead declaration, and the declaration filed thereon was void and of no effect to exempt said premises from levy and sale on execution. With this conclusion of the district court we cannot agree. The character of the occupancy or use of the premises claimed as a homestead, so long as the same is occupied by the declarant as a residence and a home for himself and family, is immaterial under the statutes of this state. The only limitations prescribed by the statutes of this state to the acquisition of homestead rights are residence and value. There is no distinction in our statutes, as there is in many of the states, between real estate located in the town, city or village, and lands used and occupied as a farm. There is no limitation in our statutes upon the amount of land that may be included in

a homestead, so long as it is occupied as a residence, and does not exceed in value the limitations prescribed by the statute. If other limitations are deemed requisite, they must be fixed by the legislature and not by the courts.”

So in the case at bar, the legislature having fixed by Section 1693, Civil Code of Montana, the amount of land which can be claimed and selected as a homestead, and the value of the property which may be held by a homestead claimant, no other limitations are allowable, and the lot claimed as a homestead being actually used as a residence for the family of a homestead claimant, the homestead exemption by force of the law includes the whole of the lot and premises, provided that it does not exceed in area one-quarter of an acre of ground.

In the case of *Skinner vs. Hall*, 69 Cal. 195, the homestead claimant prior to the time of his declaration of homestead which was in question, had rented his house and lot by the month for the monthly rental of \$15.00. On the day prior to the filing of the declaration of homestead, which was in question, he made an arrangement with his tenant by which he gave up part of the rent and was permitted to occupy the front room of the house, and on the night of the day prior to the filing of said declaration of homestead, he took to the room some bedding and slept there. He then filed his declaration of homestead on the 25th day of January, 1881, having on the same day filed a declaration of abandonment of prior homestead claimed by him on the same premises. He then continued to sleep in the room until May, 1881, when the tenant gave up the house, and the wife and child of the homestead claimant joined him and occupied the premises.

The court in deciding this case, after maintaining the validity of the homestead declaration filed under the circumstances as above set out, goes on to say in the opinion:

“So one may file and maintain a homestead upon property which is partially rented out or used for other purposes than his residence. (Ackley vs. Chamberlain, 16 Cal. 181; Phelps vs. Rooney, 9 Wis. 70.) It is also claimed for the appellants that the south half of the lot, back as far as the poultry yard fence, was not impressed with the character of homestead, and to that extent, at least, the court erred in its conclusions. As has been seen, the whole lot was but 62 feet wide and was all enclosed. It was divided by a fence running back to the poultry yard, and the outbuildings and house were upon the northern half. Still, the court thought it all constituted a homestead and was exempt from forced sale; and we cannot say its conclusions were not justified by the facts.”

In the case of Heathman vs. Holmes, 94 Cal. 291, the court, in discussing this question, said, on page 294 of the opinion:

“We think the court below erred in disallowing the injunction. We have not been referred to any decision of this court where the facts were exactly like those of the case at bar; but it has been held here that using a building partly, or even chiefly, for business purposes, or renting part of it, is not inconsistent with the right of homestead, provided it is, and continues to be, the bona fide residence of the family.”

Plaintiff in error states in her brief that Section 1693 of the Civil Code of Montana is a continuation of the law as it formerly stood in Montana under the Compiled Statutes, and that said law was borrowed from the state of California, and much of her argument is based upon the proposition that Section 1693 of the Civil Code of the State of Montana, *supra*, was at one time the law in California, and that the decisions of that state have construed the same favorably to her contention. This

statement is entirely erroneous. No similar provision was ever contained in the laws of California. The statute of California at the time of the decision of *Gregg vs. Bostwick*, 33 Cal. p. 225, is given in the opinion of the court, and is as follows:

“The homestead, consisting of a quantity of land, together with the dwelling house thereon and its appurtenances, not exceeding in value the sum of five thousand dollars, to be selected by the husband and wife, or either of them, or other head of a family, shall not be subject to forced sale on execution, or any final process from any court, for any debt or liability contracted or incurred after the passage of the act to which this is amendatory.”

It will be observed that this statute does not grant to the homestead claimant a specific area of land with the dwelling house thereon, as is done by Section 1693 of the Civil Code of the state of Montana. And even under this section of the statute the ruling of the California courts has not been uniform. Prior to the case of *Gregg vs. Bostwick*, it was held in California, in accordance with the very learned decisions and sound reasoning of the Nevada courts, that although a specific quantity of land was not granted, yet, if the value did not exceed five thousand dollars, it would all be exempt, provided the dwelling house was situated thereon, no difference what use the premises were put to, and since the decision of the *Gregg vs. Bostwick* case, the courts of California have departed from the doctrine therein enunciated.

See: *Skinner vs. Hall*, *supra*.

Heathman vs. Holmes, *supra*.

To show that Section 1693, *supra*, or its equivalent, was never in the Code of California, the court's attention is invited to *Gaylord vs. Place*, 98 Cal. p. 478, in which the court said:

“A homestead in the country may include a farm, whether it contains a hundred or a thousand acres, and

whether it is used for the ordinary purposes of farming or for grazing and raising stock. The only tests are use and value. Its value must not exceed five thousand dollars, and its use must be primarily as a home for the family. Whatever is used being either necessary or convenient as a place of residence for the family, as contradistinguished from a place of business, constitutes the homestead, subject to the statutory limit as to value.”

Plaintiff in error has cited many cases in support of her contention that will, almost uniformly, be found to be under homestead statutes in which the definition of a homestead is given, as it is in Section 1670 of the Code of Civil Procedure of the State of Montana, with a limitation only as to value. This renders such cases inapplicable to the homestead laws of the State of Montana. Wherever the decisions have been under statutes analogous to Section 1693, *supra*, they are invariably in accordance with our contention as to the proper construction, and, as we have heretofore said, we think the construction of this section has been settled in the case of Yerrick vs. Higgins, *supra*.

Adopting, however, the doctrine of principal or primary use insisted upon by plaintiff in error, she was not entitled to the instructions asked for, for the reason that the testimony, as we have heretofore stated, is uncontradicted as to the character of the use to which the whole of the premises claimed were put to at the time of the filing of the declaration of homestead, and this testimony shows the entire premises to have been then used primarily as a homestead for the defendants in error. The whole of one house and one room of the other was used for the family, and four rooms only of the addition to the older house was rented to tenants. The front yard was used in common, there was no division fence between the houses, and that portion of the back yard which was separated by an improvised

fence, was used in common as a garden spot. The whole was enclosed by a substantial outside fence. The following cases demonstrate that the mere leasing of a portion or a majority of the rooms of a house does not destroy the homestead character of the premises:

Hubbell et al. vs. Canady, *supra*.

Layson vs. Grange, *supra*.

Hancock vs. Morgan, *supra*.

Bailey vs. Banknight, *supra*.

Winland vs. Holcomb, *supra*.

Phelps vs. Rooney, *supra*.

Kiesel vs. Clemens, *supra*.

Skinner vs. Hall, *supra*.

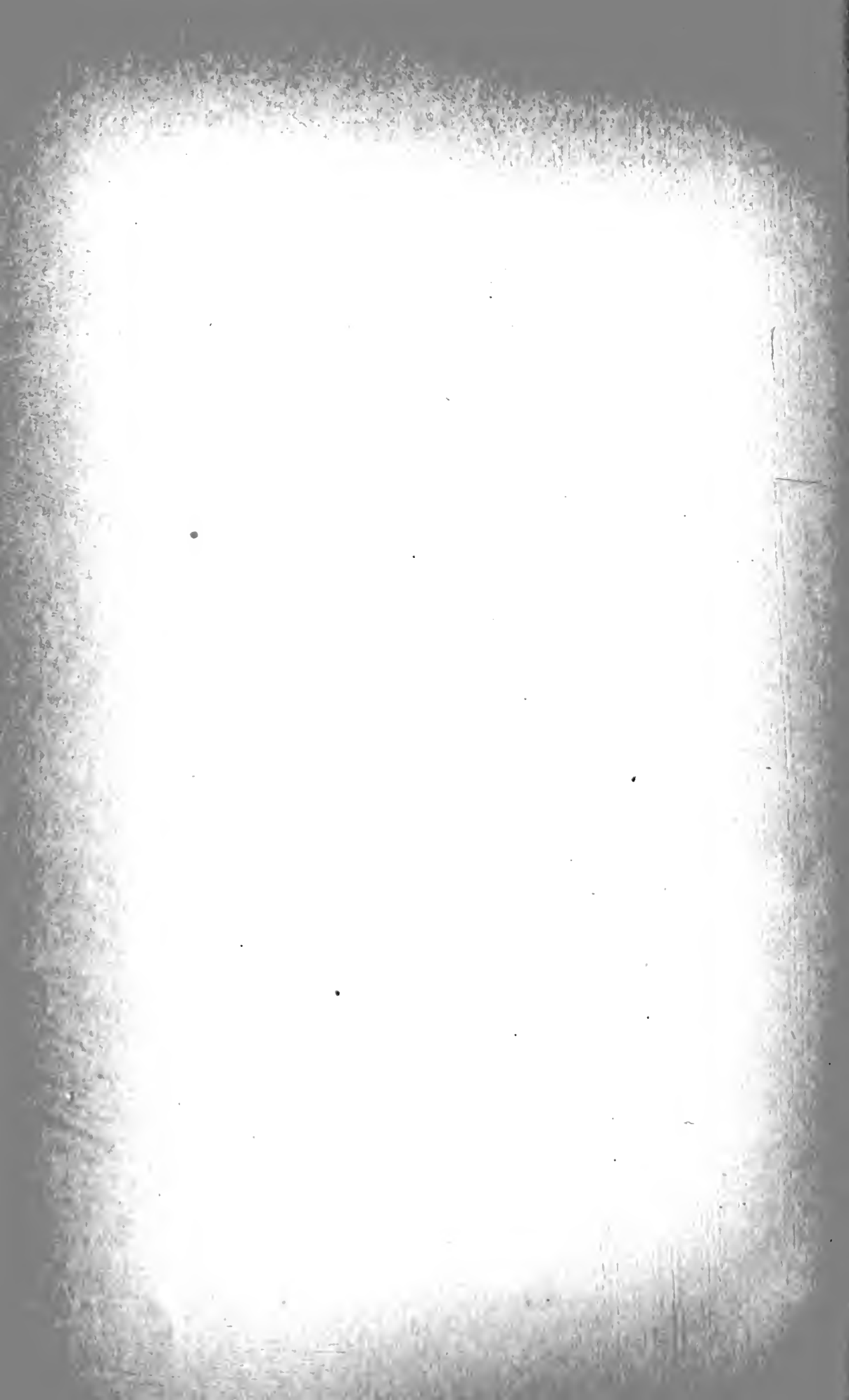
The testimony of Pinegar, Transcript, p. 34, and the map, Transcript, p. 36, and the testimony of all other witnesses, show that the plaintiff in error arbitrarily segregated the southern portion of the lot and sold it separate, claiming it to be not exempt. That she included in this portion of the lot land which had never been divided from the other by any division fence, and had never been leased by the homestead claimant at any time to tenants. The front yard, about two feet of the passageway between the two houses, and that portion of the premises and the room which was occupied by the McCafferys at the time of the filing of the declaration of homestead. She thus sold more land, and claims more as subject to execution, than under any feature of this case she would be entitled to claim, and, therefore, the entire sale would be void.

We very respectfully submit that under the authorities and Section 1693, of the Civil Code of Montana, the defendant in error was entitled, having filed the proper declaration, to claim as exempt the entire one-quarter of an acre, notwithstanding four rooms of one of the houses situated thereon was leased to

tenants, provided the value of the one-quarter of an acre did not exceed twenty-five hundred dollars, and that the judgment of the lower court should be affirmed.

Respectfully submitted,

WILLIAM B. RODGERS,
Attorney for Defendants in Error.



IN THE
United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

CLARA E. SACKETT,

Plaintiff in Error.

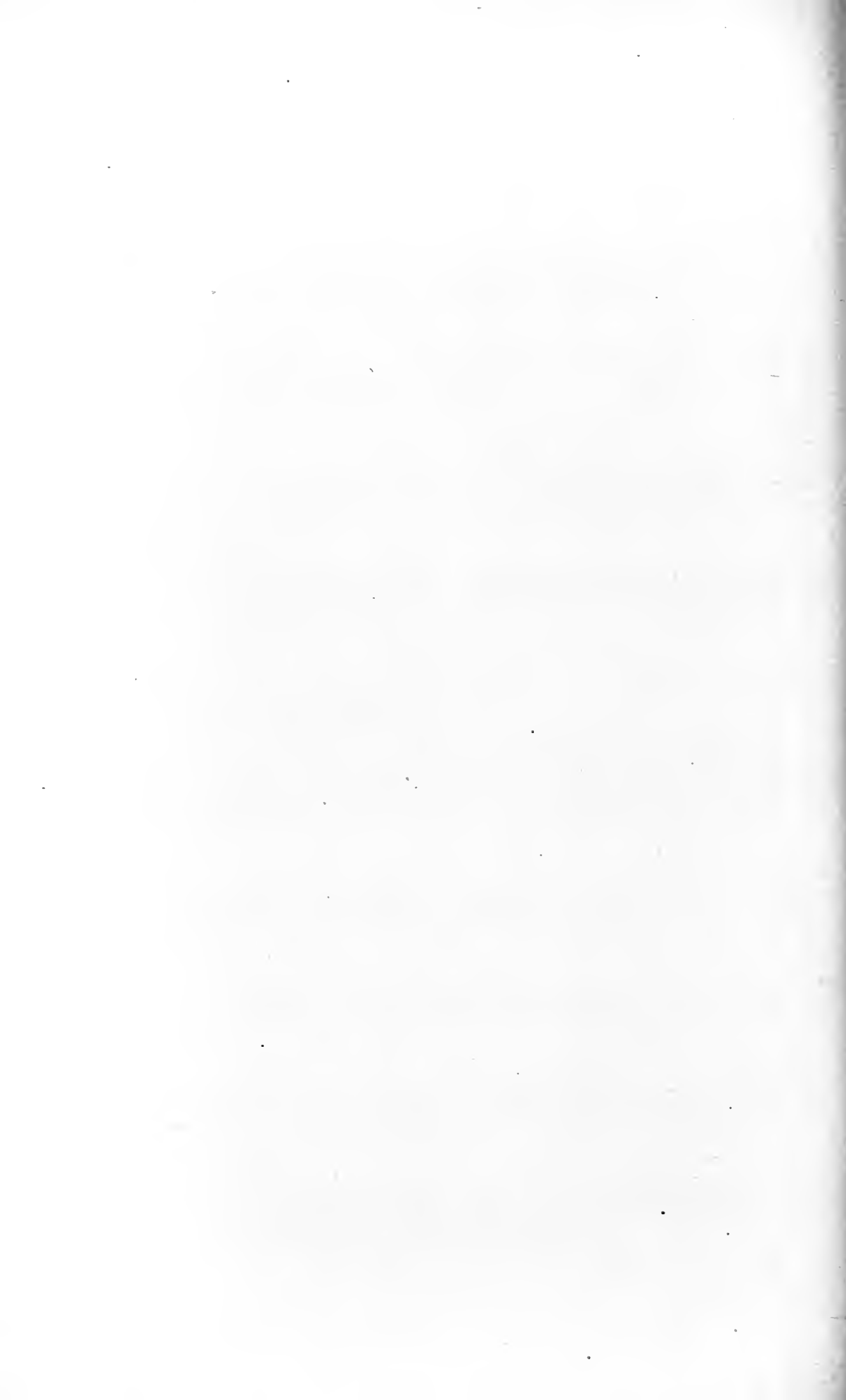
vs.

MARY McCAFFREY and
JOSEPH McCAFFREY,

Defendants in Error.

**Reply Brief and Argument of Plaintiff in
Error, Clara E. Sackett.**

E. B. HOWELL,
CHARLES E. SACKETT,
Counsel for Plaintiff in Error.



IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

CLARA E. SACKETT,

Plaintiff in Error.

vs.

MARY McCAFFREY and

JOSEPH McCAFFREY,

Defendants in Error.

ARGUMENT IN REPLY.

It being provided in the stipulation on file that a reply brief may be filed on or before October 15th, counsel for plaintiff in error respectfully ask the Court to receive and consider the following reply to the argument of counsel for defendants in error.

THE STAMP QUESTION.

Counsel for defendants in error erroneously infers that plaintiff "does not insist upon the first ground of her objection," to-wit, "that said instrument (the homestead declaration as distinguished from the certificate of acknowledgement thereto) offered in evidence was not stamped as required by the laws of the United States, in force at the date of its execution." Counsel for plaintiff have not withdrawn this objection, and ask its consideration.

Counsel for defendants maintain (1) that the copy in the record (Tr. pp. 27-28) of the homestead declaration offered in evidence by the defendants, and admitted, does not show that the declaration was not stamped, because said copy purports to be only the copy of an instrument or paper, and a stamp is not a part of any paper or instrument to which it is affixed, and would not necessarily appear upon a copy thereof; and (2) that the objection to the admission of the declaration on the ground (Tr. p. 28, l. 29), "that the notarial certificate to said instrument offered in evidence was not stamped as required by the laws of the United States in force at the date of its execution," was not sufficiently specific because (Defts. Br. p. 4, l. 16 et seq.), "it cannot be told therefrom whether the admission of the declaration was objected to because the stamp was not of large enough denomination, or because the stamp was uncanceled, or because there was no stamp of any denomination upon * * * the certificate of acknowledgment, or because the stamps had been put on after the filing of said declaration for record without the formalities required by law in obtaining the permission of the internal revenue collector for the district and having the same canceled by him."

To the first point, our reply, which is perhaps as technical, but fully as logical as the objection, is, that what was offered in evidence was the homestead declaration (Tr. p. 27, l. 1, 2) and that as the stamp, according to defendants' argument, was not part of the declaration, it was not included in the offer of the declaration, so that the offer, being of a homestead declaration without a

stamp, should have been refused under the objections, and the admission of the instrument was error.

Under the second point urged by defendants it must be admitted that the objection quoted therein is ambiguous, by reason of the inadvertant omission of a comma after the word "stamped." The objection was made on the ground that there was no stamp on the certificate of acknowledgment, and was decided on the theory that the acknowledgment required no stamp.

Under rule 14, sub'd 4 of the Rules of this Court, providing that when the judge of the lower Court deems it necessary or proper that an original paper of any kind should be inspected in this Court, he may cause the same to be transmitted to this Court where it will be received, and considered in connection with the transcript of proceedings, we asked the judge of the trial court in this case to cause said original homestead declaration to be transmitted to this Court, which has been done. An examination of said instrument shows it to be entirely unstamped, and the points which defendants attempt to make are therefore disposed of. Where a copy of an instrument in the record cannot in the nature of things show its actual condition or what it contains, we deem it a proper case for asking the transmission of the original for the inspection of the appellate court. The reason for the practice of transmitting copies instead of originals to the appellate court is, on account of the greater convenience and because, ordinarily, a copy will advise the appellate court of the condition of the original as fully as may be neces-

sary. And when this information cannot be afforded by a copy, the original should be sent.

Defendants next urge (Dfts. Br. pp. 7-12), that the provision in Schedule A. of the War Revenue Act taxing "Certificates of any description required by law not otherwise provided for in this Act" does not include the certificate of acknowledgment of a homestead declaration, because,

(1) Such certificate is properly described as "proof of acknowledgment," and congress would have used that term if it had intended to tax such certificate, and that, by reason of the common use of the term "proof of acknowledgment" as applied to such certificate, there is at least a doubt raised as to whether congress intended to tax a certificate of acknowledgment, which doubt must be resolved in favor of the person taxed.

2. That the tax, if intended to be imposed on a certificate of acknowledgment, is a tax on the Notary taking the acknowledgment, or upon the official duty performed by him as an officer of the State of Montana, and that congress has no power to impose a tax upon the function of a state government, or upon the acts of an officer done in the performance of those functions.

Under the first point, it is sufficient to say that defendants' argument is based on a mis-statement of fact. Nowhere in the Montana Codes is the certificate of acknowledgment referred to as "proof of acknowledgment." Thus the sections of the Code referred to by counsel for defendants (which defendants' counsel does not quote, as re-

quired by Rule 24, sub'd c., and which appear in the Civil Code, and not in the Code of Civil Procedure as stated by him), read as follows:

“SEC. 1600. The proof of acknowledgment of an instrument may be made at any place within this state before a Justice or Clerk of the Supreme Court or a Judge of the District Court.

“SEC. 1601. The proof *or* acknowledgment of an instrument may be made before either: (designating certain officers).

SEC. 1602. The proof of acknowledgment * * * may be made * * * before either: * * *.

SEC. 1603. The proof *or* acknowledgment * * * may be made * * * before either: * * *.”

It will be observed that in Section 1600 and Section 1602, the phrase is “proof *of* acknowledgment,” whereas in Section 1601 and Section 1603, the phrase employed is “proof *or* acknowledgment.”

In the corresponding California sections, from which these were copied (Cal. C. C. Section 1180-1183), the uniform phrase is “proof *or* acknowledgment.” The word “of,” where it occurs in the Montana sections quoted, is, therefore, clearly a misprint for “or,” so that the phrase should read in all of the sections “proof *or* acknowledgment.”

The proof of an instrument is its authentication otherwise than by a certificate of acknowledgment, as, for instance, by the testimony of a subscribing witness taken

before an authorized officer, reduced to writing and authenticated in such a way as to entitle the instrument to record; while the acknowledgment of an instrument is the statement of the person executing it that he “executed the same,” made to an officer who certifies it in the form of a certificate of acknowledgment, whereupon the instrument becomes entitled to record.

The sections quoted provide for taking this proof or acknowledgment *before* an officer; the certificate is not taken *before* the officer but is made by him; and then the officer, having taken the acknowledgment, must attach to the instrument a certificate of acknowledgment under Sections 1573, 1608 and 1609 of the same Code (See Plfs. Orig. Br. p. 15).

Under the second point defendants’ counsel quotes Section 7 of the War Revenue Act providing that no one shall “make, sign, or issue or cause to be made, signed or issued; any instrument * * * without the same being duly stamped * * * or without having thereupon an adhesive stamp to denote said tax * * *.” We submit that the obvious meaning of this provision is, that where one person causes another person to make, sign, or issue an instrument without the same being duly stamped, the former is liable for the payment of the tax, and not the latter; and that it is the duty of the former, and not the latter, to furnish and affix the stamp. Otherwise, when a person takes an instrument to a notary before whom he acknowledges it, and no stamp is placed upon the certificate of acknowledgment, both would be liable for the omission, the notary for signing the certificate without affixing

a stamp, and the principal for causing the acknowledgment to be taken and the certificate added, without himself affixing the stamp. The stamp is a tax. If a person makes his own promissory note, he is, of course, liable for the tax. If his agent, acting within the scope of his authority, makes the note in the principal's name, without affixing a stamp, it is evidently the principal and not the agent who is liable to pay the tax, although he did not sign the instrument, but "caused" it to be signed. The agent signs the instrument, but is not thereby made personally liable to pay to the government the amount of the tax. Whether the agent would be liable to the penalty imposed for non-stamping, in said Section 7, it is not necessary to decide; this suit is not brought to collect a penalty. The utmost that could be claimed under Section 7, is, that it forbids the notary making the certificate without the same being stamped (by somebody). The section does not say that one must not sign a paper, required to be stamped, "without stamping the same," but that he must not sign it "without the same being duly stamped * * * or without having thereon an adhesive stamp to denote said tax." In view of this prohibition, the notary need not make the certificate at all, if he does not wish, unless a stamp is furnished by the party in interest. There is no requirement that the notary furnish the stamp, and therefore there is no tax upon the notary or his official functions. Sections 7, 14 and 15 of the War Revenue Act, quoted on page 23 of Plaintiff's original brief, forbid the admission in evidence or to record of an unstamped instrument which is required to be stamped; and the party in interest, offering it in evi-

dence or for record, must at his peril see that it is properly stamped.

As shown on page 16 of plaintiff's original brief, the Treasury Department has ruled that a certificate of acknowledgment requires a stamp. The Department has also ruled that a certificate must be stamped, not by the officer making it, but by the party in interest.

“Certificates required by law issued by any department or officer of the government at the request of private persons, solely for private use, should be stamped. The stamp should be furnished by the person applying for the instrument and for whose use or benefit the same is issued * * *.” Dec. Comm. Int. Rev. Vol. 1, p. 312.

Also in Vol. 2 of said decisions, pp. 71-74 (Ruling No. 20,551), the question having arisen as to the taxability of certificates of authority issued by the State of Missouri, through the state insurance commissioner, to agents of insurance companies, and also the question whether, if such certificates were taxable, the stamp thereon should be furnished by the State Commissioner who would execute the certificate, or by the insurance agent who secured it, the Treasury Department held, under the advice of the Attorney-General:

a. That such certificate was taxable because not necessary in the operation of the general machinery of the state government, and because, the issuance of the certificate though an official act, was performed at the instance of a private individual, in serving interests other than those required to carry on the governmental machinery.

b. On the question as to who should furnish the stamp to be placed on the certificate, the ruling of the department reads :

“Nor, because it is the duty of the Insurance Commissioner to affix a 10-cent stamp to such certificate of authority, does it follow that the state must pay such tax. The law imposes the duty of affixing the stamp on the person executing and issuing an instrument, but it does not say that such person shall pay for the stamp. As you will observe in the Attorney-General’s opinion, the tax must be paid by the party for whose use or benefit the same is issued, which in this case, is the insurance agent. The citizens of a state are citizens of the United States, and are not exempt from taxation because in the course of their business it becomes necessary for them to secure a certificate of authority from the state. The certificate is issued at their instance and for their benefit, and they must pay the tax.”

The question, therefore, whether the notary, in taking an acknowledgment, acts judicially or ministerially, is immaterial. Yet, in the *Cyclopedia of Law* (2d ed.) vol. 1, pp. 485-487, under the head of “Acknowledgments,” it is said, “The weight of authority seems to be in favor of the view that the act is ministerial, and not judicial.”

It is difficult to see any judicial quality in the act of a Notary in receiving a statement from the person executing an instrument that “he executed the same,” and then certifying such statement. Under the former California and Montana law, providing that the Notary, in taking the acknowledgment of a married woman, must examine her

separate and apart from her husband as to whether she executes the instrument freely and voluntarily, a judicial quality in the Notary's act may be discerned, and it was such an acknowledgment under consideration in the California case cited by defendants (*Wedel vs. Herman*, 59 Cal. 514). In the *Cyclopedia of Law* (2d ed.) vol. 1, pp. 487-488, under the head of "Acknowledgments," it is stated that "in Mississippi a distinction has been made between taking the acknowledgment and making the certificate, the former being looked upon as a judicial and the latter as a ministerial act." Under that view, the making and signing of the certificate of acknowledgment which is to be taxed, is a ministerial act. A similar distinction is apparently made in the above cited California case, where it is held that the making of the acknowledgment is a necessary part of the execution of a married woman's deed, but that the "certificate of acknowledgment is not an essential part of her conveyance. That, under the codes, is regarded simply as record proof of the fact of acknowledgment *"

* *. In *taking the acknowledgment* the officer acts judicially."

It is provided in the California Political Code Section 801 (Montana Section 919), that a Notary and his sureties are liable in damages for his official negligence. And in *Joost vs. Craig*, 131 California 504 (63 Pac. 840), in construing this provision, it is held that a Notary does not act judicially in taking an acknowledgment.

And in the case of *First National Bank vs. Roberts*, 9 Mont. 338 the Court seems to hold that a Notary, in taking an acknowledgment, does not act judicially.

The duty of a Notary in taking an acknowledgment has no connection with the administration of justice; he is not acting under commission from any court; and the paper acknowledged, with the acknowledgment thereto, is and remains private property.

Counsel for defendants maintains, on pages 12-14 of his brief, that the words "instrument, paper or document," in Section 14 of the War Revenue Law refers only to the body of the instrument and not to the certificate of acknowledgment thereto, to the principal thing and not to the mere incident, to the homestead declaration and not its acknowledgment; that such words refer to "the thing which is to be used in evidence," meaning the declaration minus the certificate; and he says, "The proof of acknowledgment or certificate of acknowledgment is not the instrument, nor the paper, nor the document which was sought to be introduced in evidence," and that, "The proof of acknowledgment cannot by any proper construction of this statute be denominated an instrument, paper or a document required by law to be stamped."

This argument appears to be the proverbial "grasping at a straw," and in reply we would say:

1. The certificate of acknowledgment was required to be stamped, as heretofore abundantly shown.

2. Such certificate was offered and admitted in evidence as a part of the declaration (Tr. pp. 26-28).

3. Under Section 1700 Mont. C. C., quoted on page 15 of the plaintiff's original brief, the certificate was necessary to the validity of the declaration; and under the

numerous authorities quoted on pages 27-31 of the same brief the certificate was a necessary pre-requisite to recording without which the recording was a "nullity," and recording was necessary to the validity of the homestead declaration under Sections 1702 and 1703 of the Montana Civil Code, quoted on page 31 of plaintiff's original brief. It follows that defendants were compelled to introduce the certificate in evidence, as well as the declaration to which it was appended, both to show that a complete declaration was made and that the same was recorded. If defendants did not put the certificate in evidence, they failed to prove a homestead. And as the certificate is required to be stamped, it could not go in evidence without being stamped. A certificate of acknowledgment is always appended to another instrument, and, in a sense is an incident thereof. If, as counsel contends, the penalty of exclusion from evidence does not apply to the certificate, then none of the penalties for non-stamping apply to it, and we are driven to the conclusion that Congress imposed a tax on certificates without intending that its collection should be enforced. Counsel for defendants has argued that Section 7 of the revenue law (page 12, Dfts. brief) imposes a tax on the Notary making a certificate of acknowledgment; but the same words "instrument, document or paper" are used in that section, so that his argument there is that said words do refer to a certificate of acknowledgment.

In the case of *Reid vs. Mercantile Co.* (Cal.), 58 Pac. 1064, the Court decided that the certificate of acknowledgment of a homestead declaration was not part of the decla-

ration; it must, then, be a separate document. On the other hand, if it is a part of the declaration, the requirement that the certificate be stamped is a requirement that the declaration be stamped in a particular part thereof. The Revenue law imposes taxes on many classes of certificates, and probably most of these are designed to be appended to some other instrument which requires such a certificate. Congress evidently intended that the tax on these certificates should be enforced, otherwise it would not have taxed them, and the means of enforcement, such as exclusion from evidence, must be held to apply to them.

On pages 15-18 of defendants' brief it is urged:

1. That the requirement in the revenue act that unstamped instruments be excluded from evidence, is not binding on the state courts, because Congress has no power to impose a rule of evidence on state Courts.

2. That the requirement that such instruments be excluded from record is not binding on state recording officers, "for the same reason."

The first point is immaterial in this case, as this is a Federal Court. As we have stated (Plf. Orig. Br. p. 26, l. 25), these same decisions concede that the section (Section 14, Rev. Act) is binding upon Federal Courts.

As to the second point, it seems to us that the requirement that county recorders exclude unstamped instruments from record is both reasonable and necessary as a regulation for the collection of the revenue, and that the second point has much less force than the first point urged by counsel.

The only Federal authorities on this point are cited

on page 33 of plaintiff's first brief; and outside of what appears in said cases neither of these points have ever been decided, so far as we can find, by any Federal Court. Our position is that the state cases cited in defendants' brief on these points, and especially on the second point, if followed, will nullify revenue statutes of the Federal government which are reasonable and constitutional.

On pages 18-20 of defendants' brief it is urged

(1) That Section 14 of the War Revenue Act could have no application to a repeal portion of Schedule A or to Schedule A after its repeal.

(2) That it is the uniform rule of law that when the law imposing a penalty is repealed, the penalty can no longer be exacted.

(3) That it is against public policy to hold that when the law imposing a tax has been itself repealed, that the instrument which was the subject of the tax should still be excluded from evidence on account of the non-payment of the tax.

Under the first point, we have abundantly shown (pp. 17-22, plfs. orig. Br.) that the repeal of the tax is not retrospective, the tax still remains due despite the repeal of the law imposing it; that is to say, said law is not repealed but remains in force as to taxes already due.

On the second point, on page 19 of defendants' brief, early Federal authorities are cited setting forth the common law rule that when a law is repealed the penalty for its infraction falls with it. But Section 13 of the Revised Statutes of the United States, was designed to repeal.

and did repeal this common law rule, as expressly stated in the Federal authorities cited on pages 25 and 26 of plaintiff's original brief.

In regard to the third point, in the case of United States vs. Barr, quoted from on page 26 of plaintiff's original brief, the Court, instead of viewing the perpetuation of the penalty by Section 13 R. S. as against public policy, expressed the opinion that Section 13 was "a salutary provision." It is proper that the government should collect its dues, and that the repeal of a tax should not be allowed to operate in favor of persons who have evaded its payment or failed to contribute what was due from them for the support of the government; if such persons are to be excused, then those who have promptly paid their taxes should have their money refunded.

Section 13, R. S. is a general saving clause. And, as stated in State vs. Sloss (Plfs. orig. Br. p. 24), "An express saving clause was not required to save the right to collect." The tax remained due after the repeal of the law, and the machinery for enforcing its collection was retained unrepealed.

THE FEDERAL HOMESTEAD QUESTION.

1. NEITHER A MAN NOR A MAN AND HIS WIFE CAN HAVE TWO HOMESTEADS, AND IF THEY, OR EITHER OF THEM, ATTEMPT TO ACQUIRE A SECOND WHILE THE FIRST IS IN FORCE, THE SECOND IS VOID.

The Montana law does not expressly prohibit a man

from having two state homesteads in Montana at the same time; yet no one would maintain, nor does counsel for defendants maintain, that a person could have two such homesteads; it is an implied condition of the law that it cannot be done, and that a man claiming a homestead must not already have one in the same state. It was so held in *Waggle vs. Worthy*, 74 Cal. 266, where the second homestead was held void. The construction placed upon the homestead law by the case cited was adopted in Montana along with said law, and is binding on the Courts of this state. (See authorities cited on page ¹⁶38 of plaintiff's original brief). Said case stated the rule without the qualification that the first homestead be in the same state. All of the authorities holding that a man cannot have two homesteads (and we find no authority holding that he can), state the rule without qualification, and none of them even intimate that a man might hold two homesteads provided they are located in different states. As it is an implied condition of the law that a man must not have two homesteads in the same state, so there is no reason why this implied condition should not prohibit two homesteads though the first one be in another state, or be a federal homestead. And, under the authorities already cited (p. 38, plfs. orig. Br.), the wife has no more power to acquire the second homestead than has the husband, and by Section 1700, Montana C. C. she is forbidden to select a homestead if her husband has already selected one.

Counsel for defendants in error maintains that, if a man cannot acquire a state homestead when he has a subsisting Federal homestead, then the converse of the propo-

sition must be equally true, so that if he has acquired a state homestead which he has not formally abandoned, he cannot acquire a Federal homestead. But this conclusion does not follow, since the holding of a homestead claim under the Federal law is primarily a process of acquiring title to, or purchasing, the homestead tract; and while the Federal law imparts to that tract all the essential qualities of a homestead under the state law, and gives to the claimant immunity from levy of execution, these features of the law are rather incidental to the main process of acquiring title. The officers of the government might, therefore, be warranted in refusing to interrupt this process, or to annul the contract between the government and the claimant, merely because the claimant was still holding a homestead exemption under the state law. If it were necessary to cure such an inconsistency, it would doubtless be done by the government requiring the claimant to file an abandonment of his former homestead, rather than by its declaring a forfeiture of the Federal homestead.

2. IT IS NOT NECESSARY, IN ORDER TO BAR A SECOND HOMESTEAD, THAT THE PRIOR HOMESTEAD BE "EQUIVALENT" THERETO, OR BE CREATED UNDER THE SAME FORMALITIES.

Originally a declaration was not required, either in Montana or in California; the later codes required a declaration for the creation of homesteads thereafter established, and gave such homesteads incidents different from those of the homesteads already existing. Yet, no one would claim that, by reason of these differences a man

having already a homestead under the old law, could acquire an additional homestead under the new law. This was attempted to be done in Georgia, and the second homestead was held void on the ground that a man cannot hold two homesteads. (First National Bank vs. Massengill, 5 S. E. 100, cited p. 36, plfs. orig. Br.).

If a man cannot hold two homesteads in the same state, created under different laws and with different incidents, then, for the same reason, he cannot be allowed to hold two homesteads in different states merely because the two homesteads are not "equivalent" or of precisely the same character. And if a claimant cannot acquire a state homestead in Montana when he has a homestead in another state, he cannot, for the same reason, acquire a state homestead in Montana, if he has a subsisting unpatented Federal homestead, because a Federal homestead is as nearly "equivalent" to a state homestead in Montana as are state homesteads, generally speaking, in other states. Probably most states do not require a declaration; many states give the husband power to abandon, encumber or alienate the homestead without the consent of the wife, holding him best qualified to decide such questions, and holding the essential object of the homestead exemption to be, not to protect the home against the acts of the head of the family, but against creditors; and there is great variety in the extent of the exemption, the length of time it covers, and the exceptions thereto.

It is sufficient to bar a subsequent homestead that the claimant already have a homestead exemption of a substantial character. The Federal homestead exemption

protects the home for all time against any and all debts incurred prior to patent. The Federal homestead claimant may start life anew, without his home being at all endangered from past imprudence. The claimant of a state homestead cannot do this as against judgments standing against him on the date of filing his declaration of homestead; antecedent judgment creditors, whose judgments have become liens on his real property, can enforce their judgments against his homestead. His homestead is also subject to the liens of mechanics or laborers. The Federal claimant, therefore, beyond question enjoys a substantial homestead exemption, which under certain circumstances may afford to the claimant and his family more effectual protection for the home against creditors than would a state homestead exemption.

Exemption from the claims of creditors is the principal right conferred by any homestead law, (including the homestead element of the Federal homestead law as distinguished from the mere acquirement of title). The prohibition against either spouse encumbering or conveying the homestead without the consent of the other, is a comparatively modern feature of the homestead law; it is not the principal object sought; in many states its wisdom is doubted, and it has not been adopted.

3. THE FACT THAT JOSEPH McCAFFERY WAS CLAIMING AND ENJOYING AN UNPATENTED, UNFORFEITED FEDERAL HOMESTEAD, WHETHER HE HAD COMPLIED WITH THE REQUIREMENTS AS TO RESIDENCE THEREON OR NOT, WAS SUFFICIENT TO BAR THE ACQUISITION

TION OF A STATE HOMESTEAD BY EITHER HIMSELF OR HIS WIFE, BECAUSE A MAN, OR A MAN AND HIS WIFE, CANNOT HOLD TWO HOMESTEADS; AND THEREFORE PLAINTIFF SHOULD NOT HAVE BEEN REQUIRED TO PROVE SUCH RESIDENCE.

But the filing and patent were evidence of the fact (and indeed, we think should be held to be conclusive evidence of it), that he did take up his residence upon his Federal homestead within the time required and continued to reside thereon as long as required, making his home there. Though he was living with his wife on her Anaconda property at the time she filed her declaration thereon, this may have been during a temporary absence from his Federal homestead, allowed under proper circumstances by the Federal homestead law, and the presumption would be that such was the nature of his absence from his Federal homestead. If such was the fact, his wife's legal residence or domicile would be on the Federal homestead with him, and her declaration of homestead on her Anaconda property therefore void.

The claimant of a state homestead in California or Montana, though he has removed from the state, still retains the homestead. (Tipton vs. Martin, quoted p. 35. plfs. orig. Br.); he is still deemed by the law to regard and hold it as his permanent home, and any absence therefrom is deemed merely temporary, and to be so regarded by him; and this amounts to a conclusive presumption. If such person should file a homestead declaration in Mon-

tana, stating that he (or she) "claims them (the premises) as a homestead," such statement could not be made in good faith; because the same person or family cannot have two homes at the same time. While the Federal homestead claimant is required to live with his family on the Federal homestead, the same conclusive presumption should obtain against him, to prevent the acquisition of a state homestead.

4. Defendant's attorney attempts to show that the case of *Power vs. Burd*, 18 Mont. 22, is not applicable for the reason that it "arose under a different statute from the one we are now considering, a statute which did not require the filing of a declaration of homestead, and made the right to claim a homestead dependent at all times upon use and occupancy." (Dfts. Br. pp. 31-32).

The statute under which that case was decided allowed a homestead only in lands "owned and occupied by a resident of this territory." Under that statute the Supreme Court held that, as the claimant had never lived on the land, his claim, at the time of the levy of execution on the land, that it was his homestead and that he intended to occupy it as such, was immaterial. Yet defendant's attorney maintains that the Supreme Court, in its opinion, approved the admission of the record of the claimant's previous entry of a Federal homestead because it tended to prove the bad faith of this immaterial claim of intention.

The Supreme Court approved the admission of said record "as tending to show whether or not appellant's claim of homestead in the lands in controversy was made

in good faith." The claimant in his answer claimed to have occupied the land. The record of his Federal homestead entry showed his sworn intention to reside on his Federal homestead; and thus impeached the good faith of any subsequent occupancy by him of the ground in controversy under a claim that it was his home,—unless he had meanwhile relinquished or forfeited his Federal homestead, and, if he had, the burden was on him to show it.

In the case at bar, likewise, the record of Joseph McCaffery's Federal homestead entry showed his sworn intention to reside on the Federal homestead. And the issuance of patent shows that he never relinquished or forfeited such homestead. And therefore, the records of such entry and patent impeach the good faith of his wife's declaration of homestead.

5. Defendant's counsel, in his brief, ignores plaintiff's last specification of error under this head, to-wit, that proof of Joseph McCaffery's residence on his Federal claim should not have been required of plaintiff, for the reason that it was a fact peculiarly within the knowledge of the opposite party. And we ask that the court consider the point.

6. In defendants' brief (p. 23), their counsel calls attention to the fact that a state and a government homestead may co-exist in the same ground. But it was held in *Hesnard vs. Plunkett*, that the former must be contained within the boundaries of the latter, and in so far as it extends beyond such boundaries it is void. (See plfs. orig. Br. pp. 38-41).

7. Defendants' counsel maintains that before patent

the Federal homestead claimant's rights are subject to the control of the Interior Department (p. 26). But if the claimant is qualified to make the entry and complies with the law, and the land entered is open to such entry, the Interior Department cannot deprive him of his homestead right.

8. In defendants' brief, on page 28, the case of Hesnard vs. Plunkett is again referred to (See plfs. orig. Br. pp. 38-40), and it is maintained that in that case, the Federal claimant had removed from his state homestead and thereby abandoned it; while Joseph McCaffery had never removed from the Anaconda property claimed as his home, and had never lived on his Federal homestead.

But, in said case, the federal homestead claimant, after taking up his residence on his Federal claim, made claim to a *new* state homestead which was partly within and partly without the boundaries of the Federal claim, but which included the portion of the Federal claim on which he resided, so that he lived on both claims. Yet it was held that the second homestead (the state homestead) was void as to the portion outside the boundaries of the Federal homestead.

The presumption as to Joseph McCaffery's residence is discussed under (3).

9. Counsel for defendants maintain (p. 31) that, if Joseph McCaffery had abandoned his wife, she could declare a homestead although his residence was elsewhere. No abandonment is claimed, however; and the fact, as shown by the evidence (Tr. p. 37, l. 15), that he was living

with his wife in Anaconda when she filed the declaration, shows that there was no abandonment.

10. It is stated by counsel for defendants (p. 27) that the cases cited by plaintiff's counsel have no application. These cases hold, and most of them explicitly, precisely what plaintiff's original brief says they hold. Whether the propositions of law laid down by these cases, as stated in the brief, are applicable to this case, is for the court to say.

THE TWO-HOUSE QUESTION.

1. It was material for plaintiff to show the rental of the tenant premises before and after the filing of the declaration, and the nature and extent of such rental; and she was not limited to showing the fact and extent of the rental at said date. In our original brief are cited the following decisions in which the Court treated such facts as material:

On pages 57 and 58 (In re Crowley).

On pages 58 and 59 (Maloney vs. Hefer).

On pages 60 and 61 (In re Ligget).

On page 82 (Freeman on Executions).

On page 70 (Milburn Wagon Company vs. Kennedy).

On page 93 (Wurzbach vs Menger).

If such facts could not be shown, a debtor, owning a house which he had always rented, having no intention to make it his home but only seeking to acquire a homestead exemption therein, might have his tenant move out, move

into the house himself for a few days during which he would file a declaration of homestead, and then move out again and give place again to his tenant, never himself making any bona fide homestead use of the premises but nevertheless acquiring a homestead exemption therein.

2. We will here reply to defendants' discussion of the evidence:

a. The map of the premises (Tr. 36) indicates that the porch, or a part of it, in front of the north house, extended across the intervening passageway to the wall of the tenement house. W. E. Pinegar, the surveyor, testified (Tr. 34, l. 16) that "on the map the hatched portion was a porch, covered by a roof connecting the two houses

* * * there was an entry between the two houses." That entry, at the point where the porch is, is shown on the map and by Pinegar's testimony, to be four feet and three inches wide. J. H. Collins testified (Tr. 31, l. 12) that "the roof of the porch in front of the north house extended across to the wall of the house occupied by the witness (the tenant house)."

The two houses were not, therefore, as alleged on page 33 of defendants' brief, "joined together by a porch which was covered, but passed from one to the other." On the contrary, only the roof of the porch extended across the entry way between the two houses, a space of more than four feet. This fact clearly does not make the two houses one.

b. It is true that there was no division fence between the houses, as that space was used by the McCafferys for

a passageway; and plaintiff did not sell any part of this passage in selling the tenant premises. This appears from the map and the surveyor's description thereon (Tr. 36). The tenant premises, as separately sold, are bounded on the north by the north line of the tenant house back to the corner where the division fence between the rear yards begins. Therefore the statement on page 52 of defendants' brief that plaintiff included in the tenant premises at such sale "about two feet of the passageway between the two houses," is entirely erroneous.

c. The division fence between the rear yards, as shown by the map, (Tr. 36) extended back continuously from the rear corner of the tenant house to the woodshed at the rear of the lot, and the line of the fence was continued through the woodshed building, dividing it into two woodsheds, the southerly portion belonging to the tenant premises. The surveyor traces the continuous course of the fence from the rear corner of the tenant house back to this partition in the woodshed; and he says (Tr. 34, l. 27) that "all the fence referred to was of about the same sort, consisting of a couple of rails with boards nailed on;" and (Tr. 35, l. 8), "the fence was entirely up at that time along the length of it at the time the witness made the survey," which was in May, 1901. The testimony of David G. Boyd (Tr. 32, l. 16) shows the fence to have been there in 1898, more than two years before the filing of the declaration. The surveyor testifies (Tr. 34, l. 13) that "there was a partition in the woodshed on the back end of the lot, and the map shows the woodshed and the partition." J. H. Collins testifies (Tr. 31, l. 15) that "there

was access through the witness' portion of the back yard to witness' woodshed, and through the woodshed to the alley in the rear of the lot." David G. Boyd testifies (Tr. 32, l. 15) "there was a woodshed next to the alley used by the witness for firewood." There is no foundation, therefore, for the claim made on page 33 of defendants' brief, that the fence separating the rear yards was a "temporary fence," and separated the back end of the lots "to some extent."

d. Each dwelling house had its own separate appurtenant outbuildings, as shown by the map.

e. There is no evidence to show that the front yard of the tenant house was a "common yard," as claimed by defendants (p. 33), or that defendants ever made any use of it. The tenants, however, were obliged to use the yard in front of the tenant house to gain access to the street, and this use was indispensable to them; therefore the McCafferys cannot claim it unless they show a use of it by themselves of greater importance, but they show no use of it at all. Plaintiff confines her claim, as to front yard, to the ground directly in front of the tenant house. There was no division fence at the front of the houses. But, as stated in *Gregg vs. Bostwick*, 33 Cal. 220, the boundaries of the homestead are not fixed by fences, but by use. A fence is always considered an important element as showing how far the homestead use extended, but this may be shown in other ways. Defendants say on page 52, that in the sale of the tenant premises the plaintiff included land "which had never been leased by the homestead claimants at any time to tenants." The ground in front

of the tenant house is apparently referred to. But the evidence shows that the defendants rented the tenant premises as a house and lot to the various tenants, and this would include the ground in front of the tenant house, if for no other reason, as being absolutely necessary to the tenants for access to the street. Defendants' statement, that plaintiff "sold more land, and claims more as subject to execution, than under any feature of this case she is entitled to claim," is, therefore, erroneous.

f. On page 51, defendants maintain that the tenant premises were *used primarily as a homestead*. But it was for the jury to say whether such was the fact, under the instructions offered and refused. (Tr. 38-40).

g. Lizzie McCaffery testified (Tr. 37, l. 27) that the rear division fence was originally built to protect the garden on the tenant side of the fence, kept by the tenants and the McCafferys jointly, but she does not say when that was, or how many years before the filing of the declaration. The fence was already there in 1898, and may have been built several years before. This is the only evidence on the subject of a garden; and does not show that the McCafferys had any interest in any garden on the tenant premises within several years at least before the filing of the declaration.

h. As regards the frame addition, David G. Boyd testified (Tr. 32, l. 12) that in 1898 it was used "by his children as a play-room and by his wife as a store-room." J. T. Dulin testifies (Tr. 33, l. 15-18) that, in the summer of 1900, it was entirely vacant. And J. H. Collins testi-

fies (Tr. 31, l. 4) that Mr. McCaffery told him he occupied the frame addition in order to “hold possession.”

There is, therefore, no evidence showing any use whatever by the defendants of the tenant premises, at the date of the declaration or during any reasonable time before, except of the frame addition, and there is evidence that such use was fraudulent.

On the other hand the testimony shows that all of the tenants used the brick part of the tenant house, and Boyd also used the frame addition. Collins testifies (Tr. 30, l. 27 et seq.) that “the premises rented by him included the building (without the frame addition), the yard in the rear of said building, and the woodshed.” Boyd also testifies to the use of the woodshed. There is no testimony that the defendants in renting the tenant premises ever “reserved” anything except the frame addition.

We submit, therefore, that the homestead status of the tenant premises should have been determined by the jury, upon the question of their principal use.

3. On pages 34, 48, 50 and 52, defendants cite *Skinner vs. Hall*, 69 Cal. 198, where the Court says “one may file and maintain a homestead upon property which is partially rented out or used for other purposes than his residence.” The Court bases this conclusion on *Ackley vs. Chamberlain* (Cal.), which we have shown (orig. Br. 76) to have been decided under the doctrine of principal use, and which was a case where the claimant had only one house; and on *Phelps vs. Rooney*, (Wis.), where also the claimant had only one building (orig. Br. p. 78), but which

was not decided under said doctrine of principal use. The last named case was decided by a judge who subsequently decided in *Casselmann vs. Packard*, 16 Wis. 70, that a separate tenant house was not exempt; and subsequently in the same state in *Harriman vs. Insurance Co.*, the Court says that in *Phelps vs. Rooney* the Court should have held that the building was not exempt unless it was principally used as the residence of the claimant; and in the same state, in *Schoffen vs. Landauer* a separate tenant house was held not exempt. (Orig. Br. p. 78). In the case cited by defendants the homestead claimant had only one small house, and occupied a small part of it; and circumstances of great hardship are shown. The case is an illustration of the fact that when Courts say that the claimant may have his homestead in property partially rented or used for non-homestead purposes, they almost invariably mean, that where the claimant has but one house, and rents a part of it, or uses part of it for his business, he does not forfeit his homestead right therein, because, if it were taken away from him, he would be deprived of the only home he has. Even under such circumstances, however, it has been held almost uniformly in California that the homestead character of the house is determined by its principal use (See cases cited, plfs. orig. Br. p. 76), where it is also uniformly held that the claimant cannot have two houses, if one is rented (See cases, pp. 54-61, plfs. orig. Br.).

In the case cited the Court refused to interfere with the decision of the lower Court, that part of the lot, which was fenced off and vacant, belonged to the homestead; but

the decision shows that the Court had some doubt on this point. Said part of the lot, however, was not rented to tenants, and presumably the evidence showed that it was devoted to some slight homestead use.

This case is also cited by defendants (p. 52) as showing that the "mere leasing of a portion or a majority of the rooms of the house, does not destroy the homestead character of the premises." The decision so holds, as does *Heathman vs. Holmes* (p. 77, plfs. orig. Br.); the other California decisions, rendered both before and after these, hold that the principal use determines the homestead character.

But the broad rule contended for, even if established as to cases where the claimant has only one house, does not apply where he has two, as in that case the homestead character of the tenant house is determined by its principal use (cases cited on pp. 86-93, plfs. orig. Br.).

4. On pages 35 and 50 of his brief, defendants' counsel denies that Section 1693 was derived from the California law, and asserts that the California decisions, therefore, are not authority in Montana.

While we regard the Montana cases cited on pages 52-53, of our former brief, as conclusive on this point, we would call attention also to the case of *Lindley vs. Davis*, 6 Mont. 456, where the Court says:

"Sections 311 and 313 of our Code are taken from the Act of 1851 of the Laws of California, as will be seen by reference to *Gregg vs. Bostwick*, 33 Cal. 220, 224, 225."

Said Section 311, so Judge Brantly states in *Yerrick*

vs. Higgins, was brought forward into the present codes as Section 1693, and Section 1693 "is substantially the same as Section 322 of that Code."

5. On pages 36-38 of his brief defendants' counsel quotes from Yerrick vs. Higgins, as holding that Section 1693 "specifies particularly the subject matter to which the selection and claim may apply." It is also said, elsewhere in the same decision, that said section "fixes the limitations." Said section specifies the subject matter as being "land * * * used for agricultural purposes, and the dwelling house thereon and its appurtenances * * * (or) land * * * within a town plot, city or village, and the dwelling house thereon and its appurtenances." It also "fixes the limitations" of area and value.

Specifying the subject matter does not involve the specifying of the quantity of the subject matter, or the value of the subject matter, which are matters of limitation, but merely the *subject matter*, to-wit, land and dwelling house and appurtenances. This phrase, therefore, does not warrant the conclusion that defendants counsel appears to derive therefrom, that a homestead claimant in a city or town is entitled to one-quarter of an acre without any restriction as to its use, provided the limitations of value and area are observed and the claimant resides thereon.

The next sentence in said decision, that: "Standing alone the general definition would leave no limit to the amount or value of the property selected and claimed pro-

vided claimant resided in his dwelling upon it," has been fully discussed by us (pp. 61, 62, plfs. orig. Br.) We will merely add that this dictum, if it means what it seems to on its face, was announced without any citation of authorities, without any reason being given for the apparent departure from the California authorities, which were binding on the Court (orig. Br. p. 61, cases cited) unless the strongest reason to the contrary appeared, and appears to have been the result of an attempt, in passing, to summarize a large subject without any necessity for so doing in the case then before the Court. We think the true explanation of the dictum is, that the Court, in announcing it, intended the implied condition that the property must be of homestead character, conforming to the definition of homestead found in Section 1670; otherwise, we must conclude that the Court looked upon Section 1693 as a definition of homestead, after stating that the definition was found in Section 1670 and the limitations in Section 1693.

Defendants' counsel also quotes the following from the same case:

"The Code contains no provision by which, after the homestead has once been selected, there can be a readjustment of the area and the surplus taken by the creditor."

Counsel for defendants infers from the statement quoted, that the levy of execution on a part of the premises claimed as the McCaffery homestead, and the sale thereunder, were not provided for in the homestead law of Montana, or contemplated thereby, and were therefore inoper-

ative and void. Following his view to its logical conclusion, it must follow, in the case at bar as in the case he cites, that as the McCaffery homestead claim is void in part, as was the homestead claim in the case cited, it must accordingly be held all void likewise; because the invalid part cannot be separated from the valid part. But although the homestead statutes in California are the same as those of Montana, aside from Mont. C. C. Section 1693, the Court there, in a case like the one at bar, find a way to segregate the valid part from the invalid part of the homestead, by simply allowing the invalid part to be sold under execution. It is true that in California, there is no limitation of area; but the limitation of area has no bearing upon a case like the one at bar where the entire area claimed does not come up to the limit, and where the segregation is sought on the ground that there is a specific and described portion of the ground claimed as homestead which has never had the homestead character impressed upon it, on account of never having been devoted to homestead uses. That the existence of an area limitation has no bearing upon the case at bar is shown by the fact that in the states which have such a limitation, the creditor is allowed to levy upon and sell under execution such portion of the premises claimed as homestead as are not properly part of the homestead by reason of being rented to tenants. There is such a limitation in Michigan, Wisconsin, and under the old Iowa law, and under the decisions from these states (cited on page 64, plfs. orig. Br.) the creditor was allowed to sell under execution tenant premises claimed as part of the homestead. And nearly all of the

California cases cited on pp. 54-60, and the cases from other states cited on pp. 66-72, of plaintiff's first brief, were cases where tenant premises, claimed as part of a homestead, were allowed to be sold under execution.

In the case from which the quotation by defendants is taken, the ground claimed as a homestead was all equally impressed with the homestead character, one part as much as another; the claimant used it all for homestead purposes. As it stood, the homestead was not valid because it exceeded the legal limitation of area; it was therefore totally void unless a way could be found to reduce it to the legal size. The law furnished no method of doing this, although there is a statutory method of reducing the value where the value exceeds the statutory limit. The Court could not mark off a specific portion of the ground and say "this part is homestead, but the remainder is not homestead," because one part had the homestead character as fully as any other part. There was, therefore, no way of curing the defect, so that the Court was compelled to hold the illegality of the homestead incurable.

Again, counsel for defendants quotes from the same case, as follows:

"If the selection is in compliance with the law, within the value limit, and remains there, the claimant is beyond the pursuit of his creditors, and so far as they are concerned he may forever after retain the specific property selected * * *."

Counsel for defendants infers from this statement, also, that so long as the premises claimed are within the

limitation of area (and value), if the claimant resides thereon, it is a legal homestead, without regard to the other uses to which it is devoted, and may therefore include tenant houses. But the Court says that the selection must be "in compliance with the law," that is to say, the homestead must fulfill the requirements of the statutory definition of homestead stated in Section 1670 Montana C. C. But the California cases cited on pages 54-60 of plaintiff's first brief are practically all constructions of such definition, and based thereon; and they hold that a homestead declaration does not make tenant premises homestead or part of a homestead.

6. On pages 39-41 of defendants' brief, are quoted the Nevada cases, and the Idaho case on page 47, which are discussed on pages 65-66 of plaintiff's first brief. We would especially refer to the elaborate criticism of these Nevada cases in Waples on Homesteads, pp. 235 et seq., which is too long to reproduce here. None of these cases deal with premises leased to tenants.

7. On pages 41-44, defendants' counsel discusses certain Illinois cases. We referred to these cases on page 73 of our first brief, as being decided under a statute which expressly makes the exemption the primary thing, and the homestead and residence features merely incidental. The statute, which is quoted on page 42 of defendants' brief shows this to be true. It does not say that the *homestead* shall be exempt, as is expressly provided in most other states, but exempts "the lot of ground and the buildings thereon occupied as a residence and owned by the debtor.
* * * to the value of one thousand dollars." There

is no definition of homestead, but the term "homestead" is applied in a descriptive way, somewhat loosely, to the exemption. What is expressly exempted is "the lot," etc.

In a later Illinois case (*Sever vs. Lyon*, 48 N. E. 926), the Court says:

"The homestead exempted by the statute is an estate, to the extent in value of \$1,000, in the farm or lot of land, and buildings thereon, occupied as a residence, together with any other buildings upon such lot, whether for carrying on business, or deriving income in the way of rent. In such case the exemption is not limited to the portion of the lot covered by the dwelling, but, *by the terms of the statute, extends to the whole lot.*" In that case the claimant had her residence on a fraction of one lot; and also owned the adjoining lot on which were houses leased to tenants, and she claimed the latter as part of her homestead. The Court, after stating that the "lot" exempted by the statute was not necessarily confined to a legal subdivision, said, referring to said adjoining lot:

"Lot 4 is a distinct and separate lot, occupied under leases by other heads of families residing thereon. It is impossible that appellee should be in the occupancy of that lot, with her family, as a residence, while she occupies a separate lot as a homestead, and it is so occupied by her tenants as their residences. It is in the same enclosure with her residence, but that fact alone is not sufficient to annex a separate lot, not occupied by her, to her homestead."

Here, even in Illinois, a part of the premises claimed

as homestead, and which would have been part of the homestead if used as such, was held to be no part of the homestead because rented to tenants.

8. On page 44, defendants' counsel cites two Texas cases.

In the early case of *Hancock vs. Morgan*, cited, the claimant erected a new house on his homestead lot and moved into it, and leased his old house which the Court held to be, nevertheless, exempt for the reason that the renting was only temporary. But the McCafferys had never made their home in the tenant house, but rented it ever since it was built. The decision was rendered under a Constitutional provision subsequently construed in *Iken vs. Olenick* (orig. Br. 67, 68). That case defines the term "homestead" as it is defined in *Gregg vs. Bostwick*, and says the purpose of the homestead law is not to exempt a definite quantity of land, but only the homestead in the popular sense and not to allow the debtor to include therein property merely contributing to the support of his family, thus virtually over-ruling the case cited.

The other Texas case cited (*Bailey vs. Baukright*), was decided under the later Constitution of 1876 (orig. Br. p. 68), expressly allowing temporary renting, under which the fact of the claimant continuing to make some use of the tenant premises is held to show that he intends the renting to be merely temporary (See orig. Br. 93), and the burden is placed on the creditor to rebut this presumption and show the renting to be in fact permanent. The Court held the tenant house exempt in that case because,

“The renting of part of lot 6 is not shown to be permanent.”

9. On page 44 of defendants' brief is cited the case of *Winland vs. Holcomb* (Minn.), 3 N. W. 341. This case is referred to on page 80 of plaintiff's first brief, as showing the extreme liberality manifested by some Courts in protecting from execution the house in which the homestead claimant lives when he has no other house; and said case is there contrasted with another decision of the same state (*Tillotson vs. Millard*, 7 Minn. 513), where the Court held that the object of the statute was to provide a home, and not to give the use of a certain quantity of land and dwelling house for any other purpose.

10. On page 45 defendants cite *Layson vs. Grange* (Kans.), 29 Pac. 585. In that case a carpenter altered his shop into a 4-roomed house; he rented the four rooms, reserving the basement thereunder for his shop; he also reserved all the ground, giving the tenant merely the right of ingress and egress. The tenant got water from the owner's residence, and kept his coal there. It was held to be not a “total abandonment” of any part.

In the case at bar, however, the tenants used the house and ground and outbuildings, the use by the owner being limited to the one-roomed frame leanto at the rear of the brick house. The case cited may well be compared with *Dyson vs. Sheley*, 11 Mich. 527 (plfs. orig. Br. pp. 87, 88), where the Court said: “The rights of the owner in the tenant side, whatever they are, do not predominate over those of the tenant, and do not show that the tenant had

a mere easement," and then decided the homestead status of the tenant property according to the principal use made of it. In the case cited by defendants, the Court may have regarded the use of the basement for business to be as important as the use of the rest of the building for residence.

In another Kansas case, *Ashton vs. Ingle*, 20 Kans. 679 (plfs. orig. Br. 89), it was held that a subsidiary use of the tenant premises for homestead purposes by the owner did not make them part of the homestead, but that the tenant premises were nevertheless subject to execution. And tenant premises were held not part of the homestead in *Poncelor vs. Campbell* (Kans.), 63 Pac. 606.

11. On page 46 of their brief defendants cite *Phelps vs. Rooney*, 9 Wis. 70. This case, together with other Wisconsin cases, has been discussed in discussing *Skinner vs. Hall*, supra; and these Wisconsin cases afford a striking illustration of the strictness of the courts in denying the claimant homestead rights in a separate tenant house, as contrasted with the liberal treatment accorded him when he has only one house.

12. On page 47, defendants cite *Kiesel vs. Clemens* (Idaho), 56 Pac. 84. This was also the case of a single building, used as a hotel; it was held exempt, the Court not following the doctrine of principal use.

13. On page 49, defendants cite *Heathman vs. Holmes*, which was also the case of a single building. We have already discussed it on page 77 of our former brief.

14. On page 51, defendants' counsel argues that, as

the Montana homestead law contains a limitation of area, decisions from states which have no such limitation are not applicable; and he says that most of the states have no such limitation, but only a limitation of value.

But, as we have pointed out already (plfs. orig. Br. pp. 63, 64), statutes of the same general form and phraseology as Section 1693 (which contains the limitations) are found in Michigan, Wisconsin, and in the old Iowa law, all of them containing the limitation of area; and under all of them tenant houses are held not part of the homestead. Also, as shown in the Appendix of Waples on Homesteads, the homestead laws of Alabama, Mississippi, Florida, and the later Iowa homestead law, all have the limitation of area; and in all of these states tenant houses claimed as part of the homestead are held subject to execution, as appears in the cases from these states cited in plaintiff's first brief (pp. 71, 72, 64 and 65).

It may be added that, of the states named, the following have the double limitation of area and value obtaining in Montana: Michigan, Iowa, Alabama and Mississippi.

Defendants' counsel goes on to say: "Wherever the decisions have been under statutes analogous to Section 1693, supra, they are invariably in accordance with our contention, as to the proper construction * * *."

Just what decisions are referred to we do not know. Counsel for defendants has not cited a single case, under any statute analogous to those of Montana, holding a separate tenant house exempt under any circumstances, except *Bailey vs. Baukright* (Tex.), cited by him on page 44,

which was decided under the phrase allowing temporary renting not found in Montana. His statement is plainly the reverse of correct as applied to *Gregg vs. Bostwick*; and as applied to the decisions in Michigan, Wisconsin and Iowa (Cited, plfs. orig. Br. 64, 65, 77, 78, 79, 87 and 88); to which may be added Texas, where the Constitutional provision quoted on page 67 of plaintiff's original brief, bears a strong resemblance, in its phraseology, to the statute under which *Gregg vs. Bostwick* was decided (as does the later constitutional provision cited by me on page 68), and receives a similar construction in *Iken vs. Ole-nick*. For these Texas cases, see pp. 68-71 and 89-93 of the original brief.

A motion has been served and filed, asking the Court to receive and consider certain journal entries of the lower Court, as part of the record in the present proceeding, as showing (1) that the lower Court withdrew from the jury all consideration of the question of the homestead character of the tenant premises, which we desire to urge as an additional error; and as showing (2) the position taken by the Court at the close of the evidence on the question of law set forth in the refused instructions.

We ask consideration of this motion in connection with the rest of the case.

Plaintiff, in conclusion, respectfully renews her request, made at the close of her original brief, that the judg-

ment be reversed, and the cause remanded to the lower Court with directions to enter judgment in her favor.

Respectfully submitted,

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